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What's in a Name? Some Issues to Consider Before Turning Your Personal Name into a Fashion Label

Eponymous labels abound in the fashion industry, from some of the oldest luxury fashion houses – Hermès, Louis Vuitton, Chanel, Prada – to brands making their New York Fashion Week debut this month – Marina Moscone, Kozaburo, Christopher John Rogers, Rebecca de Ravenel, Cushnie. But following this tradition is not without risk from a brand protection perspective.

Designers considering using their personal names as brand names should be aware of the difficulties they may face in registering and enforcing a personal name as a trademark. Designers should also consider that they may lose control over the use of their own name in the event of a sale or departure from the company.

Do you have the right to use your name as a trademark?

Do not assume that you have the unrestricted right to use your personal name in any manner, including as a brand name, for any goods or services. A party with prior rights may be able to prevent or restrict your from using the same name or a confusingly similar name for the same or related goods or services.

Several examples can be found among the descendants of Gucci's founder Guccio Gucci who have unsuccessfully sought to use and/or register their personal names (with the Gucci surname) as trademarks in the U.S.

In 2015, Uberto Gucci, great-grandson of Guccio Gucci and former vice president of Gucci Parfums S.p.A., sought to register his given name in the U.S. for electronic cigarettes. Through his entity, UGP LLC, Uberto filed applications for "By Uberto Gucci" in stylized form depicting Uberto's signature, and for a design mark comprising the Gucci family crest overlaid with Uberto Gucci's signature. Gucci America, Inc. opposed registration of the Uberto Gucci applications as confusingly similar to Gucci America's famous GUCCI mark, for which it holds numerous registrations in standard characters and in various stylized and design forms for a wide variety of goods and services. *Gucci America, Inc. v. UGP, LLC* (TTAB Opp. Nos. 91223733 and 91223735).

In July, the Trademark Trial and Appeal Board (TTAB) ruled in favor of Gucci America, Inc., finding a likelihood of confusion between the "Uberto Gucci" logo marks and the "exceedingly strong, famous" GUCCI trademark. The TTAB reasoned that:

Because Opposer's GUCCI and GUCCI "signature" marks are exceedingly famous and strong, Applicant's marks contain GUCCI preceded by the personal name of an individual "known" [to] be a member of Opposer's founder's family, the scope of products offered under Opposer's marks is so vast, and electronic cigarettes are sometimes marketed as luxury

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or fashionable items, including under infringing GUCCI marks, consumers could believe that Applicant's goods come from the same source as, for example, pens offered under the GUCCI mark . . . or essential oils for personal use offered under the FLORA BY GUCCI mark. . . . Confusion is therefore likely.

Another Gucci descendant – Paolo Gucci, a grandson of Guccio Gucci – was permanently enjoined from using his name as a trademark or tradename. Paolo licensed his name to an Italian company for which he designed handbags and leather goods following his termination and removal as a director from the Gucci entities that he was involved with for over 25 years. The court allowed him, however, to use his name solely to identify himself as the designer of products sold under other trademarks provided that the name Paolo Gucci always appears after the other trademark and includes a disclaimer notifying consumers that he is no longer affiliated with the famous Gucci brand. *Paolo Gucci v. Gucci Shops, Inc.*, 688 F. Supp. 916 (S.D.N.Y. 1998).

In 2009, Paolo Gucci's wife, Jennifer Gucci, and their daughter, Gemma Gucci, were permanently enjoined in the U.S. from making any commercial use of their names and from registering or attempting to register the JENNIFER GUCCI and/or GEMMA GUCCI name for coffee, bedding, housewares, cosmetics, hosiery, handbags, wine, and gelato. *Gucci America, Inc. v. Gucci*, No. 07 Civ. 6820, 2009 U.S. Dist. LEXIS 124888 (S.D.N.Y. Aug. 5, 2009).

Moreover, even if you think your name is unique, there could be others with a similar or identical name. By way of example, reality television star Kylie Jenner's application to register KYLIE JENNER for use in connection with clothing was rejected as confusingly similar to prior registration of KYLEE for clothing owned by MIMO Clothing Corp. Jenner petitioned to cancel MIMO's registration based on

abandonment and ultimately overcame the refusal when MIMO's registration was cancelled.

Kylie Jenner also faced opposition to her applications for KYLIE for entertainment and advertisement services, and KYLIE COSMETICS for cosmetics, by the famous performing artist Kylie Minogue. Minogue, who released her eponymous first album "Kylie" in 1998 – a decade before Jenner was born – owned trademark registrations for KYLIE for entertainment services and KYLIE MINOGUE DARLING for cosmetics. It appears that the parties privately settled their differences and Jenner's applications were unaffected.

Is your name protectable as a trademark?

Whereas famous namesake brands are afforded a broad scope of protection under U.S. trademark law, as exemplified by the Gucci examples above, newer personal name labels may face obstacles in even obtaining a federal trademark registration. If the brand name is *primarily merely a surname*, it is not even registrable on the Principal Register unless it has obtained trademark significance in the minds of relevant consumers, typically through extensive use over many years.

Here are a few examples of marks that were denied trademark protection in the U.S. on the ground that each is primarily merely a surname:

- HECHTER for clothing, bags and accessories designed by French designer Daniel Hechter;
- WEISS WATCH COMPANY, which incorporates the surname of founder and head watchmaker, Cameron Weiss; and
- ROGAN for clothing, bags and accessories designed by Rogan S. Gregory. Notably, ROGAN was later registered when the applicant demonstrated that the mark had acquired secondary meaning.

Are you willing to cede control over your own name?

No matter how creative your parents were in naming you, there are drawbacks to turning your personal name into a fashion brand. Most notable is the potential to lose control over or be restricted in the use of your name and likeness as a brand in the event of an acquisition or a separation from the company. A transfer of rights or interest in or ceding of control over the brand to a third party (or to a friendly entity in which you don't have full ownership) could diminish your right to use and/or control the use of your name and likeness. This could include giving up domain names and social media accounts for your personal name, and ceasing any uses that could be confused with the use of your name as a brand by the company. In jurisdictions that recognize moral rights (notably *excluding* the U.S.), designers may be able to retain at least the right of attribution with respect to past designs.

Following a sale of an eponymous brand, designers who wish to continue selling their designs should be prepared to conceive of and launch a new brand. For example, Catherine Malandrino and Joseph Abboud unsuccessfully sought to continue selling their designs under their personal names following the sale of their brands and trademark rights to unrelated third parties. Similarly, when designer Katherine Noel Brosnahan, known professionally as Kate Spade, sold her interest in Kate Spade LLC in 2006, she also sold the namesake Kate Spade trademark. A decade later, Ms. Brosnahan – who then called herself Kate Valentine Spade – launched a new fashion brand called Frances Valentine, which combined the first name of her daughter, Frances, with her grandfather's middle name, Valentine.

The recent death of Brosnahan raises another important consideration when using your personal name as a brand on your fashion designs – what happens to an eponymous mark after the designer's death? The answer is complex, and can implicate

both federal trademark laws and state right of publicity statutes. In the case of Kate Brosnahan, the new owners of the trademark rights in the name Kate Spade can continue to use and exploit the name and obtain trademark registrations without Ms. Brosnahan's consent (which was required while she was living).

Tips for Naming a Fashion Brand

In view of these and other risks associated with namesake brands, here are some points to consider in selecting a brand name:

- Choose a fanciful or arbitrary mark. A fanciful mark has no meaning other than as a mark. An arbitrary mark has no meaning in relation to your goods or services.
- A nickname may pose fewer obstacles than your legal personal name.
- Avoid names that are primarily surnames, even if not your own.
- Conduct clearance on your name, even if you have been using it without objection from any third parties. Registering domain names and social media accounts for your brand is easier if the brand name is not a name shared with others.
- Consider the impact that using your personal name may have on members of your family.

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