he wheels of American commerce would grind to a halt without trademarks, since trademarks distinguish the products of one manufacturer from the similar products of another. This is as true for record companies as for toothpaste manufacturers. As long as you can’t look at a CD or a cassette and see what it sounds like, trademarks will continue to be almost as important to the music business as copyrights. No one walks into a record store and asks simply to buy a record. More so than with most other products, records, tapes, and concert tickets are requested and sold by name—the name, that is, of the performer. In the recording industry, the music sells the album, but the trademark lets you find the record you want to buy. Consequently, trademark infringement lawsuits are a very serious matter for anyone unlucky enough to be either a plaintiff or a defendant in one.

BY L. LEE WILSON
A trademark is a word, phrase, sound, or symbol that represents in the marketplace the commercial reputation of a product or service. (Capital letters are used to indicate the precise verbal content of the trademarks discussed.) The most important trademarks in the music industry are the names of bands, individual performers, and record companies. These names come to mean something to the consumer; when you ask for the latest GUNS 'N ROSES album, you won't be satisfied by Tony Bennett's Greatest Hits, and when you check the newest ALLIGATOR RECORDS releases, you're not looking for WINDHAM HILL.

Every record or concert ticket sold, in the United States and elsewhere, is marketed in conjunction with one or more trademarks and is bought because those trademarks guide the consumer to that particular record or ticket. Consequently, trademark owners are usually quick to act against anyone who infringes their valuable marks. That means that a very efficient way to get yourself sued is to adopt a trademark that already belongs to someone else.

Because copyright does not protect song titles, many music industry professionals incorrectly assume that there is no protection available for any name. Often trademark disputes arise because trademarks are chosen solely on the basis of their artistic merit and the image they will create in the media, with no attention to the possibility that the new trademark will infringe an established one. Whether you knew that by using your new mark you were infringing someone else's rights is immaterial; ignorance of trademark law will not save you from an infringement lawsuit if you step on the toes of a trademark owner who is determined to protect an established mark.

Imagine this scenario: after a lot of hard work and three years of playing small clubs, your band, THE BOOMERS, gets some attention from a major record label, which offers you a recording contract. For the first time since you and the other members of the band quit your day jobs, you have the chance to make big money from your music.

Then, your manager calls the day after you hear that the first single released from your new album will be number seven with a bullet on next week's BILLBOARD chart. He tells you that you and the other members of your band and your record company have been sued in federal court for trademark infringement. It seems that some band in Los Angeles has performed for seven years under the name THE BOOMERS and owns a federal trademark registration for that name. The Los Angeles BOOMERS are asking for damages, the profits from your album, and an injunction that would force your record company to freeze distribution of the single and pull all previously-distributed records off record store shelves. They also want to stop you from performing or releasing records under the only name by which you have ever been known as a band.

The saddest news of all is yet to come. Your lawyer tells you that because they have been using their name four years longer than you have used yours, the best thing to do is to bite the bullet and settle with the Los Angeles band. This means abandoning the name you only thought you owned and building a following for your band under a new name.

None of this had to happen. Trademark disputes can almost always be avoided by paying attention at the right time to a few simple considerations.

In the United States, trademark rights are acquired by use of the trademark. Trademark registration only enhances the rights trademark owners gain by using their trademarks. This means that the first person to use a trademark acquires rights in that trademark superior to those of anyone who later uses the same mark. The rights so acquired are roughly commensurate with the geographic scope and variety of commercial uses of the mark. That is, a band with a major label recording contract that tours and sells tickets, records, and T-shirts throughout the United States has a strong claim to its name. Any such band is much better able to halt anyone else's use of its name (for a band, records, or promotional clothing) anywhere in the United States than a teenage garage band that has never played outside its hometown or released any records other than the eleven homemade tapes it sold last weekend.

Trademark infringement occurs when someone chooses a name for a new product or service that is too similar to a name that has been used longer for the same product or service. When consumers are likely to confuse the new name with the older, established trademark because of the similarities between them, a "likelihood of confusion" is said to exist.

The similarity between marks is gauged by what is called the "sight, sound, and meaning test." That is, the new name is compared to the established mark for similarities of appearance, sound, and meaning. If the marks are so similar that the average buyer is likely to confuse the products or services the marks name, or to believe they're somehow related, the new name infringes the older mark.

The first way to avoid infringing an established trademark is to consciously avoid choosing a name identical or
similar to another trademark that somebody is already using for a band or any music-related product or service. More than a few trademark infringement lawsuits have been filed because someone who heard a good name decided that if a name had worked before, it would work again. And changing a few letters in the name or spelling it differently or even combining it with other words won’t eliminate the problem. It’s just not that simple.

A few examples of “confusing similarity” will give you an idea of the degree of similarity between trademarks that constitutes infringement.

The appearance of a trademark is very important in gauging infringement. Naming your band JINXS (pronounced “jinks”) will get you into trouble with the well-known group INXS (pronounced “in excess”). Even though the two names have very different meanings and don’t sound alike when spoken, their appearance in print, and on album covers, would be very close. Further, INXS is an unusual name and the band that owns it is famous. It’s dangerous to get too close to unusual trademarks that name famous products or services because the “name recognition” of famous marks is so high that people are likely to mistake similar marks for the famous ones.

In fact, some trademarks are so famous that anyone who uses them for any product or service will incur the wrath of whole platoons of trademark lawyers. That’s why you can’t call your band THE PEPSIS or THE OREOS or THE XEROX MACHINES. If you do, Pepsi or Nabisco or Xerox is going to send you a “cease and desist letter” telling you that you are “diluting” its famous trademark and demanding that you immediately cease any use of the infringing mark and desist from any further use of it. The next step after a cease and desist letter is a lawsuit in federal court, which you will lose.

The way a trademark sounds when spoken is a very important factor in evaluating infringement. A recording artist who performs and releases albums as LA DONNA is going to hear from the lawyers for MADONNA, even if she is a sixty-year-old black gospel singer who can’t dance and never made a video. And even if ANDY TRAVIS is his real name, he can’t perform under that name without encountering some strong opposition from RANDY TRAVIS. Sound-alike names, especially in an industry that depends on radio for a large part of its revenues, always create problems. Even if the new name looks different from the established trademark in BILLBOARD, if it sounds the same on the air, the new name has to go.

The meanings of trademarks can create problems in ways that sometimes surprise their owners. We already have RHINO RECORDS, ALLIGATOR RECORDS, FLYING FISH RECORDS, AND SPARROW RECORDS. That means that HIPPO RECORDS, CROCODILE RECORDS, BIG FISH RECORDS, and WREN RECORDS are out of the question. These names don’t sound the same as the names of the actual record companies, or look the same in print, but their meanings are close enough for infringement.

Think you’ve got it? Maybe not. It’s important to remember that trademark infringement can jump product or service categories. If the product or service named by the new trademark is similar or even related to that

People with money ... can afford to sue and they want to protect the goose that laid the golden egg.

named by the established mark, infringement can result. For example, PEARL manufactures drums, not guitars, but anyone who tries to name a new line of electric guitars PEARL will encounter serious opposition from the drum manufacturer. Because PEARL is so well-known as a manufacturer of drums, consumers could easily assume that PEARL guitars were simply a new product from the makers of PEARL drums. Drums and guitars are very different products, but trademark law thinks they are both simply “musical instruments” and would allow the Pearl Corporation to win a trademark infringement suit.

The same is true for kinds of music; trademark law classifies rock, rap, hip hop, jazz, rhythm and blues, country, and classical music in the same category. All music is “similar” to all other music, at least in the eyes of trademark lawyers. A new gospel group that named itself THE EURYTHMICS would get into trouble just as quickly as any pop group that adopted the name. Consumers might not mistake the music of the identically named bands, but they could confuse the names in ads for concert tickets, club appearances, and record stores. And record store buyers, music columnists, radio stations, and owners of clubs and concert halls would have a hard time distinguishing the “Sweet Dreams” EURYTHMICS from the brand-new, same-name gospel group on their orders from record distributors, in their columns, on their playlists, and in their bookings.
If you think none of this stuff concerns you, think of it this way: nobody ever fights over an unsuccessful project. If you never get a record deal and never make any money from your songs, you may escape the notice of anyone who could sue you for trademark infringement. But if you're chasing gold records and hope to catch one, remember that you'll look like a more attractive defendant just as soon as you have some money.

People with money also make better plaintiffs, both because they can afford to sue and because they want to protect the goose that laid the golden egg. This means that the more famous the trademark, the more vigilant its owners will be to halt any infringement; under U.S. law, they can actually lose their rights in their mark if they don't enforce them. And the bigger the song, movie, or book, the more determined its owners will be to protect their valuable rights in its title or in characters' names or slogans. In other words, don't step on the toes of anyone who is big enough and rich enough to squash you.

A band's name (its trademark) is arguably more valuable than its musical ability. Although your musical ability will create the demand for your records and concerts, it's your name that will guide your fans to your records and your shows and their money to your pockets. Every single person who buys your albums will find them in a record store bin behind a divider imprinted with your name. And every single one of the people who buy tickets to your concerts will say something like: "Give me two tickets to the DANCEARAMA concert" before sliding a couple of twenty dollar bills across the counter to the ticket agent.

It takes talent, guts, and a lot of hard work and luck to create your own unique identity in the music marketplace. But hard work and talent aren't enough. At every stage of your metamorphosis from opening act to main attraction, you must protect your identity from the imitators who try to hitch a ride on every rising star. Otherwise, nobody will ever stand in line for tickets to hear you play, because no one will know who you are or why you're different from the thousands of other bands born in U.S. garages every year.

Choosing the right name is critically important to the success of your band because in order to own your name exclusively, you must create a name that can be protected from trademark infringers. This is important both now and later. Before your name has become a household word, you need to make sure that you're the only band using it in order to ensure that whatever reputation you're able to build is yours alone, unencumbered by the good or bad music of any competitor with a similar name. When you've become famous, you'll have even more reason to want to stop trademark infringers, because by then your band's name may represent hundreds of thousands of dollars of record and ticket sales every year.

The most important step in protecting your trademark is registering it, because trademark registration makes stopping infringers much easier. There are two sorts of trademark registration: federal trademark registration, which is not easy to obtain but which offers significant benefits to the owners of registered marks, and state trademark registration, which is easy to obtain but confers fewer benefits. Most trademark owners want to register their marks federally, that is, with the U.S. Patent and Trademark Office, because federal trademark law has much more clout than is available under any state trademark law. Because federal registration is the goal you should aim for, when we discuss "trademark registration," we'll be referring to federal trademark registration.

You already know how to avoid the headaches that can result if you step on someone else's trademark; you also need to know how to protect your own name. If you become a successful band, or even if you don't, you need to be able to protect your trademark against the encroachments of trademark infringers, who come in several distressing varieties. There is the innocent infringer, the band that hits on your name by accident, performs under it in clubs, and presents a big problem to you and your booker, who keeps encountering club managers who never want to book your band again because the other band can't sing and can't dance. Just as dangerous is the band that adopts your name and becomes more famous than you. How are you going to convince
fans, club owners, or record companies that you own your name and that the other band is infringing your rights, rather than the reverse? Then there are the true trademark villains, the T-shirt pirates who show up outside every venue where famous bands play to sell counterfeit shirts to fans; they'll pocket everything they can earn from the popularity of your name, and they're hard to stop because they're fast and sneaky and move around a lot.

Protecting your trademark usually means threatening to sue infringers. If you've registered your trademark, a nasty letter from your lawyer is probably going to stop every sort of infringer except truly determined T-shirt pirates, because most lawyers will advise a client who receives a cease and desist letter from the owner of a federally-registered trademark to find another name—this afternoon. Further, your federal registration means that your mark will start turning up in the trademark searches other people commission. That is, any band that commissions a search for a name similar to yours will find out that your name is definitely unavailable and will choose instead a name that won't become the subject of a trademark infringement lawsuit. In other words, registering your trademark will actually have the result of diminishing the possibility that you'll have to go to court to protect your ownership of your name. Anyone who has ever been involved in any kind of lawsuit will tell you that this is a very big advantage.

If you do have to sue to protect your trademark and you have registered it, you can recover the profits of the infringer, the costs of bringing the infringement suit, attorneys' fees (sometimes), and up to triple the amount of damages the infringer caused you. T-shirt pirates and other real evildoers (as opposed to ordinary infringers who somehow blunder into infringing your trademark) can also be subject to criminal penalties for ripping off a registered trademark.

But trademark registration is not as easy as copyright registration. When you apply to register the name of your band, you are, in effect, asking an agency of the federal government to give you a nationwide monopoly on that name. Filing a registration application with the Trademark Office sets in motion a complicated process called the "examination" of your application. Your application must prove you're entitled to receive a registration; to do this it has to comply with requirements set out in the U.S. trademark statute, in trademark court decisions, and in regulations of the Trademark Office.

The toughest of these are the restrictions on trademark registrability set out in the trademark statute. They're the only ones you really need to know about. The others will be the concern of the lawyer who prepares and files your registration application; however, since your lawyer can only work with the name you choose, the rules that govern which names are eligible for registration are really more your concern than your lawyer's. Ignorance of these rules is not bliss, since you're most likely to bump up against these restrictions on trademark registrability only after you've begun to use a mark that proves to be unregistrable. Consider this dilemma from the perspective of a band.

Let's suppose you're forming a new group with your brother and three cousins. Before you can commence your brilliant career, you have to choose a name. You have a beer together one evening after rehearsal and each of you comes up with a name you like. The favorites are:

- BAND IN BOSTON (your cousins live in a suburb of Boston and you and your brother are in college there);
- BREAD AND ROSES (proposed by your cousin the history major, who knows that "Bread and roses!" was the cry of striking 19th century Massachusetts mill workers);
- THE WALTONS (Walton is your shared surname);
- HARVARD DRINKING SQUAD (you and your brother, who also goes to Harvard, think this one is hilarious); and
- F.U.C.T. (the name proposed by your cousin Isaac, who is a little strange).

Because you know your band could spend the proceeds from its first gold record defending against a lawsuit for trademark infringement if it adopts the wrong name, you consult your friendly neighborhood trademark lawyer, Fred. You're amazed when Fred tells you that none of the five names you like is a keeper. You ask in an indignant tone just why he is so eager to see you discard the five great names you culled from hundreds of possibilities when you expected him to recommend a trademark search for one of them. Fred explains that although it is extremely important to make sure the name you adopt for your band is available for use, you'd be wasting your money on a search for any of your five proposed names, because they are all unregistrable.

You ask Fred what he means by "unregistrable." He says the Trademark Office will deny federal registration to some trademarks because of certain characteristics of the marks themselves. Then Fred demolishes your list of hit band names one by one.

It seems that BAND IN BOSTON is what's known as a "descriptive" mark. That is, it says what it is, according to Fred. You tell him that if he had any sense of
humor he would recognize it as a pun: “banned in Boston.” Fred says it’s immaterial whether or not he has a sense of humor because the Trademark Office does not; it is, in fact, very literal-minded and would not grant a registration to a Boston band for the name BAND IN BOSTON because doing so would prevent any other “band in Boston” from using those words to describe itself. Further, says Fred, any trademark that uses a geographic term is suspect as far as the Trademark Office is concerned because, for example, the Trademark Office can’t go around giving one restaurant the exclusive right to use NEW ENGLAND FISH HOUSE or OLDE VIRGINIA HOME COOKING or RIO GRANDE CHILI PARLOR because there is more than one fish house in New England, more than one homestyle restaurant in Virginia, and more than one chili parlor on the Rio Grande.

You’re not sure you understand what Texas chili has to do with a band in Boston, but you think Fred knows his stuff, so you ask him why BREAD AND ROSES won’t work.

Fred says BREAD AND ROSES is not only unregistrable, it is also downright dangerous to use. You make a rude noise and ask Fred if he’s a total ignoramus, since he seems not to know that “Bread and roses!” was the cry of striking 19th century Massachusetts millworkers. Fred says it doesn’t matter, because, as a band name, it is confusingly similar to a trademark Fred is sure must be registered already—GUNS ’N ROSES, and the Trademark Office will not grant a registration to any trademark that is confusingly similar to a previously registered mark used for the same goods or services. Fred tells you that besides being unregistrable because of its confusing similarity to GUNS ’N ROSES, BREAD AND ROSES would also subject you to a lawsuit for trademark infringement from GUNS ’N ROSES.

Fred says THE WALTONS will be denied registration because it’s the surname of every member of the band and is, therefore, another kind of descriptive trademark. Fred says that the Trademark Office does not register surname marks until those trademarks are famous. He explains that because there are thousands of Waltons in the United States, the name THE WALTONS could refer to any of the other Waltons, and would not function as a trademark, that is, would not point to you and your brother and cousins as the particular source for your musical entertainment services, until you had made such a name for yourself that no one thought of anyone but you when they heard or read the name THE WALTONS.

You tell Fred that you intend to become famous pretty quickly and can wait for trademark registration, but he shakes his head and says that as soon as you become famous enough as THE WALTONS to qualify for trademark registration, you will come to the attention of the producers of the television show THE WALTONS, who will sue you for trademark infringement and unfair competition. You tell him he’s been watching too many reruns, that the television show THE WALTONS was canceled years ago. Fred says he has been watching reruns, and so have millions of other people every day all over the country, and when they hear the name THE WALTONS they still think of John-Boy and Jim-Bob and the others, not of you and your brother and cousins. He tells you this means you and your kin can use THE WALTONS on your mailboxes, but not as the name of a band.

Fred is just as negative about the name HARVARD DRINKING SQUAD, which he does not think hilarious. He says the name is unregisterable for two reasons. He tells you that the first thing the Trademark Office will ask if you apply to register this name is whether you’re Harvard University or have permission from Harvard to use its name as a part of your band’s name. Since neither of these two prerequisites for registration is likely to come to pass, Fred says you would be denied registration because the Trademark Office cannot register a mark that falsely suggests a connection with the institution.

He goes on to say that the Trademark Office would also consider HARVARD DRINKING SQUAD unregisterable because the name would have the tendency to tarnish the dignity of the august university, another rule about trade-

In addition to determining that your new trademark will not infringe an established mark, it’s also important to consider whether the name you choose will be eligible for federal trademark registration.
loosen up, that none of your friends would think F.U.C.T. was so bad. Fred reminds you that the Trademark Office is considerably stuffier than your buddies and is generally not able to be jollied into disregarding its many rules governing the registration of trademarks, which you must be written down in a book the size of Wyoming. Fred reminds you that it doesn't much matter what you think, because the Trademark Office is the government and you're not, and unless you want to put your nearly-completed degree in political science to work to start an alternative government, a step that has been known to get people shot for treason, you'll have to cope with U.S. law as it exists.

The following week, you and the band have Fred search the name EARTH 2 MARS. He commissions a trademark search service to search its databases for similar names for bands and music-related goods and services, both those that are registered in the U.S. Trademark Office and those that are in use but unregistered. When he examines the data the search service compile in a search report, Fred gives you the go-ahead for EARTH 2 MARS. It appears that no one has beat you to it and that the name is yours to use. You also apply for federal trademark registration the week your band debuts in a "battle-of-the-bands" showcase, because you believe Fred when he says coming up with a registrable and protectable trademark is not an easy thing to do and you want to be sure that the name you adopt and build a reputation under is yours as long as you want to use it.

The moral of this little tale is that, in addition to determining that your new trademark will not infringe an established mark, it's also important to consider whether the name you choose will be eligible for federal trademark registration. In fact, choosing a registrable trademark should be your first concern, since an unregistrable trademark may also be much harder to protect; that is, you may have a harder time preventing others from using or imitating it.

The federal trademark statute governs the sorts of trademarks to which the Trademark Office may grant registration. There are nine reasons the Trademark Office will reject your application to register the name (or logo) of your band; all of them have to do with the inherent characteristics of your trademark. They are:

- **The name or logo does not function as a trademark, that is, does not act in the marketplace to identify the source of your services as a band.**

This restriction is often cited when someone tries to register a symbol that decorates a product without actually acting as a "brand name" for it. Bands are most likely to encounter this restriction with applications to register their logos if they are used more as ornaments than trademarks. For example, a band called THE PTERODACTYLS may use a drawing of the flying dinosaur in the background of its album cover art; the Trademark Office will consider this a non-trademark use of the mark and will not grant THE PTERODACTYLS' application to register their logo. If the band uses its pterodactyl logo on T-shirts, caps, and tour jackets and sells these items at its performances, the Trademark Office will register the logo for clothing. Using the logo in association with the name THE PTERODACTYLS in ads for the band's concerts would enable the band to register the logo for entertainment services.

- **The name (or logo) is immoral, deceptive, or scandalous.**

Usually, bands and performers have to worry mostly about the "immoral" and "scandalous" parts of this restriction. Some names that are slightly risqué will be granted registration, but a name that is truly offensive will not. Before you cry "First Amendment" and "government censorship," bear in mind that the Trademark Office will not, no matter how much it hates your band name, tell you not to use it; your government just draws the line at registering any "immoral, deceptive, or scandalous" name. But maybe you don't want to choose a really offensive name for your band, anyway, because many clubs and concert halls and radio stations will hesitate to use your name if it is really smelly, and it is possible that someone at your eventual record label will object to it, although record labels are not known for their sensitivity and politeness. To be rejected for registration on this ground, a name has to be to be rejected. Usually double entendres, obscure sexual slang, and all but the most shockingly vicious phrases or symbols will pass muster with the trademark examiner, even though it is the examiner's job to review your application and try diligently to figure out why not to grant it.

The "deceptive" part of this restriction is usually not much of a problem for bands unless the band is already going to be in hot water with somebody anyway. For instance, if you get the bright idea to call your band SONS OF METALLICA because you think you sound like METALLICA, the Trademark Office will deny your application to register that name on the ground that, because you have no connection whatsoever with METALLICA, your name is "deceptive" (and maybe on...
some other grounds that we discuss below). But by the time this rejection reaches you, you will have been sued for trademark infringement by the able lawyers for METALLICA.

- The name (or logo) disparages or falsely suggests a connection with persons, institutions, beliefs, or national symbols or brings them into contempt or disrepute.\(^\text{23}\)

This restriction is similar to the “immoral, deceptive, or scandalous” restriction. If you'll recall, this is the reason EARTH 2 MARS was not named HARVARD DRINKING SQUAD. For example, if you want to call your band TRICKY DICK in honor of the only U.S. president ever to resign from office, that's your business, but the Trademark Office may deny your application to register that name on the ground that it disparages Richard Nixon. It doesn't matter that TRICKY DICK is merely a nickname for Richard Nixon. It doesn't even matter that he is now deceased. And your arguments that Mr. Nixon's reputation would be hard to hurt aren't going to make the slightest difference to the Trademark Office.

Applications to register names that suggest nonexistent connections with particular well-known institutions will also be denied. For instance, the Trademark Office would not grant a registration to a band called THE F.B.I.; call your band G-MEN, though, and you may be able to register the name. Ditto for SEARS AND ROEBUCK and TEXAS MARSHALS—neither of these names is registrable because they belong to Sears and the Texas Marshals; call your band MALE ORDER or FRONTIER JUSTICE, however, and you, too, can be the proud owner of a registered trademark.

And no matter how clever and ironic you think it is, the Trademark Office will refuse to register any name or logo that disparages any belief or national symbol. If you're a group of Jewish cantors who sing traditional Jewish songs at wedding receptions you may be able to call yourselves STARS OF DAVID and convince the Trademark Office to register the name, since your use of it would not be disparaging. However, you won't be able to register that name for any rock or metal band or register the familiar six-pointed Star of David as a part of a band logo without running into some trouble from the Trademark Office, which could reasonably interpret your use of the name or symbol as disparaging. The same goes for crucifixes; Madonna may wear them as jewelry and decorate her videos with them, but she would have a hard time registering one as a trademark. Any attempt to register any name or symbol that the adherents of any religion hold dear will encounter the same obstacle.

This is the rule for Eastern religions as well as more familiar Western belief systems; for instance, four fat boys who try to register the name THE BUDDHAS for their rap group will be chased ignominiously from the imposing premises of the Trademark Office after a stern lecture from His Highness the Trademark Commissioner on respecting other people's religious beliefs, despite their piteous pleas that they meant no disrespect.

All this is also true for “national symbols.” If you try to register as your band trademark a logo depicting Uncle Sam wearing red lipstick and rouge, white theatrical makeup, and blue eyeshadow, the Trademark Office will turn you down, even if your only goal in turning Uncle Sam into a female impersonator was to make him look like you and the other members of your pretty-boy band, because your manner of using this famous American symbol will be interpreted by the Trademark Office as bringing it into “contempt or disrepute.”

- The name (or logo) consists of or simulates the flag, coat of arms, or other insignia of the United States or of a state, municipality, or foreign nation.\(^\text{24}\)

The American flag, for instance, belongs equally to every American citizen. Since trademark registration gives the registrant the exclusive right to use the registered mark, the trademark statute prohibits the registration of any mark that consists of the American flag. This doesn't mean you can't use the American flag as a part of your logo; you just can't register your flag logo as a trademark. If your logo includes the American flag only as a small part of a larger design, you may be able to register the entire design by disclaiming any exclusive right in the flag portion of it.

The same goes for other official symbols from just about everywhere. A reggae group called THE BAHAMANS cannot register the Bahamian flag. Neither can a cowboy band called THE LONE STAR BAND register the state flag of Texas as its logo.

- The name (or logo) is the name, portrait, or signature of a living person who has not given consent to the use of the name, portrait, or signature as a trademark or of a deceased president of the United States during the life of his widow, unless she has given her similar consent.\(^\text{25}\)

This is an easy one to understand. How would you feel if you woke up one morning and found that the Trademark Office had given somebody else the exclusive
right to use your name for a band without your permission? You'd be steamed, right? Well, everybody feels the same way, which is why you have to prove to the Trademark Office that any living person after whom you name your band consents to that use before you can register his or her name as the name under which you perform. You can call your jazz group JELLY ROLL after the great Jelly Roll Morton or name your singing duo GILBERT AND SULLIVAN after the famous English composers of comic operas or perform under the stage name LUDWIG VAN BEETHOVEN after the famous classical composer because all these musical gentlemen are now playing harps under long-term engagement.

(A caveat, however. Be very careful about adopting the name or even the nickname of any famous figure who died after, say, 1900. There is something called the “right of publicity” that famous people acquire with their fame, and sometimes it can be inherited. Basically the “right of publicity” is a celebrity's right to be the only person who profits from the use of his or her famous name. This means you should be very careful about naming your act after any celebrity of this century, alive or dead. This is all you need to know about the “right of publicity” until you yourself are a celebrity, at which time some sharp entertainment lawyer who went to school for about 20 years will be glad to tell you more.)

Remember that this restriction applies even if you’re one of the band members. Honest. Without Tom Petty’s and Bob Seger's permission, TOM PETTY AND THE HEARTBREAKERS would have to register its name as THE HEARTBREAKERS, and BOB SEGER AND THE SILVER BULLET BAND would become just THE SILVER BULLET BAND.

So much for living people. The dead presidents restriction is sort of a leftover from when companies were likely to name their products after popular politicians in an effort to appeal to the people who made the politicians popular—you know, “TEDDY ROOSEVELT MOUSE-TACHE WAX.” This restriction is of less concern to performers than many of the others in the Trademark Office’s long list of types of unregistrable marks, but it could play a role in your choice of a name for your band. For instance, you could not have registered the name JFK during the lifetime of Jacqueline Kennedy Onassis without her permission. The trademark statute doesn’t say what happens if the dead president is female; presumably, her widower would have to consent to any use of her name. Apparently the men (they were men) who wrote our trademark statute back in the forties thought that the possibility of a woman being elected president was so slender as to be non-existent, so they specifically worded the statute in terms of deceased male presidents.

- The name (or logo) is confusingly similar to a trademark that is already registered with the U.S. Patent and Trademark Office for a band or performing group.

The test the Trademark Office uses to determine whether your mark is “confusingly similar” to a registered mark is the same “sight, sound, and meaning” test. Judges apply the test to determine whether the plaintiff has grounds to complain about the defendant’s use of its name. However, the only thing the Trademark Office will do if you adopt a name that’s too close to a registered trademark is deny your application to register your name. It remains the job of the owner of the registered mark to sue you.

- The name (or logo) is merely descriptive or is deceptively misdescriptive of the services to which it is applied.

This restriction is the main reason Fred nixed BAND IN BOSTON. The trademark statute prohibits the registration of marks that are “merely descriptive” (also known as “generic marks”) because it would be unfair to give one person the exclusive right to use what are essentially ordinary words used in an ordinary way for services or products that those words simply describe. In other words, if a mark describes what it names, the mark is unregistrable. Some examples will help you understand.

You can't register BLUES BAND as the name for a blues band or RAPPERS for a rap group or SINGING FEMMES for your girl group. (The Trademark Office translates foreign words to determine whether they're descriptive, so using a word from another language won't get you around this restriction. Neither will misspelling words.) BLUES BABIES and RAP IT UP and FEMMES FATALE might work, however, because they don’t so immediately convey the nature of what they name.

Marketing people hate this restriction, since they often think the best names describe what they name. It’s easy to see that this is not so. Actually, the best trademarks suggest what they name without describing what they name. That is, at least a small leap of the imagination is required to connect them with the products or services they name.

In fact, the most protectable marks are completely arbitrary, with no relation at all to what they name. Think of R.E.M., GENESIS, NED'S ATOMIC DUSTBIN, NIRVANA, PEARL JAM, and NINE INCH NAILS; these
names, by themselves, don't tell you anything about what they name. But you remember them. And they are registrable and protectable. Ever since bands starting naming themselves THREE DOG NIGHT, JEFFERSON AIRPLANE, STRAWBERRY ALARM CLOCK, and THE GRATEFUL DEAD, the trend has been toward names for rock groups that don't mean anything in particular. Stick with the trend and you'll be able to register your mark. And protect it.

The "deceptively misdescriptive" half of this restriction is akin to some of the other restrictions mentioned above, which are designed to discourage the adoption of misleading or distasteful marks by denying them registration. A "deceptively misdescriptive" mark is a name that describes what is in the mark, but falsely. The restriction against registering deceptively misdescriptive marks is intended primarily to discourage manufacturers from choosing misleading names like LEATHERCRAFT for a new line of vinyl sofas or SILKSHIRT for polyester blouses, but it should not be disregarded in choosing the name of a band. This restriction is most likely to be of concern to manufacturers of cheese and wine and other products tied to certain regions than it does to people who make music, but it can have an effect on innocent musicians like you who didn't even know it existed.

Translated into music industry terms, this restriction means you have to be careful about using the name of a state, city, or region in your band name, even if you do expect to become your hometown's big contribution to American music. Rock bands and other sorts of pop groups are not immune, but country bands are particularly prone to name themselves after the landscape; THE TENNESSEANS, THE ROCKY MOUNTAIN BOYS, THE MISSOURI JUG BAND, and KENTUCKY BLUE GRASS are all going to be turned down by the Trademark Office if they try to register their names. (At least until they become as famous as ALABAMA or KANSAS, that is. When a very famous band name, even one that the Trademark Office otherwise considers unregistrable, comes to signify only the group it names to the public, it becomes registrable because, in effect, its fame enables it to escape the anonymity inherent in a geographic name and function as a trademark.)

If you use a geographic term in your name but have no connection to that place or region, the Trademark Office could refuse to register your name because it is "geographically deceptively misdescriptive," but, as a practical matter, probably will not cite this as a reason for refusing registration. If your band is not based in the city, state, or region you use in your name, that use of that geographic name is not a description but becomes merely an allusion. The more fanciful the use of the geographic term the better. For example, THE KENTUCKY HEADHUNTERS is a registered trademark because Kentucky is a state devoid of headhunters and because the band that owns the name is not based there. In other words, the name is arbitrary.

Bear in mind that the restriction on registration of geographic marks applies to graphic representations of a state or country in band logos, too. If your entire logo is
the map of a state or some other recognizable representation of a piece of the world, the Trademark Office will deny it registration.

- The name is primarily a surname.

Personal names are not considered distinctive enough in and of themselves to point to a particular source for a product or service when used as trademarks. This is another way of saying that they're "descriptive." Think of it this way: there are millions of people in the United States named Smith; the source of SMITH'S SHOE POLISH could be any of them. Until SMITH'S SHOE POLISH becomes so well-known that it transcends the anonymity inherent in most surname trademarks, all the Smiths in the country could market shoe polish under their shared surname without infringing each other's trademark rights. In other words, surname marks do not work as trademarks until they have achieved something called "secondary meaning," which is a term trademark lawyers use to mean "Everybody knows that trademark because it's famous."

There are, obviously, a lot of famous surname trademarks; many of them have been registered in the U.S. Trademark Office. Think of WATERMAN fountain pens, CAMPBELL'S soups, WILSON sporting goods, or the DOLBY noise reduction system. These marks are registered because they achieved fame enough to function as trademarks.

What all this stuff means to you is that using your last name as the name of your band isn't a great idea. If you do, you'll have some trouble registering your band name until you're pretty well-known, a state the Trademark Office is usually willing to presume has occurred only after you have been performing under that name for five years in interstate commerce, and then only with some extra persuasion from your trademark lawyer. The same goes for band names made up of the last names of the band members. We all know that CROSBY, STILLS, NASH, AND YOUNG, HALL AND OATES, BON JOVI, and WILSON PHILLIPS have done well with their surname marks, but their names became registrable only after they became famous.

Now that you have memorized the Nine Deadly Sins of Trademark Selection, it must be said that there are exceptions to these restrictions. The Trademark Office is not as consistent as you might believe; there are some exceptions to these restrictions that are so complicated, you don't want to even try to understand them. Let your trademark lawyer worry about the fickleness of the government; your job is to make sure that you choose

- A federal registrant has rights in the registered mark superior to anyone else except prior users of the mark.

- The owner of a federally registered trademark is in a much better position to quash infringers than if the mark were not registered, since federal registration offers immediate access to a federal court, where a federal registrant can obtain an injunction with nationwide effect to stop infringers.

- A federal trademark registrant who sues an infringer in federal court may be entitled to recover profits, damages, and court costs, including attorney's fees. In some circumstances, the registrant may be awarded "treble damages," which are damages three times the amount that would ordinarily be awarded.

- Moreover, because a federal registration gives the registrant the benefit of the presumptions that the registrant owns the registered mark and that the registration is valid, registrants who end up in court have a powerful advantage over any challenger who also claims ownership.

- A federal registration serves as "constructive notice" to any subsequent user of the registered mark that the registrant claims ownership of it. In other words, the presence of the registration in the public records of the Trademark Office is presumed to make any other would-be user of the mark aware of prior ownership claims of the registrant. This eliminates any defense raised by an alleged infringer that the mark was adopted in good faith.

- After five years, a registered mark may become "incontestable"; that is, the registration becomes conclusive evidence of the registrant's right to use the mark.

Source: Lanham Act §§7(b)(c), 15, 35(b)
15 U.S.C. §§ 1057(b)(e), 1065, 1117(b)
a name that can be registered, because many unregistrable marks are also all but unprotectable. That is, if you adopt an unregistrable mark, it may be next to impossible to prevent someone else from using your name, depending on the grounds on which the Trademark Office denies registration.

Consult this list of restrictions before you choose a band or stage name. Then get a lawyer to commission a trademark search. And then, because every trademark wants to be registered as soon as possible after it is born, register your trademark, even if you have to use the money you were saving for a new keyboard to pay for it.

The Trademark Office classifies all goods and services according to the International Schedule of Classes of Goods and Services, which includes 42 classifications. The classification of greatest interest to bands and performers is Class 41, “Education and Entertainment Services” (you render “entertainment services” when you perform). Many bands and performers also register their names in Class 9, “Scientific Apparatus” (believe it or not, this is the class that includes records and tapes) and Class 25, “Clothing” (for T-shirts you sell at your concerts and to members of your fan club). The filing fee per class is $245.

There are two types of federal trademark registration: the use-based application, which is based on current use of the trademark in interstate or international commerce, and the intent-to-use application, which is based on a “bona fide intent” to use the mark in interstate or international commerce. This means that you can, and should, apply for federal trademark registration as soon as you make the decision to adopt a trademark, even if you have not yet begun to use it to advertise your performances. Registering your trademark in all three classes strengthens your rights in your mark considerably, but a Class 41 registration is the most important, so if you can’t afford to file three registration applications, file in Class 41 first and worry about the other two classes when you get a record deal and make some money.

Federal trademark registrations endure for a term of ten years. However, because all trademark rights are based on use of the mark, between the fifth and sixth anniversaries of the date a registration is granted, the registrant must formally attest to continuing use of the mark by filing an affidavit describing that use and furnish a new specimen of use of the mark. Further, at the end of the initial ten-year registration period, but no sooner than six months prior to the end of the period, you may file to renew your registration. You may renew the registration for your mark at ten-year intervals as many times as you want, so long as you continue to use the mark. In theory, a trademark can live in perpetuity in the marketplace. There are some trademarks that are still active after a hundred years or more of service in commerce.

It is one thing to know that federal trademark registration is desirable and to know something about the registration process, but filing for federal trademark registration is, like searching a trademark to clear it for use, not a do-it-yourself project. The Trademark Office allows trademark owners to file their own applications for registration, without the help of a lawyer, but satisfying the complicated filing requirements imposed by the Trademark Office is not easy and filing without the help of a trademark lawyer is likely to result in the rejection of the application. Lawyers do have their uses; filing for trademark registration is one of them.

Further, even if you manage to meet the requirements of the Trademark Office for a registration application, you may still be confronted with the need to keep your application on track by filing a response to some complicated objections to registration raised by the trademark examiner who reviews and evaluates your application. That is, even if you managed to file a proper application without a trademark lawyer, it is likely that you still would need to find one, because almost no one who has not done it before can successfully respond to a complicated Trademark Office rejection of an application. Failure to respond will result in the abandonment of your application; failure to respond fully will result in a final rejection of your application.

Federal trademark registration helps trademark owners avoid the necessity of bringing suit to stop trademark infringers in two important ways. First, once a trademark is registered in the Trademark Office, any other companies that conduct searches to clear proposed new marks will know that the registered mark is already in use for the goods and services it names and will stay clear of it or any confusingly similar mark. Secondly, even if some company does infringe the mark, it is likely to agree to stop using the mark immediately upon the receipt of a cease and desist letter from the trademark owner’s lawyer, since the infringer will know that the owner of the registered mark does, indeed, have the clout to prevent the continued infringing use of the mark. These circumstances have the effect of stopping trademark infringement lawsuits at the optimum time—before they start.

This article is adapted from sections of THE TRADEMARK GUIDE and MAKING IT IN THE MUSIC BUSINESS: A BUSINESS AND LEGAL GUIDE FOR SONGWRITERS AND PERFORMERS.

See Lanham Act (requiring use of a mark or intent to use as a prerequisite for registration); Lanham Act at §7(c), 15 U.S.C. §1057(c) (registrant receives right of priority over all but prior users and prior applicants).


See Lanham Act §45, 15 U.S.C. §1127 (abandonment of mark is inferred when (1) its use has been discontinued with intent not to resume, or (2) the mark has become generic for the goods or services it describes). See also Lanham Act at §14, 15, U.S.C. §1064 (abandonment as grounds for cancellation of registration).

See Sheldon H. Klein, Introduction to Trademarks: UNDERSTANDING BASIC TRADEMARK LAW 1998 at 528 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series No. 9, 1998) (state trademark protection is usually easy to secure; it may prevent rivals from registering to do business in the state under the same name).

See id. (Federal registration confers many more benefits than state registration, including: (1) nationwide constructive use, and thus a right of priority over all subsequent users or filers; (2) the ability of the certificate to act as prima facie evidence of the right to exclusive use; (3) the use of the ® symbol; (4) the right to exclude from entry into the U.S. goods bearing a mark infringing on a registered mark; and (5) furnishing a basis for foreign registration under the Paris Convention.)


See Trademark Counterfeiting Act of 1984, 18 U.S.C. §3290(a) (1984) (imposing a maximum fine of $2,000,000 and a maximum sentence of ten years for an individual's first offense, and greater penalties for companies and repeat offenders, in connection with the trafficking and use of counterfeit marks).


See Lanham Act at §20(e)(1) and (f), 15 U.S.C. §1052(e)(1) and (f) (merely descriptive marks only registrable upon a finding of secondary meaning).

See Lanham Act at §20(e)(2) and (f), 15 U.S.C. §1052(e)(2) and (f) (geographically descriptive terms only registrable upon a finding of secondary meaning). See also Lanham Act at §20(e)(3) and (f), 15 U.S.C. §1052(e)(3) and (f) (geographically misleading marks only registrable if acquired secondary meaning before December 8, 1993, pursuant to the North American Free Trade Agreement (NAFTA)).


Lanham Act at §20(e)(4) and (f), 15 U.S.C. §1052(e)(4) and (f) (requiring secondary meaning).

See Lanham Act at §2(a), 15 U.S.C. §1052(a) (excluding from registration deceptive matter which may falsely suggest a connection with an institution).


See Alan I. Cyrlin, Reducing a Company's Risk Over Domain Name Disputes, 81 J. PAT. & TRADEMARK OFF. SOC'Y 42, 60 (Jan. 1999) (discussing the importance of conducting a search of the desired trademark); W. Scott Petty, Warning: Failure to Check Name Availability May be Hazardous to Your Corporate Merger, 5 INTELL. PROP. TODAY 7 (June 1998) (“[t]he task of advising a client on whether a particular trademark is available for use typically includes searches of traditional name databases, such as federal registration and common law names, and a search of Internet domain names”).

See Lanham Act §45, 15 U.S.C. §1127 (requiring that trademark that it “identify and distinguish [one's] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown”).


Id.


See Jerome Gilson, TRADEMARK PROTECTION & PRAC. §2.16(1) (Jeffrey M. Samuels ed., MB 1998) (defining the right as a common law right of an individual to control the commercial use of his or her name, likeness, signature, or other personal characteristics). See also id., at §2.16(4) (discussing the disagreement among the circuits as to whether the right of publicity is inheritable. Three views have emerged: (1) it is always inheritable; (2) it is never inheritable; and (3) it is inheritable only if the name and likeness of the individual were commercially exploited during the individual's lifetime).


See supra note 5.

Id.


Lanham Act at §2(e)(2) and (3), 15 U.S.C. §1052 (e)(2) and (3).


See Lanham Act at §1(a), 15 U.S.C. §1051(a) (establishing elements for a use-based federal trademark registration application).


Id.