

Beyoncé Trademark Case Provides Evidentiary Lessons Before the TTAB

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by Cathy Dahl



Veronica Morales, a wedding/event planner providing services under the trademark **BLUE IVY** (depicted above), has unsuccessfully challenged a pending application for the mark **BLUE IVY CARTER**, filed by BGK Trademark

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Holdings, LLC (**Beyoncé Giselle Knowles-Carter**). The decision contains some helpful lessons on how to pursue a discovery dispute in accordance with Board procedures to ensure that an opposing party's allegedly recalcitrant conduct can be used against it on a trial on the merits. In addition, in attempting to prove an applicant's lack of bona fide intent to use, relying on ill-advised statements made by the husband of the applicant to a reporter – in this case, Jay-Z – is not a recipe for success as an evidentiary matter.

Blue Ivy Carter, the eldest child of Beyoncé Knowles-Carter and Jay-Z, was born January 7, 2012. Ms. Morales filed a trademark application at the PTO for the mark **BLUE IVY** in February 2012 for her event planning services, which registered in October 2012. Ms. Morales claimed first use of the **BLUE IVY** mark in commerce in October 2009. BGK filed an application for the mark **BLUE IVY CARTER** on January 26, 2012, on an intent-to-use basis, for a variety of consumer goods and services. The **BLUE IVY**

CARTER application subsequently abandoned in February 2016 because no evidence of use was filed within the deadline. BGK filed an identical replacement intent-to-use application for the **BLUE IVY CARTER** mark in January 2016, which was approved and published for opposition in January 2017.

Ms. Morales opposed the registration of the **BLUE IVY CARTER** mark claiming: 1) a likelihood of confusion with her own **BLUE IVY** mark for wedding/event planning services; 2) no bona fide intent on the part of BGK to make use of the **BLUE IVY CARTER** mark for the goods/services in the application; and, 3) fraud on the PTO. The Trademark Trial and Appeal Board dismissed all three claims in the Opposition in favor of BGK. Most notably, Ms. Morales failed to establish any admissible evidence that BGK lacked a bona fide intention to use the **BLUE IVY CARTER** mark, and missed an opportunity to compel BGK to respond to discovery requests through established rules of procedure before the Board.

In a trademark opposition, an Opposer has the initial burden to demonstrate by a preponderance of the evidence that an applicant lacked a bona fide intent to use the mark on the identified goods and/or services in a trademark application. One manner in which an Opposer may establish prima facie evidence of a lack of a bona fide intention to use a mark is to show that the applicant does not have any documentary evidence to support its alleged intent to use as of the filing date of a trademark application.

Ms. Morales relied heavily on that argument, and stated that BGK “acted in a recalcitrant and uncooperative manner throughout the case, disclosing no substantive information in response to interrogatories and producing no documents in response to requests for production.” In fact, BGK had objected to all of Ms. Morales’ interrogatories and requests for production, but said that supplementary responses would be provided after the execution of an agreed upon or Board-ordered protective order. A few months later, the Board issued an order providing its standard protective order. BGK never responded to the interrogatories or requests for production in a substantive manner, but said it was due to “Opposer’s misconduct,” Contending that “Opposer used [her] discovery requests as a weapon to pry into the personal life of Mrs. Carter and to threaten and intimidate her.” The Board in its opinion stated that both parties “painted an incomplete picture.”

While the Board issued an order for a standard protective order, the Board also denied Ms. Morales’ motion to compel the production of documents she wanted because she did not make a good faith effort to resolve the discovery dispute between the parties. Ms. Morales had the opportunity to raise the issue of the subsequent unsatisfactory supplemental discovery responses from BGK before the Board, but she did not timely file a renewed motion to compel. If she had filed a renewed motion to compel and the Board had granted the motion, it would have remedied the unsatisfactory responses. *Ms. Morales did not follow the Board’s “clear procedures during discovery and prior to trial.”*

Interestingly, Ms. Morales also pointed to the filing of an identical prior trademark application as bad faith and evidence of no bona fide intent to make use of the mark. The refiling of a new intent-to-use based trademark application for the same mark is not particularly unusual. The Board has found a pattern of bad faith conduct in previous

cases where multiple applications have been filed for the identical mark (16 applications for the same mark, for example), but one new trademark application for the identical mark will not and did not establish a pattern of bad faith conduct.

Ms. Morales also relied on the content an interview of Jay-Z, which was published in a 2013 article in *Vanity Fair* magazine. The interviewer reported that Jay-Z said during the interview that he and Beyoncé filed a trademark application for their daughter's name "merely so that no one else could." Ms. Morales contends that the statement made by Jay-Z shows the true intent behind filing the trademark application and is "an admitted pattern of abusing the trademark process." The argument failed because not only was Jay-Z's statement hearsay within hearsay, but Jay-Z is also not a party to the proceedings, so his statements were deemed irrelevant. In addition, a hearsay exception that might be applicable to a party as an admission against interest was also inapplicable, again, because Jay-Z was not a party to the opposition proceeding.

The Board found none of the evidence or arguments compelling and dismissed the Opposition. We will monitor and report upon the filing of an Appeal to the Federal Circuit or the commencement of a civil action before a district court.