

No Marijuana in Margaritaville: TTAB Rejects Proposed “Marijuanaville” Mark

May 3, 2017 – The TMCA

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A recent decision in an opposition proceeding before the TTAB demonstrates that the leisure industry is sometimes anything but laid back. Rights holders who may be wasting away in paradise can be roused to action when their valuable trademarks are being threatened.

Rachel Bevis, a resident of Colorado looking to capitalize on her state's legalization of recreational marijuana, applied to register the mark "Marijuanaville" in 2014 based on intent to use the mark in connection with apparel and drive-through retail stores.

The application was opposed by Margaritaville Enterprises, LLC, the successor in interest to Jimmy Buffett, and owner of two registrations for the mark MARGARITAVILLE covering apparel and retail services. Mr. Buffett's chain of MARGARITAVILLE restaurants was named after his popular and ubiquitous song of the same name, and Margaritaville Enterprises opposed the registration on the ground of likelihood of confusion. The TTAB sustained the opposition.

In support of its claim of likely confusion, Margaritaville Enterprises submitted a declaration from Mr. Buffett, explaining the meaning of “Margaritaville”:

- I regularly refer to “Margaritaville” as a state of mind inspired by margaritas.
- The images I most commonly associate with “Margaritaville” are beaches, tropics, leisure activities, islands and escapism.
- Based on the success of my song “Margaritaville” and loyalty of my fan base, in 1985 I opened a retail store named “Margaritaville” in Key West, Florida. In addition to selling MARGARITAVILLE branded souvenirs, including clothing in Key West,

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Florida, this retail store mailed newsletters, named The Coconut Telegraph, to my fans to purchase MARGARITAVILLE-branded souvenirs, including clothing by mail and phone.

Applying the *DuPont* likelihood of confusion factors, the Board found that the MARGARITAVILLE mark was famous for apparel and retail clothing services due to its financial success, strong online presence, and unsolicited press coverage of the mark. The goods and services were also deemed identical in part.

On the issue of the similarity of the marks, the Board did not find the expert testimony of a lexicographer submitted by Margaritaville Enterprises to be particularly compelling, but did rely on some evidentiary materials attached to the expert's declaration in support of its analysis. In addition, the Board found that even though the respective prefixes MARGARITA- and MARIJUANA- are different, both words represent a similar state of mind "induced by either a cocktail or marijuana". The Board therefore concluded that "the overall connotation and commercial impression of the marks is highly similar – a chemically induced mental paradise. The public is likely to perceive the Applicant's mark as an extension of Opposer's lifestyle brand."

Notably, Ms. Bevis represented herself *pro se* before the TTAB, failed to submit any evidence during the proceeding, and admitted a number of the allegations of the Notice of Opposition in her answer. Further, the TTAB was not persuaded by Ms. Bevis's arguments that she intended to limit her sales to regions of the country that support the marijuana industry, or that she intended to direct the goods related to her mark to consumers connected with the cannabis industry, because no such limitations or restrictions were incorporated into the application's identification of goods and services.

This case should serve as a cautionary tale on several levels. First, the general argument that a mark based on recreational marijuana is distinguishable from other goods and services because of its inherently narrower audience and applicable geography is unlikely to succeed. Second, while the applicant's failure to submit supporting evidence clearly did not assist her defense of the proceedings, asserted differences of target market and channels of trade absent corresponding restrictions in the application itself will not be deemed persuasive in a registration proceeding.

As a result of the TTAB's decision, there is now one less fictional "-ville" where people can drown away their sorrows.