

Phish Snared in Trademark Office's Net Due to Phan Products

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by Evan Everist



Ask any fan of the American improvisatory rock band Phish to explain the significance of the following pattern and you will invariably receive the same answer:



It's of course the pattern of drummer Jon Fishman's iconic dress, which he has worn during nearly all of the band's 1,700-plus shows. But the U.S. Patent and Trademark

Office ("PTO") thinks something is a bit fishy, and has repeatedly rejected Phish's pending applications to register the pattern for entertainment services, clothing, and other merchandise. The refusal rests in part on the PTO's assertion that the pattern is merely ornamental and lacks distinctiveness such that consumers would not understand it as exclusively identifying Phish products or services. The PTO has cited an abundance of products bearing the design created and sold by Phish fans through the Etsy online marketplace. Nearly all of the products include the words "Phish" or "Fishman" in the title. Due to the prevalence of these fan products, the PTO contends, the design does not necessarily indicate a single source – it could refer to any number of parties selling products with the design. (Having just attended the Phish New Year's Eve show, I can attest to the staggering amount of fan-created merchandise featuring this design, including flags, shirts, ties, bow ties, eyeglasses, bandanas, leggings, jumpsuits, and even a matching sequined tuxedo/ball gown combo worn by one Phish-loving couple.) You can find the PTO's initial refusal [here](#).

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In an attempt to convince the PTO of its exclusive rights in the design, Phish argued the design has acquired distinctiveness and submitted substantial evidence of the band's use of the pattern, including decades of articles referencing or featuring pictures of Fishman's dress and affidavits from those closely associated with the band, including Phish's general counsel and archivist Kevin Shapiro, describing the band's long-time use of the design and significant sales of products bearing the design. The response also dismissed the third-party uses cited by the PTO as "bootleg merchandise," which are clearly attempting to trade on Phish's goodwill in the pattern. The band indicated that it intends to engage in a robust trademark enforcement program to stamp out these uses, but that it needs "acknowledgement of its rights in the mark to have a high rate of success." You can find Phish's initial response [here](#). Although the PTO recently accepted the claim of distinctiveness for entertainment and music services, it continues to reject the claim for Phish merchandise in part on the ground purchasers may instead view the parties producing "knock-off goods" as the source of the merchandise.

This is certainly not the end of the road (or stream) for Phish, which now has an opportunity to submit additional evidence of distinctiveness or arguments against the refusal. Nonetheless, the band's experience serves as a cautionary tale in brand management both for musicians and other brand owners, especially for those that, like Phish, have an enthusiastic fan base with a long history of creating and selling fan art and merchandise. These often well-intentioned tributes can have very negative repercussions because each unlicensed coexisting use of a mark weakens the original mark owner's scope of rights. If the coexistence becomes too widespread, the mark owner may even lose all rights to exclusively use its mark. Additionally, brand owners should remember that the PTO is not a closed ecosystem – it will take into account evidence of third-party use to determine whether an applicant may assert exclusive rights in the purported mark.

So what are brand owners like Phish to do? First and foremost, they should adopt a consistent enforcement strategy for key trademarks as early as possible. And this strategy should evolve over time to account for technological changes in the marketplace, such as the creation of online retailers like Etsy and Ebay (both of which allow brand owners to request removal of infringing and counterfeit products). For brands wishing to take a lighter approach to enforcement against fan-created merchandise, it is also equally important to collect any direct evidence showing that consumers associate the mark with its owner (i.e., message board comments, consumer letters or statements, advertisements, etc.), which could help to counteract an argument that the mark lacks distinctiveness. However, if the coexistence with fan-created merchandise is pervasive, even this type of evidence could prove unsuccessful.

We will continue to monitor these applications to see if Phish wriggles free of the PTO's refusal.