

David and Victoria have IP Office at Beck and Call for Children—Trade Marking the Kids’ Names puts Beckhams on Cruz Control for IP Protection

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Whether you buy into it or not, “Brand Beckham” is a global business empire, and a highly successful one at that. The couple’s total wealth was estimated to be £508m in 2016, and the Beckham “brandwagon” rolls on. The Beckham brand has been further bolstered with the recent registration in May 2017 of their children’s names HARPER BECKHAM, CRUZ BECKHAM and ROMEO BECKHAM as EU trade marks, with the registration for BROOKLYN BECKHAM closely following on 15 June 2017. With no recognised proprietary right of personality in the UK, celebs have to rely on a patchwork of other more traditional rights in order to look after number one. Such miscellany of rights to protect the use of a celebrity’s name or image can, depending on the scenario, include copyright, defamation, confidential information, privacy, data protection, advertising laws, passing off, and trade mark protection. Victoria’s decision to register the names of each of the kids as a trade mark in the EU is therefore a shrewd move by the business-savvy fashion designer. Brooklyn, Romeo, Cruz and Harper have each appeared in the public eye throughout their lives, with both Brooklyn and Romeo already having been associated with large brands such as Burberry. However, it has now become apparent that the gates to the Beckham empire are not only opening for its heirs and heiress, the empire itself is expanding too, if the registered scope of trade mark protection is anything to go by!

The applications

On 22 December 2016, Victoria Beckham filed four EU trade mark applications for each of her children’s names. An EU trade mark, once successfully registered, will be enforceable in all 28 EU Member States, however a number of conditions must first be satisfied in order to navigate the route to registration. In essence, a trade mark must act as an indicator of origin. Pursuant to the European Union Trade Mark Regulation 207/2009 (the EUTMR) art.4,¹ a trade mark must be clearly defined and “may consist of any signs capable of being represented graphically ... provided that such signs are capable of distinguishing the goods or services of one undertaking from those of others”. When assessing an EU trade mark application, the European Union Intellectual Property Office (the EUIPO) must conclude that the mark is both *distinctive* and *non-descriptive* (EUTMR arts 7(1)(b) and (c)). According to the EU IPO, “your trade mark is the symbol your customers use to pick you out. It distinguishes you from your competitors”. Place “John Smith” up against “Cruz Beckham” in the “name-game” stadium and it seems evident who is likely to lose the shoot-out when it comes to assessing distinctiveness.

The registrations

The four EU trade mark registrations are each owned by “Victoria Beckham as parent and guardian of” said Beckham child, including somewhat surprisingly for the “BROOKLYN BECKHAM” trade mark, even though Brooklyn is now himself 18 years old. The Beckham parents’ decision to apply for trade marks for the Beckham brood has been widely criticised in the media, attracting press headlines such as “Victoria Beckham turns her daughter into a trade mark” and Piers Morgan’s well documented comment of “putting these kids into the public domain while simultaneously saying privacy”. As with all trade mark applications, the registered right is seeking to protect the value attributed and which may in future be attributed to a particular brand. By ensuring that each of the Beckham children’s names are proactively registered, their parents are providing them each with an opportunity not only to assist in protecting their own image, but also to explore a wide range of commercial options to exploit their personal brands.

Having successfully passed the three-month publication periods, during which third parties could, but did not, file an opposition to their trade marks, all four Beckham youngsters are now listed on the team sheet. Somewhat unsurprisingly the breadth of the goods and services applied for under each specification is vast with goods and services listed in the following seven international trade mark classes 3, 9, 16, 18, 25, 28 and 41. Once registered, the children will each be able to use their trade marked names in relation to anything from clothing and footwear, and toys and electronics, to the more obscure fields of animal leashes and laundry powder. The

¹ Regulation 207/2009 on the Community trade mark [2009] OJ L78/I.

Beckhams have also applied for a broad category of services under international registration class 41, which relates to entertainment services. This acts to grant each child the exclusive right to use their name in music, TV and film—though the goal remains open as to whether registration of such trade marks for such services could in theory be invalidated for descriptiveness.

EU as distinct from UK and US registrations

In contrast to the law applicable to UK trade mark applications, any applicant of an EU trade mark is not required to have a bona fide intention to use the mark, and as such the application form does not contain a statement to this effect. This differs again from the US, whereby an applicant is only entitled to own a trade mark if they have used it in commerce, or reserve rights in the trade mark by having an “intent to use” the trade mark for up to three years. This is somewhat more burdensome, as the applicant must prove that they have actually taken steps in preparation for use of the mark as applied for, an issue that is currently plaguing Beyoncé and Jay-Z in the US (see below for further details). It is clear that the EU’s more lenient position in this regard will work in the Beckhams’ favour, as it may be fairly safe to argue that six-year-old Harper Beckham has other things on her mind than whether her EU trade mark survives the EUIPO’s application of the “absolute grounds for refusal”. However, a trade mark owner’s rights will be revoked under EU law if, within a continuous period of five years from registration, the trade mark has not been put to genuine use in the EU in connection with the goods or services in respect of which it is registered. This means that in due course, the Beckhams will need to get to work in actually using the trade marks in relation to the broad spectrum of goods and services for which registration has been sought in order to successfully defend any future actions for revocation for non-use.

Celebrity jnr. brands

Unsurprisingly, Posh and Becks are not the first parents to seek to add their “celebrity jnr.s” to the branding package. Queen B and Jay-Z have not lost any time in filing applications for their two-week old twins, with the names “RUMI CARTER” and “SIR CARTER” pending as trade marks at the United States Patent and Trademark Office as of 26 June 2017. The power couple have already attempted to register “BLUE IVY”, the name of their first-born child, in the US for a wide range of goods and services. The application was bravely and successfully opposed by a Veronica Morales, an independent wedding planner who has been in business since 2009 and who holds existing registered rights in the name Blue Ivy for event planning services. However, the ambitious parents have not stopped there. On 22 January 2016, Mr and Mrs Carter filed a new, and hopefully more distinctive

application for their daughter’s full name, “BLUE IVY CARTER”. Nevertheless, 7 February 2017 saw Veronica Morales file yet another intention to oppose the new application. Controversially, recent media reports have suggested that the opponent also has evidence on record that Jay-Z has said they have no intention of actually selling any products and are merely using the applications to prevent others from doing so. This would not meet the crucial requirement of “intent to use” under US law, as discussed above, and would fundamentally undermine their application. It remains to be seen whether the addition of “CARTER” will add a sufficient level of distinctiveness for the USPTO to grant the registration. It is worth noting however, that the couple has successfully attained a trade mark registration in the EU for the name, and as trade marks are territorial rights, the EU jurisdiction was likely beyond the reach of Ms Morales.

Patchwork of rights

Protecting a celebrity’s (or in this instance a cohort of child celebrities’) brands and “brand potential”, is not always straightforward. The UK does not provide for a codified law of privacy or image rights, and thus if the individual wishes to protect their “famous personality”, they must rely upon a patchwork of statutory and common law rights. Protecting a celebrity’s “image” from a photographic perspective can prove more difficult and may rely heavily on copyright laws and the complex law of the right to privacy. In recent years, the tort of passing off has been relied upon by several celebrities whose name, image or likeness is used in a way which incorrectly suggests they have endorsed the defendant’s goods or services. In 2002, Laddie J upheld a passing off claim brought by Formula One racing driver, Eddie Irvine against Talksport. Talksport had distributed an advert which featured a photograph of Mr Irvine appearing to listen to a Talksport branded radio. The court held that it was the claimant’s exclusive right to protect its own goodwill from damage and that it was therefore for Mr Irvine to determine the quality of his reputation by engaging in celebrity endorsements. The Court of Appeal has since extended this further. In 2013, it was held that Topshop’s sale of t-shirts bearing a famous photograph of popstar Rihanna, which she had not consented to, amounted to passing-off. This was a significant decision in expanding such celebrity rights into the field of character merchandising, although Birss J emphasised heavily that such a decision was fact specific and should not be seen as opening the floodgates for such celebrity claims.

Comment

It is evident that the law will not always swing in a celebrity’s favour, and it may prove difficult to navigate around some of these complexities in order to protect a celebrity’s “brand”. The most certain and pro-active

means to bolster protection is therefore to seek trade mark registrations, and it is arguably easier to do so at a young age, before an individual's fame and notoriety grows, which could mean that the name can no longer fulfil the essential function of a trade mark, which is to act as a badge of origin. The Beckham family's value undoubtedly lies in their world-renowned surname, and a registered trade mark will provide each of the Beckhams with a valuable commercial asset which is both

commercially exploitable and relatively easy to protect and enforce. Whilst further registrations will not make Brand Beckham entirely invincible, they will certainly act as a deterrent to anyone seeking to exploit the Beckham brand and sub-brands and once granted, can be renewed indefinitely. With all four of the young Beckham squad's applications having been successfully registered as trade marks, it looks as though the Beckhams are fairly close to world (or at least EU) domination.