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News

Trademarks

Absent Showing of False Association With Singer, 'Maria Callas' Is Registrable

The Trademark Trial and Appeal Board Sept. 26 reversed a trademark examining attorney's refusal to register the mark "Maria Callas," holding that the mark did not violate Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), by falsely suggesting a connection with famous, deceased opera singer, Maria Callas (*In re MC MC S.r.l.*, T.T.A.B., No. 79022561, 9/26/08).

'Maria Callas' Mark

MC MC S.r.l., an Italian company, filed an application to register the mark "Maria Callas" for "precious metals and their alloys, namely, gold, silver, platinum, namely necklaces, rings, bracelets, brooches; jewelry; precious stones; homological and chronometric instruments."

The trademark examining attorney refused registration of the mark pursuant to Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), asserting that the mark falsely suggests a connection with "'Maria Callas,' the famous, deceased opera singer, her heirs and/or her estate."

MC MC appealed.

Parties Dispute Whether Rights Still Exist

Section 2(a) of the Trademark Act allows refusal of a registration on the principal register for a mark that falsely suggests a connection with persons living or dead, institutions, beliefs, or natural symbols, or brings them into contempt or disrepute. In *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, (Fed. Cir. 1983), *aff'g* (TTAB 1982), the board articulated the following four-part test to determine whether a false suggestion of a connection under Section 2(a):

(1) that the marks are the same as, or a close approximation of, the name or identity previously used by the other person; (2) that the marks would be recognized as such, in that they point uniquely and unmistakably to that person; (3) that the person named by the marks is not connected with the activities performed by applicant under the marks; and (4) that the prior user's name or identity is of sufficient fame or reputation that a connection with such person would be presumed when applicant's marks are used on applicant's goods.

The examining attorney argued that: (1) the name in the proposed mark is the same name as the famous, deceased opera singer Maria Callas; (2) the proposed mark would be recognized as being the same as that of the singer; (3) no one associated with deceased singer, her heirs and/or estate is connected with the goods sold by applicant; and (4) the fame and reputation of the singer is such that consumers of applicant's goods will presume a connection between the two.

MC MC countered that the mark does not falsely suggest a connection with the singer because there is no estate vested with rights to control use of Maria Callas's name or persona. According to MC MC, the rights of privacy and publicity in the Maria Callas name were extinguished with her death in 1977. Furthermore, MC MC argued that it was licensed to use the Maria Callas name by the International Maria Callas Cultural Association, which is the recognized source of Maria Callas memorabilia and information.

For support, MC MC submitted: (1) a sworn affidavit from a Greek investigator that concluded that there were no heirs of Maria Callas who are in the position to enforce Maria Callas' right of personality; and (2) a declaration from Bruno Tosi, the president of IMCCA, who affirmed the same thing.

Doubt About False Association Prompts Reversal

Administrative Trademark Judge Thomas W. Wellington noted at the outset that the issue of whether an applicant's mark has a false suggestion of a connection under Section 2(a) was addressed by the board in *In re Wielinski*, 49 USPQ2d 1754 (TTAB 1998) in the context of a corporate entity. There, Wellington said, the examining attorney refused to register the applicant's marks for false association with a defunct trunk company, but the board reversed,

reasoning that the company no longer existed, and there was no evidence that anyone was entitled to assert that entity's rights.

The fact the entity here was a person does not present a different issue, Wellington said. Thus, he continued, "we must find whether or not there is someone (this may be a natural person, estate, or juristic entity) with rights in the name 'Maria Callas.'"

The board concluded MC MC had rebutted the examining attorney's prima facie case under Section 2(a) by presenting evidence that no such entity exists. The board acknowledged the examining attorney's references to an entity that appears to authorize releases of Callas' recordings, and to a Greek law firm that purportedly represents the singer's estate.

Citing MC MC's contrary evidence, however, the board concluded that "significant doubt remains as to whether there is a successor in interest to Maria Callas' rights in her name and persona." Moreover, the board said, it is the examining attorney's burden to establish the false association of an applicant's mark, and any doubt about such a connection should be resolved in the applicant's favor.

The board accordingly reversed the examiner's refusal to register the mark.

Administrative Trademark Judges Karen S. Kuhlke and Lorelei Ritchie de Larena joined the opinion.

MC MC was represented by G. Franklin Rothwell of Rothwell, Figg, Ernst & Manbeck, Washington, D.C.