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## Will the Real Kylie Please Stand Up?

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# WILL THE REAL KYLIE PLEASE STAND UP?

BY [ADAM VALKO](#) / ON APRIL 16, 2016

Kylie Jenner (pictured above, left), has found herself in a bit of a legal scrape having nothing to do with the actions of her infamous family. Jenner, the youngest of the *Keeping Up with the Kardashians* clan, has, until this point, been famous merely for being the youngest child of Kris Jenner and making appearances on their E! television series. However, she has recently attempted to create a name for herself by jumping into the world of clothing and cosmetics.

In April and November of 2015, Jenner filed various trademark applications with the USPTO to protect both her full name and her first name standing alone. [1] "Kylie Jenner" was registered to protect various bags, purses, wallets, clothing, fragrances, and umbrellas while "KYLIE" was for more general entertainment services, as well as advertising services to promote her personal brands.[2] Back in September, Kylie (and the rest of the Kardashian sisters) released an app to market to her specific audience.[3] Her app became the most popular, sharing cosmetic tips and taking users behind the scenes of her various fashion endeavors.[4] The transition into real world products bearing her name seemed inevitable, and her trademark applications were the first indication of Jenner's intent to jump into the market officially.

One person not at all thrilled to hear this news was Australian-born actress and singer Kylie Minogue (pictured above, right). Minogue has become a "global phenomenon" who has sold over 80 million records worldwide and in 2012 celebrated 25 years of musical performances.[5] Minogue, who's first album was entitled "Kylie", owns various trademarked variations on her own name as well, including "Kyle Minogue", "Kylie Minogue Darling" (a perfume), and another donning the name of her musical.[6] Minogue expressed her discontent to her 2+ million Twitter followers with the tweet, "Hello ... My name is KYLIE #lightyears".[7] Minogue started a legal bid in late February to prevent Jenner from claiming ownership of the name Kylie. The firm representing Minogue, KDB, said that "allowing Jenner to take the Kylie name would cause confusion for Minogue fans and dilute her brand." [8] She further described Jenner as a "secondary reality television personality," [9] which seems like a sure fire way to irritate a Kardashian.

Under the Federal Lanham Act, the body of law governing U.S. trademark law, any party who feels they will be damaged by the proposed registration of a mark is entitled to challenge the proposed mark. This is exactly what Minogue did through her firm, KDB. At first, Minogue did not oppose all variations of Jenner's applications, originally choosing to ignore the application covering her celebrity, actress, and model appearances. That changed in early March when KDB announced that they would be opposing that as well.[10]

Minogue's argument, as evidenced by calling Jenner a "secondary" personality, is that Jenner is lesser known, and that Minogue's fans will be confused in the marketplace. Minogue also

hopes that, by categorizing Jenner as a lesser known celebrity, it lowers the chance of her brand being found to have the secondary meaning necessary for registration.<sup>[11]</sup> Minogue, who has been releasing music since the late 1980's, has a strong argument that the public, "...more closely identifies the name Kylie with Kylie Minogue than Kylie Jenner, 18, who made her TV debut in 2007."<sup>[12]</sup> If trademarks no longer serve as an identifier of source and goods, the system begins to crumble. Minogue's opposition also references other "existing trademarks for the term KYLIE that cover entertainment services and music recordings."<sup>[13]</sup>

Now that Minogue's opposition is filed, the USPTO will schedule a time to resolve the dispute before the Trademark Trial and Appeal Board (TTAB).<sup>[14]</sup> Minogue is hoping that TTAB refuses to register Jenner's marks, agreeing that this causes confusion in the marketplace and dilutes Minogue's international brand. Jenner, obviously, is hoping for the exact opposite outcome, because she thinks her name is more famous than Minogue. Jenner's camp reportedly stated that they, "...never heard of Kylie Minogue and believe Kylie Jenner should be able to use the name 'KYLIE' how she wants."<sup>[15]</sup> This sets the stage for a contentious hearing before TTAB.

Unfortunately, unless a settlement arises, we may not have a resolution to this problem any time soon, as TTAB cases can take quite a while. The results should be interesting, as both sides have strong and convincing arguments for their individual brands. On one hand, Jenner is, regardless of the public's perception of her controversial actions<sup>[16]</sup> or notorious family, a very well-known personality, especially within fashion and entertainment. Likewise, Minogue has an international brand and legacy of success. She would clearly suffer harm if consumers confuse the two marks.

Finally, consider the following point: Minogue has owned the domain name "Kylie.com" since August 21, 1996 and has used it as the home for all things relating to her music.<sup>[17]</sup> Kylie Jenner, on the other hand, was born on August 10 . . . 1997. Minogue's legal team may argue the point that Jenner would be forced to create a domain name inconsistent with her proposed "brand," which can create confusion amongst her own supporters. Therefore, maybe she should consolidate her image behind the "Kylie Jenner" brand.

<sup>[1]</sup> *UPDATE: Kylie Minogue Opposed Kylie Jenner's Trademark Application*, The Fashion Law (Mar. 10, 2016), <http://www.thefashionlaw.com/home/kylie-minogue-opposed-kylie-jenners-trademark-application>.

<sup>[2]</sup> *Id. See also Josh H. Escovedo, Kylie Minogue v. Kylie Jenner: A TTAB Clash of Celebrities*, The IP Law Blog (Mar. 4, 2016), <http://realobsession.com/kylie-minogue-files-lawsuit-against-kylie-jenner/>.

<sup>[3]</sup> Kevin Smith, *This Is What It's Like When You Pay \$2.99 A Month For Kylie Jenner's Official App*, BuzzFeed (Sept. 15, 2015), <http://www.buzzfeed.com/kevinsmith/king-kylie-has-taken-her-throne#.coEvO50l12>.

[4] *Id.*

[5] *Kylie Minogue Biography*, bio., <http://www.biography.com/people/kylie-minogue-507447> (last visited Mar. 31, 2016).

[6] Hannah Ellis-Peterson, *Kylie who? Minogue fights Jenner bid to trademark name*, *The Guardian* (Feb. 29, 2016), <http://www.theguardian.com/music/2016/feb/29/kylie-minogue-jenner-trademark-first-name-kardashians>.

[7] *Kylie Minogue Twitter*, Twitter (Feb. 28, 2016), [https://twitter.com/kylieminogue/status/703880943493185536?ref\\_src=twsrc%5Etfw](https://twitter.com/kylieminogue/status/703880943493185536?ref_src=twsrc%5Etfw).

[8] Ellis-Peterson, *supra* note 6.

[9] *Id.*

[10] *The Fashion Law*, *supra* note 1.

[11] KYLIE would probably be found to be descriptive under The Lanham Act, which could then only be registered with a showing of secondary meaning.

[12] *Id.*

[13] Escovedo, *supra* note 2.

[14] Rich Stim, *Opposing and Canceling a Trademark Registration*, NOLO, <http://www.nolo.com/legal-encyclopedia/opposing-canceling-trademark-registration.html> (last visited Mar. 31, 2016).

[15] Alex Roman, *Kylie Minogue Files Lawsuit Against Kylie Jenner*, *Real Obsession* (Mar. 6, 2016), <http://realobsession.com/kylie-minogue-files-lawsuit-against-kylie-jenner/>.

[16] Ellis-Peterson, *supra* note 6 (“... criticism Jenner has faced from [African American communities](#) and disability rights groups, particularly for her “photographic exhibitionism” on social media. In December, Jenner caused controversy by [posing in a wheelchair](#) for a photoshoot with *Interview* magazine”).

[17] Evan Real, *Kylie Minogue Throws Shade at Kylie Jenner Amid Name Trademark Drama – See Her Telling Tweet*, *US Weekly* (Feb. 29, 2016), <http://www.usmagazine.com/celebrity-news/news/kylie-minogue-responds-to-kylie-jenner-trademark-drama-w165806>.