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## **Secondary meaning not established by length of use alone, says court**

### **United States – McDermott Will & Emery LLP**

In *B & J Enterprises Ltd v Giordano* (Case 08-1375, May 18 2009), the US Court of Appeals for the Fourth Circuit has affirmed a grant of summary judgment against the plaintiff's trademark infringement and cybersquatting claims.

*B & J Enterprises Ltd* has operated a talent agency under the name Washington Talent Agency in the Washington DC area since 1967. However, it did not apply to register the trademark WASHINGTON TALENT AGENCY until July 2006, after the commencement of the lawsuit.

*Albrecht Entertainment Services Inc*, doing business as USA Talent Agency, registered the domain names 'WashingtonTalentAgency.com', 'MarylandTalentAgency.com', 'VirginiaTalentAgency.com' and 'ColoradoTalentAgency.com'. Each of the domain names was a portal for Albrecht's parent website, 'USATalentAgency.com'. B & J filed suit, alleging trademark infringement and cybersquatting.

To prevail on trademark infringement and cybersquatting claims, a party first must prove that it possesses a valid and protectable trademark. In the instant case, the district court found that WASHINGTON TALENT AGENCY was a geographically descriptive mark which had not acquired secondary meaning. Therefore, it was not a protectable mark.

In reviewing the district court's decision, the Fourth Circuit took into account the six Perini factors:

- the plaintiff's advertising expenditures;
- consumer studies linking the mark to a source;
- the plaintiff's record of sales success;
- unsolicited media coverage of the plaintiff's business;
- attempts to plagiarize the mark; and
- the length and exclusivity of the plaintiff's use of the mark.

In considering the first factor, the court found that B & J's evidence of advertising expenditures was insufficient because it showed only that the funds were expended generally. They did not show expenditures on advertising the name Washington Talent Agency in the relevant area of Washington DC. B & J also failed to satisfy the second factor because it did not produce any consumer studies linking the mark to a source. With regard to the third factor, the court again found B & J's evidence lacking because its sales history failed to show sales success in the Washington area.

B & J fared no better on the fourth and fifth factors. Despite using the name Washington Talent Agency for almost 40 years, B & J could produce only one instance of unsolicited media coverage and no instances of infringement prior to the instant case. Finally, in evaluating the sixth factor, the court found that length of use alone, without evidence of exclusivity in the relevant market, is not sufficient to establish secondary meaning.

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