

## Katy Perry Faces Choppy Waters: 'Left Shark' TM Refused

Law360, New York (May 22, 2015, 2:48 PM EDT) -- Katy Perry has run into trademark trouble in her attempt to register a "Left Shark" design mark. Here's what happened and what you can do to avoid a similar fate.

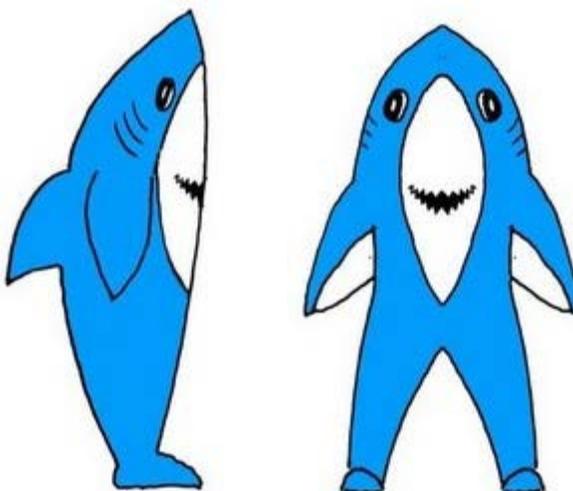
To the merriment of Left Shark fans everywhere, Katy Perry has struck a hurdle in her attempt to obtain trademark registrations for "Left Shark." Left Shark refers to the back-up dancer dressed in a shark costume who performed on the left side of the screen during Katy Perry's 2015 Super Bowl performance.



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After Left Shark garnered widespread acclaim due to its less-than-perfect (yet widely determined to be adorable) dance moves, Katy Perry decided that she wanted to stop entrepreneurs from capitalizing on Left Shark's unexpected popularity. She sent a cease-and-desist letter to a man named Fernando Sosa, who was selling 3-D-printed figurines of Left Shark, and promptly thereafter filed trademark applications with the United States Patent and Trademark Office.

After examining Katy Perry's applications, filed under the name Killer Queen LLC, the trademark office refused the two design marks, depicted below, for the following reasons.



First, the examining attorney determined that the applied-for marks do not "function as a service mark" with respect to "live musical and dance performances." A trademark or service mark must identify the applicant (here, Katy Perry/Killer Queen LLC) as the source of the goods/services and distinguish the applicant's services from those of others. The examining attorney determined that the shark does not identify and distinguish Katy Perry's musical and dance performances.

Second, the trademark office refused registration because the specimen did not exactly match the drawing submitted in the trademark application. A specimen is evidence of how the trademark is being used in the real world. For reference, Katy Perry's trademark attorney submitted the

following photo as the specimen:



The trademark examiner pointed out a number of differences between the specimen and the drawing (for example, the fins, legs, gills, mouth, teeth, eyelids and overall position of the shark) and as such refused registration because the specimen is not a “substantially exact representation of the mark as used on or in connection with the goods and/or services.”

Third, the trademark examiner determined that the identification of goods in Classes 25 (“costumes”) and 28 (“figurines”) were unacceptable as indefinite, and needed to be more specific.

Lastly, the examining attorney raised a couple of smaller issues regarding color and the description of the mark. The examiner determined that Katy Perry had submitted an incomplete color claim for the mark because Perry only listed the colors blue and white. The color claim should have also included black, which also appears in the image. In addition, the examiner determined that a more accurate and concise description of the mark needed to be submitted.

In order to avoid the complications faced by Katy Perry’s team and have a smoother (and faster) trademark registration process, keep these rules of thumb in mind:

1. Make sure your trademark or logo is being used as an identifier of the good/services you seek to offer. When a consumer comes across your trademark, he/she should associate you as the source of the product.
2. When submitting a “drawing” of your trademark, make sure the drawing appears the exact same way as the trademark will be displayed in the marketplace.
3. When determining what to write for your description of goods or services, use the Trademark Identification Manual to see examples of other descriptions that have been approved. For example, if Katy Perry’s trademark attorney had done a search for “figurines” in the ID Manual, he would have seen that he needed to be more specific and identify the material of the figurines.
4. Pay close attention to detail when filing your trademark application. If you are submitting a color claim, include every color that appears in your drawing.

Despite what Left Shark fans may hope, Perry’s fight for the trademark is not over. As a matter of course, a trademark office will always give an applicant an opportunity to argue against a refusal.

Katy Perry has six months to respond to the office action and argue that the refusal should be withdrawn.

Katy Perry is also attempting to obtain trademark registrations for "Right Shark," "Drunk Shark" and "Basking Shark." It remains to be seen how these trademark applications will fare.

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