

# PUBLICATION

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## Advertising and Fair Use of Trademark: Oprah's Aha! Moment

September 28, 2016

**On September 16, 2016, the Second Circuit cleared Oprah Winfrey's company and magazine of charges that their use of the phrase "Own Your Power" infringed a motivational speaker's trademark rights. The judges said that despite the speaker's ownership of a "special form" trademark on the phrase – arguably making it distinctive – Oprah's team proved that the phrase was merely descriptive.**

Motivational speaker and life coach Simone Kelly-Brown has limited rights in the phrase "Own Your Power," as it appears in a light blue version with stylized letters. Nonetheless, the court found that Kelly-Brown's claims didn't rise to trademark infringement. Because none of Winfrey's uses of the phrase involved the font in Kelly-Brown's registration, Kelly-Brown had no rights in the descriptive phrase itself because the public had not come to associate it with her (secondary meaning), and she had not properly alleged and proven trademark rights in the combination of those elements.

The Second Circuit held that "even if a presumption of inherent distinctiveness applied to the words 'own your power' apart from their visual representation in the plaintiffs' special form mark, the defendants demonstrated, as a matter of law, that the phrase is merely descriptive as applied to the plaintiffs' business." Winfrey provided evidence that Kelly-Brown used the phrase descriptively in her own advertisements. Expert testimony offered by Winfrey also proved that the phrase has been in use since at least 1981, including in a much-publicized 1993 commencement address made by Winfrey. Further, Winfrey presented three largely unchallenged surveys demonstrating the absence of any confusion between her use of the phrase and Kelly-Brown's mark.

The court noted while "the distinctive display of descriptive or otherwise unregistrable components of a mark . . . [can be protected if the overall display, inter alia,] create[s] a distinctive commercial impression separate and apart from the descriptive significance of [the] components," such protection is not automatic.

Winfrey has finally, after two district court trials and two appeals, received a ruling that brings to mind her favorite three words: "fa-bu-lous."

For more information on this or any related matters, please contact a member of the Firm's Intellectual Property Group.