

International reports

Who is the real MASTERMIND?

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On 15 June 2018 the Ninth Circuit Court of Appeals reversed a district court's decision to invalidate a USPTO registration for the mark MASTERMIND by independent hip-hop artist and producer Raul Caiz. The Ninth Circuit held that the presumption of validity for the registered mark was heavy and the defendants had not sufficiently overcome that presumption.

Caiz owns the mark MASTERMIND (Reg 4366332) for, in general, musical sound and video recordings and entertainment services. While relatively unknown, Caiz had used the mark for almost two decades, and his songs were receiving some radio airplay.

In 2013 Grammy-nominated rapper Rick Ross (real name William Leonard Roberts II) released an album titled *Mastermind*. The album was well received and a *Mastermind* tour was announced. Ross began calling himself 'Mastermind' and others soon followed.

In 2015 Caiz sued Ross, Def Jam Records and Universal Music Group for trademark infringement, unjust enrichment and misappropriation of the name. The defendants argued that MASTERMIND was not a valid, protectable mark because it was descriptive. The district court agreed, granted summary judgment on the issue in favour of the defendants and ordered the cancellation of the mark.

On appeal, the Ninth Circuit disagreed. Because the mark was registered, it was entitled to a strong presumption that the mark is protectable; a defendant has a heavy burden to overcome that presumption. The court acknowledged that the defendants had submitted some evidence that the mark was descriptive, including a dictionary definition that used the word 'mastermind' with reference to a musician, but this did not demonstrate that there was no factual dispute and was not sufficient to overcome the presumption at the summary judgment stage. There was also evidence that other musicians had called themselves masterminds; however, while widespread use of a word might weaken the mark, it does not conclusively demonstrate that competitors must use the word to fairly describe their product.

The case has been remanded for consideration of the defendant's fair use defence, among other issues.

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