

# Rapunzel, Rapunzel, Pay Us a Fee

Clinic fights trademarking of *Grimm's Fairy Tales* character

Should one company have the right to trademark the name of a centuries-old *Grimm's Fairy Tales* character—and potentially charge other companies to use it? In this case, we're talking about Rapunzel, and a company, United Trademark Holdings, that's trying to trademark the name for a line of dolls.

Suffolk Law's IP & Entrepreneurship Clinic is opposing the registration at the Trademark Trial & Appeals Board (TTAB). If they win, it will be a Cinderella story.

The Disney Corporation, which asked the TTAB for an extension to file its opposition to the trademark request, may also enter the fray. Disney has some skin in the game, with its own rendering of the Rapunzel fairy tale in the film *Tangled*.

Over the years, underestimating our Clinic students—backpacks, Dunkin' iced coffee, cheap desks, and all—has turned out to be a bad idea for corporate attorneys at some massive brands, including Nautica and Monster Energy Drink. The students' victories have struck a chord, garnering coverage in the *Washington Post* and *Seattle Times*, among others.

The early results of the Rapunzel case are encouraging. In December, the TTAB held that Suffolk Law Professor Rebecca Curtin has standing to challenge the trademark registration. Curtin is represented by the IP Clinic students under the supervision of their director, Professor Loletta Darden JD'91.

In all but a few cases, it's a business competitor who can successfully oppose a trademark registration. For that reason, most of the trademark professionals Darden and Curtin talked to thought the professor's opposition—as a consumer—would go nowhere.

They were wrong. But in their defense, the Clinic's early victory was unprecedented. It's the first time that a general consumer (Curtin) has been allowed to proceed with a challenge to a trademark registration through the "descriptiveness" section of the trademark law. To successfully register a trademark you need to avoid terms that are the generic word for a kind of product or just

describe a quality of the product. Trademarks should tell consumers who made the product, not what the product is.

By way of explanation, Curtin looks to the generic word "apple." Using the word "Apple" as a trademark for computers is reasonable, she says, because competing computer makers can use another name for their computers. "But if one apple farmer had the exclusive right to use just the word 'Apple' to market apples, the actual fruit from the tree, it would make it hard for other farmers to tell consumers that they also were selling apples." What, exactly, would they call their apple?

Curtin and the Clinic are arguing that Rapunzel, like the fruit in her example, is both generic and un-distinctive for toy figures that depict Rapunzel.

So how might a Rapunzel doll trademark impact consumers? Curtin says exclusive trademarks would raise barriers to the use of the name by other toymakers, resulting in fewer toys expressing the character. There may also be a domino effect, she contends, with other companies seeking exclusive rights to decades-old iconic characters on greeting cards, party favors, or board games. Ultimately that's bad for consumers, Curtin argues. "Why should only one company

have the right to tell us what a fairy-tale princess looks like?" she asks. "How could just one company define who Rapunzel is?"

The trademark registrations might also require competing companies to pay licensing fees—paying for the right to use the name Rapunzel—increasing the costs of their products, Darden says.



Professor Rebecca Curtin



Professor Loletta Darden JD'91