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Trademark: “I Love You...You’re Fired!”

By

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Abstract

Recently, Donald Trump tried to trademark the phrase “You’re Fired!” for a myriad of items in connection with his popular television show “The Apprentice.” The phrase has become closely associated with Mr. Trump and his show, so much in fact, that it disturbs some business owners that have used the phrase for their ceramics and pottery stores for several years. One owner in particular, Ms. Susan Brenner of Illinois, has challenged Mr. Trump in the Chicago area claiming that she has common law trademark rights in the region. This article discusses how the courts will likely handle litigation between Mr. Trump and Ms. Brenner, as well as a bigger problem for Mr. Trump- whether “You’re Fired!” is generic and not eligible for trademark protection at all.

Donald Trump’s recent filings at the United States Patent and Trademark Office of the phrase “You’re Fired!” and its progeny¹ for trademark protection have caused a big uproar as Trump² tries to capitalize on the success of his television show “The Apprentice.” Apparently unbeknownst to Mr. Trump, there are several small shops scattered throughout the country with the name “You’re Fired!” For the most part, these tiny stores are pottery and ceramic studios

¹ Mr. Trump has filed seven applications consisting of different uses of the marks “YOU’RE FIRED!” “YOU’RE FIRED! DONALD J. TRUMP” “YOU’RE FIRED” and “YOU’RE FIRED! THE DONALD.” Search of Trademark Electronic Search System (TESS), United States Patent and Trademark Office (searching for the term “You’re Fired” and finding 15 trademarks), <http://tess2.uspto.gov> (accessed May 25, 2004).

² In addition to Mr. Trump, there are at least seven others who wish to use the mark as a result of the television show, including the executive producer Mark Burnett. Search of Trademark Electronic Search System (TESS), United States Patent and Trademark Office (searching for the term “You’re Fired” and finding 15 trademarks), <http://tess2.uspto.gov> (accessed May 25, 2004).

where classes are taught, where pottery is made and sold, and where patrons can find and use the tools of the art. One such studio, located just north of Chicago in Glenview, Illinois, is owned by Ellen Benaim and Susan Brenner. According to a Chicago Tribune interview with Susan Brenner, her fears of Trump registering the mark are two-fold: first, that people might associate her store with Donald Trump and wonder why she is using his mark; and second that Trump's casinos in nearby Gary, Indiana, might give ill repute to Brenner's store.³

On the surface, Ms. Brenner's claims appear both valid and enforceable. Ms. Brenner has been at the same location for the past seven years, and in that time she has compiled a mailing list of over 5,000 patrons that not only spans the Greater Chicago area, but also southern Wisconsin.⁴ Ms. Benaim and Ms. Brenner obtained a federally-registered trademark for "You're Fired!" in 1997, but it was abandoned.⁵ However, they continued to use the mark for their company, "You're Fired," for the last seven years, as they continued to sell ceramics and pottery and teach classes at their studio.⁶ Because of her patronage and goodwill built up through the last seven years, Ms. Brenner claims she has developed a common-law trademark right that entitles her to exclusive use of "You're Fired" on ceramics and pottery in the Greater Chicago region.⁷ In addition to ceramics and pottery, Ms. Brenner also claims that she has rights to t-shirts because she has sponsored little league teams for the last six years whose members wear t-

³ Ameet Sachdev, *Trump's Trademark Plan Under Fire*, Chicago Tribune (Mar. 30, 2004).

⁴ *Id.*

⁵ The original application was filed by a company called "Art 'N Soul", of which Benaim was president and Brenner was secretary. They apparently abandoned the name "Art 'N Soul" for a new company called "You're Fired!" which conducts the same business and uses their federally registered mark. Nonetheless, that mark was abandoned for apparent failure to pay maintenance dues. Search of WESTLAW, Public Records, Businesses, Corporate Records and Business Registrations (May 27, 2004) (searching for the term "Art N Soul" and finding 14 companies).

⁶ Ameet Sachdev, *Trump's Trademark Plan Under Fire*, Chicago Tribune (Mar. 30, 2004).

⁷ *American Morning* (CNN television broadcast, Apr. 1, 2004).

shirts branded with her store's name.⁸ Ms. Brenner claims that Mr. Trump's use of "You're Fired" will cause reverse confusion and that tarnishment of her business will occur.⁹

An analysis of Ms. Brenner's reverse-confusion claim yields a victory for Mr. Trump. In comparing Mr. Trump's trademark intent-to-use applications in the last several months with Ms. Brenner's 1997 abandoned trademark commercial use application, the only conflicts would be in categories 100 and 101 (miscellaneous service marks and advertising and business services, respectively). The conflicts would mean that Ms. Brenner would have protection against Mr. Trump's use of the mark on products under categories 100 and 101 in the Greater Chicago area. Nevertheless, since the mark was officially abandoned, whatever protection Ms. Brenner's mark has depends on what goodwill she has established in the last seven years regarding ceramics and mosaics. For ceramics and mosaics in the Greater Chicago area, Ms. Brenner would likely receive full protection of her mark. Anything outside her market of mosaics and ceramics, however, is fair game for Mr. Trump, or anyone else. For example, a souvenir mug is arguably too far from ceramics to be considered a conflict. In addition, Ms. Brenner's claim on t-shirts would fall short because the t-shirts used by the little league are the sponsor's t-shirts, and they were not commercially used. Thus, Ms. Brenner's claim on the t-shirts is too remote to establish trademark protection.

Further, in regard to Ms. Brenner's tarnishment claim, Mr. Trump should not be liable, because Ms. Brenner will be unable to point to any precedent establishing that an association with legal gambling amounts to tarnishment. In fact, the only authority Ms. Brenner could rely on is a Second Circuit case.¹⁰ In *New York Stock Exchange*, the New York Stock Exchange ("NYSE") sued the New York, New York Hotel in Las Vegas for use of an image of the NYSE

⁸ *Id.*

⁹ *Id.*

¹⁰ See *New York Stock Exchange, Inc. v. New York, New York Hotel, LLC*, 293 F.3d 550, 558 (2nd Cir. 2002).

on its façade.¹¹ The court did not find that tarnishment had occurred in that case, but only that it was possible that tarnishment could be proven at trial.¹² The court suggested that NYSE, being a business rooted in the inherently risky enterprise of investing, could have wanted to preserve its reputation for “integrity and transparency in the trading conducted on its floor,” and that a trier of fact could find that an association with “odds stacked heavily in favor of the house” was injurious to NYSE’s reputation.¹³ Thus, Ms. Brenner would need to show that her business is so grounded in principles inconsistent with those of the legal gambling industry that any association with Mr. Trump’s casinos would injure her business reputation. Arguably, this is unlikely. Ms. Brenner’s business is not grounded in odds or risks the same way as the NYSE, making any association with meager odds inconsequential. Even if she can make an adequate showing that her business’s principles are contrary to the legal gambling industry, the Second Circuit holding will only prevent summary judgment in Mr. Trump’s favor. At trial she would be left without precedent yet again.

Although it appears that as long as Ms. Brenner and Mr. Trump stay to their respective uses Mr. Trump will be allowed to have his mark, a bigger issue remains, i.e. that the term “You’re Fired” may already have become generic. At most, the term is merely descriptive and therefore requires secondary meaning in order for the mark to establish any protection. This secondary meaning will likely be very difficult for Mr. Trump to establish because of the long history of the phrase “You’re Fired” as slang for termination of employment.

¹¹ *Id.* at 552.

¹² *Id.* at 558.

¹³ *Id.*

The origin of the phrase “You’re Fired” with respect to terminating an individual’s job has been used since at least 1885.¹⁴ In a chapter having to do with unions, Flexner asserts that “the easiest way to get rid of a union member was to fire that person.”¹⁵ Flexner then lists a variety of other methods to “fire” someone and the corresponding date that it was used. A few examples are “giving one [their] walking papers” (1825), or “walking ticket” (1835), and these people were said to “get the boot” (1888).¹⁶

There is further evidence that the phrase is even several hundred years older than Flexner suggests. The word “fired” originated in Mendip, just south of Bristol, England and originally meant to discharge from a job.¹⁷ More specifically, it is found in item 6 of the Laws of Mendip Miners.¹⁸ The law reads:

[i]f any man... do pick or steale any lead or ore to the value of XIID[87], the Lord or his Officer may arrest all his lead and ore House or hearthes with his Grooves and Workes and keep them in forfeit... and shall take the person that hath soe affeeded and bring him where his house or worke and all his tooles and instruments are... and put him into his house or worke and set fire in all together about him and banish him,

This means that if any man stole a certain amount of ore from his Lord or Officer, the Lord or Officer may arrest the offender, place the offender in the offender’s house and set fire to it, hence the term “fired.”¹⁹

Even if the term “You’re Fired” is not generic, it is at most descriptive, which requires secondary meaning for trademark protection. This secondary meaning will be difficult to attain because it is commonly known that the term “You’re Fired” has been a part of corporate America since its birth from the Industrial Revolution. Every employee from factory worker to

¹⁴ Stuart Berg Flexner, *Listening to America: An Illustrated History of Words and Phrases from our Lively and Splendid Past* 517-518 (Simon & Schuster 1982).

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ James Briggs, *The Bedtime Browser* <<http://www.briggs13.fsnet.co.uk/book/ef.htm>> (accessed Jun. 4, 2004).

¹⁸ *Id.*

¹⁹ *Id.*

corporate executive knows, and has known, what the phrase has meant for decades. Arguably, allowing such a phrase to even be considered for trademark protection is absurd because the term will likely never be associated with any one commercial enterprise strongly enough to establish secondary meaning necessary for trademark protection of descriptive marks. In fact, to allow “You’re Fired” to gain trademark protection for a secondary meaning it attained centuries ago would be similar --though perhaps less extreme-- to allowing Hallmark to trademark the phrase “I love you.”

In conclusion, Ms. Brenner should be allowed to protect her ceramic and mosaic trademarks in the greater Chicago region because she has attained goodwill and patronage in the area for the last seven years. Her t-shirts were never commercially sold and thus no protection of clothing goods should be extended to Ms. Brenner. Additionally, Ms. Brenner’s tarnishment claim would fail for lack of precedent showing that an association with gambling is inherently injurious. Even so, Mr. Trump arguably deserves no protection because the meaning of the phrase “You’re Fired” originated centuries ago in feudal England and is commonly used in American slang. As such, the mark “You’re Fired” has either become generic or is at most descriptive and lacking the secondary meaning required to achieve trademark protection.

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