

Will.i.am Trademark Lesson: Set realistic goals, Haynes and Boone's Parker says

August 23, 2017

RELATED PRACTICES Intellectual Property Litigation, Intellectual Property, Litigation

The Black Eyed Peas' will.i.am can't expand the trademark on his signature phrase "I Am" into the market for sunglasses and jewelry, the U.S. Court of Appeals for the Federal Circuit ruled recently, and Haynes Boone Partner Kenneth Parker, chair of the firm's Intellectual Property Litigation section, and Associate Diana Obradovich explained why in the [Aug. 22 Daily Journal](#).

"The lynchpin of the panel's decision was its agreement with the Trademark Trial and Appeal Board that an amendment to the descriptions of goods for the mark was insufficient. The case illustrates the need to consider tailoring one's trademark prosecution strategy, and the sought-after marks themselves, with realistic goals in mind," they wrote.

"It also demonstrates the board's and court's view of (1) the difference between explicitly limiting or qualifying the applied-for mark itself as distinguished from the identification of goods for which the mark is sought; and (2) the need for specificity, and traditional language, in describing trade channels to distinguish a potential mark's use from that of an existing mark."

Parker and Obradovich suggested ways in which will.i.am, whose real name is William Adams, could have avoided confusion: "Modifying the mark itself to include a phrase such as 'by will.i.am' would have made clear what the consuming public would see and distinguish it from pre-existing marks. Better yet, prosecution, in parallel, of a modified mark with an additional limitation should be considered under circumstances like these."

Excerpted from the *Daily Journal*. To read the full article, click [here](#). (Subscription required)