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Court rejects Oprah's trademark fair use defense for motivational slogan

Owning things is an important concept for Oprah Winfrey. She once testified that she had created a culture of ownership at her company, Harpo Productions. "My intent always is to own myself and every part of myself that I can, including photographs, a building, everything in the building. I have, you know, created a culture ... at Harpo of ownership." She owns O, the magazine. She owns OWN, the Oprah Winfrey Network. She owns a lot of things. One thing she does not own is the trademark "Own Your Power" — more on that later.

The testimony above about Oprah's culture of ownership was given almost 15 years ago in a deposition in the case of *Natkin v. Winfrey*, 111 F. Supp. 2d 1003 (N.D. Ill. 2000). It was a suit by two Chicago freelance photographers, Paul Natkin and Stephen Green, who claimed that Winfrey published some of their copyrighted photographs in one of her books without their permission. They had created the photos over a period of years during tapings of "The Oprah Winfrey Show."

Not surprisingly, Winfrey claimed that she owned the copyrights. Her philosophy of ownership, however, did not align with the rules of ownership in the copyright law. The court (U.S. District Judge Ruben Castillo) ruled that Natkin and Green, not Oprah, owned the copyrights in the photos. The photographers were independent contractors, not employees of Oprah, and thus the photos were not works made for hire. Absent a written agreement to the contrary, copyrights in works created by freelancers like Natkin and Green are owned by the freelancers, not the party who hires them. The photographers had never signed such an agreement. So that's another example of something Oprah does not own.

Currently, Winfrey is in a different type of ownership dispute. This time the court battle involves a trademark instead of a copyright. The case relates to Win-

frey's use of the phrase "Own Your Power." Oprah is on the defense in this case, and her defense is that she is using the phrase descriptively and not as a trademark. Ironically, despite her culture of ownership, her legal team in this case asserts that she does not own a trademark in the phrase.

Simone Kelly-Brown owns a motivational services business, Own Your Power Communications Inc., engaging in personal and business development coaching. OYPC's stated mission is "to serve as an empowering Guiding Force ... connecting entrepreneurs to their fullest potential." Kelly-Brown reminds us on her website that "ANYTHING YOU WANT IS ATTAINABLE!" That's good — I wish I had known that sooner. But to make that happen, the motivational coach says, you have to "maintain the 'Own Your Power' attitude." Wisely, and perhaps as a manifestation of owning her power, Kelly-Brown registered her "Own Your Power" trademark in 2008.

Oprah Winfrey is a great motivator too, encouraging her fans to "Live Your Best Life." (In fact, Oprah owns a federally registered trademark on that bit of sage advice). In 2010, Oprah's empire launched a campaign encouraging her followers to "Own Your Power." For Kelly-Brown, who serves an audience similar to Oprah's, this was not good news. With vast resources and numerous media outlets, Oprah could quickly co-opt the "Own Your Power" name, leaving Kelly-Brown's motivational business looking derivative, like a lame Oprah wannabe.

True to her philosophy, Kelly-Brown took action and filed a trademark infringement suit against Winfrey and Harpo Productions, alleging that the defendants had infringed her trademark by "producing a bevy of publications, events and online content" all using the trademarked phrase. First was a prominent use of the phrase on the cover of Oprah's magazine, fol-



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lowed by an "Own Your Power" event at which celebrities posed for photos in front of an "Own Your Power" banner. Winfrey's website had "Own Your Power" banners and content on at least 75 different pages.

Winfrey claims she was merely using the phrase as a description to illustrate the ideas and content contained in her publications. She was relying on the doctrine of trademark fair use. "Fair use" is an important limitation on the rights of trademark owners to prevent overreaching when a mark contains common words.

The law does not want trademarks to be used in a way that

stifles expression or monopolizes language needed to fairly describe things or ideas. It provides a defense to someone who uses a phrase which happens to be a trademark (such as "Own Your Power" or "Live Your Best Life") if the phrase is used 1) other than as a mark, 2) in a descriptive sense and 3) in good faith.

The district court found that Winfrey's use of the phrase was a fair descriptive use and dismissed Kelly-Brown's case, but the court of appeals reinstated the case. *Kelly-Brown v. Winfrey* (2d Cir., May 31, 2013). It held that Kelly-Brown had adequately alleged that the defendants' use of the phrase could constitute use "as a trademark" rather than just as a descriptive phrase. While simply using a phrase on a magazine cover or as a headline would not normally qualify as trademark use, here the plaintiff made a plausible allegation that Oprah used the term "as a symbol to attract public attention" and not just as a descriptive phrase.

The defendants' use was far more wide-ranging than just a callout on a magazine cover. Winfrey had made an entire range of uses that collectively gave plausibility to Kelly-Brown's allegation that Oprah was "attempting to build a new segment of her media empire" around the catch phrase "Own Your Power."

Winfrey's recurring use of the phrase contributed to the appellate court's finding that it could be considered a trademark use.

"Repetition is important because it forges an association in the minds of consumers between a marketing device and a product."

Litigating against Winfrey's media empire is not for the faint of heart. Kelly-Brown tells us that the term "Own Your Power ... represents a confident state of mind." She demonstrated her confidence by bringing the appeal and winning. Adhering to her own motivational coaching philosophy, she used her power to achieve her goals. Remember, "Anything you want is attainable!" So far she seems to be right.

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