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What's in a Name? Maybe More in Rihanna Than Phyllis Schlafly

What does Rihanna's father have in common with the brewer nephew of a late anti-feminist icon?

Both have been confronted by famous relatives over commercial rights to the family name.

But names aren't the same when it comes to trademarks. The law blocks registration of a mark that is ''primarily merely a surname''; the standard is whether a name acquires another established meaning before registration.

So while Rihanna's Fenty brand may not be Ford, trademark lawyers say the pop singer probably has a stronger case than the late conservative activist Phyllis Schlafly, whose estate lost a trademark battle with a nephew whose St. Louis brewery has produced Schlafly beer since 1991.

''Phyllis had no connection to the beer industry. It's not as though the nephew of hers was riding on her coattails. At least not as the way the Rihanna case is being portrayed,'' said Virginia Wolk Marino, an intellectual property attorney for Brinks Gilson & Lione.

The fact her estranged father is using the family name in his own entertainment business is a key component of the case pursued by Rihanna, who has used her music fame to sell cosmetics branded with her last name. She claims her father, Ronald Fenty, is trading on her name without permission with his Fenty Entertainment LLC and that his company ''blatantly'' ignored requests to stop claiming association with her.

Family of Factors The U.S. Patent and Trademark Office and courts treat rights to fanciful marks like Pepsi or Clorox, or arbitrary marks like Apple, as first-come-first-serve within an industry. Surnames, famous or not, are treated more like descriptive marks—marks that merely describe a product, like Windows or Sharp—in that they must have a secondary meaning to consumers before registration. Marino said she sees surname refusals from the PTO for failing to show secondary meaning ''all the time.''

Family feuds have frequently popped up in trademark law. Eric Ball, a trademark lawyer at Fenwick & West LLP, noted the 13 years of rancorous litigation between the Gallo siblings ending in 1992. Two brothers running the long-established E & J Gallo Winery successfully blocked their younger brother from selling cheese under a Gallo or even Joseph Gallo brand because they established likely consumer confusion.

James E. Griffith, an intellectual property attorney for Marshall Gerstein & Borun LLP, said the twist with surname litigation is that accused infringers often claim a right to trademark their own name as a defense. But that's not always true. Rights depend on a number of factors, including the strength of the existing mark, proximity of the related goods, similarity of the marks, evidence of confusion and the newcomer's intent.

''It's a fact-intensive inquiry,'' Griffith said. ''Does the defendant appear to be acting in good faith, or seeking to exploit their own personal name or the name of a brand owner in a way that violates the court's sense of the equities?''

Griffith said the distance between Phyllis Schlafly, who made her name as a conservative pundit and opponent of the Equal Rights Amendment, and the trade of selling beer made it a ''reach'' that her estate would be associated with Schlafly beer by consumers. Her son, the brewer's cousin, also joined the doomed suit on the side of her estate because association with beer might hurt his physician practice.

The Federal Circuit affirmed the St. Louis Beer Co.'s rights to the mark, finding the brand's extensive sales and marketing had established meaning separate from the family name.

Ronald Fenty's use of Rihanna's name, however, would be ''exploitation or possibly even fraud'' as alleged if the case shows he asserted a false connection between his entertainment company and a famous entertainer, Griffith said. A court would likely look at that use ''with less favor,'' he said.

Fame in a Name Similar or identical marks can often co-exist in different industries, Marino pointed out. But anti-dilution trademark law allows an owner of a famous mark well-known to the general public to reach across industries to prevent dilution or tarnishment of their brand.

Establishing a misleading association with an individual is enough to block use of a surname mark regardless of fame, Ball noted. Varying state laws on right of publicity can also come into play.

But Marino said fame can help in confusion balancing tests. And when an allegedly infringed mark has established a level of fame among the general public, tarnishment and dilution claims that reach across industries can be factors.

The Federal Circuit noted Phyllis Schlafly was clearly a public figure, but ruled 75 million beer sales in a five-year period, advertising spending and media recognition clearly established secondary meaning for the beer company.

In Rihanna's case, her fame mixed with the proximity of her father's far-less established business to her name and alleged bad faith could give her the upper hand.

''Obviously Rihanna's an entertainer. There's obviously an association with what he's purportedly trying to do with the mark,'' Marino said.

Ball also raised the question of whether that tarnishment protection could survive a Supreme Court challenge. He noted the 2017 Supreme Court decision in Matal v. Tam invalidating a ban on disparaging trademarks, forcing the PTO to register ''The Slants'' to an Asian-American band.

Ball said he expects Iancu v. Brunetti, currently pending before the high court, to do the same to the ban on ''immoral or scandalous marks'' despite the PTO's request to let it block ''FUCT'' as a clothing mark.

He wondered if the court might also reach further and address the tarnishment prohibition, used by Anheuser-Busch's to block a ''Buttwiser'' mark, and North Face to force ''South Butt'' into mediation and a settlement.

''Tarnishment sounds a lot like disparagement,'' Ball said. ''The court might not explicitly take a swipe at fame or tarnishment, but it could.''

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