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Girls Gone Wild: Trademark Infringement or Publicity Stunt?

By: Donna Ray Berkelhammer. ***Monday, February 6th, 2012***

Did **Madonna** infringe the Girls Gone Wild video series trademark by recording a **song** with the same name? Probably not, but (with the typical lawyer disclaimer) it depends.

Girls Gone Wild is a video series where young women (usually at Spring Break or Mardi Gras parties) agree to be filmed stripping or flashing. Madonna, halftime entertainment at last night's **Super Bowl** XLVI, has a song on her latest (unreleased) **album** entitled "Girls Gone Wild." The owner of the Girls Gone Wild trademark for adult videos and related products sent a **cease and desist letter** this week warning Madonna not to sing this song at the Super Bowl.

Is this trademark infringement?

First , song titles are not **trademarks** and cannot be registered as such. To act as a trademark, a term must be used to identify the source of goods or services (i.e., FORD for trucks or CHILI'S for restaurant services). A song title doesn't typically do this. Sometimes, the song title can be the subject of **copyright** protection, but generally a title is considered too short and unoriginal to be an "original work of art" that is subject to copyright protection.

Second, even if the title did function as a trademark, identical trademarks can **co-exist** in different classes of goods. A classic example is DOMINO'S pizza and DOMINO'S sugar. Even though these are both foods, they are different enough in target markets, retail outlets, use by the end-user, method of purchase, etc., that these identical trademarks are allowed to co-exist. A song title (that probably has a corresponding music video) and a video may be so closely connected that these would not be allowed to co-exist, because they might create a likelihood of confusion in the relevant customer (This is where the "it depends" comes into play).

Likelihood of confusion with a pre-existing mark is the standard for trademark infringement. Courts will consider a variety of factors in determining whether the reasonable customer would become confused. The factors come from a 1961 New York case, **Polaroid Corp. v. Polaroid Elects.Corp**., 287 F.2d 492 (2nd Cir.), cert. denied, 368 U.S. 820 (1961).

1. The strength of the plaintiff's [complaining party, usually the owner of the pre-existing mark] mark;
2. The degree of similarity between the plaintiff's and the defendant's marks;
3. The proximity of the products or services covered by marks;
4. The likelihood that the plaintiff will bridge the gap;
5. Evidence of actual confusion of consumers;
6. The defendant's good faith in adopting the mark;
7. The quality of the defendant's product or service; and
8. Consumer sophistication.

In this specific case, Madonna also has a first amendment right to use the phrase "Girls Gone Wild" in a song. **Mattel** once sued **MCA Records** for trademark infringement of its famous "Barbie" mark in the song "**Barbie Girl**" recorded by Aqua. The Court dismissed the case on summary judgement, ruling, (1) MCA's use of Mattel's Barbie trademark in a song title did not constitute trademark infringement; and (2) MCA's use of "Barbie" was "non-commercial," constitutionally protected speech and, therefore, exempt from the Federal Trademark Dilution Act (FTDA).

And finally, since Girls Gone Wild did not object to the 2007 **Ludacris** single, Girls Gone Wild, my prediction is: this more owner Joe Francis "goes wild" for free publicity than a legitimate trademark dispute.