

Pre-Emptively Filing a Trademark Application Over a Viral Catchphrase, Not Very Demure

September 9, 2024
By Queen O. Ndukwe



On August 5, 2024, the life of TikTok content creator Jools Lebron changed after she posted a video that went viral. In the video, Lebron uses the phrase “very demure, very mindful, very cutesy.” That TikTok has since been viewed over 23 million times. Lebron has gone on to appear on Jimmy Kimmel Live and snagged endorsements with Zillow, Verizon and K18 hair.

However, Lebron’s joy was dampened after she discovered that an individual named Jefferson A. Bates filed a trademark application with the United States Patent and Trademark Office (“USPTO”) for the wordmark “very demure .. very mindful ..” Bates’ application was filed on August 20, 2024, for advertising, marketing and promotional services related to all industries for the purpose of facilitating networking and socializing opportunities for business purposes. Since then, a few other trademark applications involving the words “demure” and “mindful” have popped up.

But what even is the implication of these trademark applications to Lebron’s growing popularity and association with the catchphrase “very demure?” Can she continue to use the phrase in her videos or for the sale of merchandise?

Under the Lanham Act, the standard test of trademark ownership is a priority of use in the marketplace. This means that ownership of a trademark is acquired by use in the ordinary course of trade, for example, by selling merchandise with the mark. On the other hand, trademark registration creates a legal presumption of ownership and provides notice of such ownership to the public. A trademark registration is obtained by submitting an application to the USPTO for the registration of the trademark. Such an application may be based upon actual use in federally regulated commerce. However, it is quite common to submit a trademark application as a way to reserve trademark rights prior to, but in anticipation of, actual use of the mark, as long as a declaration of bona fide intent-to-use in federally regulated commerce is submitted with the application, although an applicant under the intent-to-use category, will ultimately be required to submit a declaration of actual use before registration is granted.

Bates’ trademark application alone does not reserve or guarantee his ownership of the “very demure .. very mindful ..” mark. Registering a mark involves a review by an examining attorney from the USPTO, and the process can take up to 18 months. During the review process, the examining attorney reviews the application to make sure it meets all legal requirements for registration. In fact, the USPTO may even reject the application for various legal reasons. For example, if the application conflicts with a mark that has already been registered or that is pending registration, the USPTO will issue an office action. An office action is a letter from the USPTO informing an applicant of the issues with a trademark application. An office action must be resolved before registration can be granted. After the review process, the trademark is published in the Trademark Official Gazette. At this point, any member of the public can oppose the registration of the trademark within 30 days of the publication. Alternatively, a letter of protest may be submitted with the USPTO.

Even though filing a federal trademark application could provide Bates with some protection, trademark rights are

automatically acquired through use of the mark in the marketplace. Thus, any protection that Bates may have received from his application may be subject to the rights of earlier users of the mark in the marketplace. However, can LeBron's iconic use of the phrase in her TikTok videos be considered prior use in commerce? In decided cases, the Trademark Board has explained that mere advertising without rendering services under a mark could, in some circumstances, constitute use sufficient to prove priority. Every case is different, and the decision of the Trademark Board depends on the specifics at hand. LeBron can certainly continue to make videos using the viral catchphrase, but the clock may have started ticking on a race to the marketplace.

Navigating the trademark application process or opposing the registration of a trademark can be confusing. If you are concerned about understanding how trademark rights can protect your business and brand name, we recommend consulting with an intellectual property attorney to discuss your options.