

Lady Gaga stops Lady Goo Goo's song – trade marks and parodies in the UK

Lady Gaga's company has won an interim injunction in the UK against a song by animated character Lady Goo Goo, who features in the Moshi Monsters children's game.

The case is interesting because it shows how trade mark rights can be used against parodies (at a time when the UK Government is wondering whether to reform copyright law on parodies) and for what it says about whether injunctions can be granted when material has already found its way onto YouTube. This was a case brought on an emergency basis for an interim injunction to keep Lady Goo Goo's song off the air until a full trial has taken place.

The time line

The Moshi Monsters game (said to have over 50 million users) features various parody characters, among them Broccoli Spears and Banana Montana. The Lady Goo Goo character was introduced in September 2009, several months after Lady Gaga had her first hit in Europe. Moshi Monsters at first denied that Lady Goo Goo was anything to do with Lady Gaga, but that argument was given a short shrift. Lady Gaga said she had only become aware of the Lady Goo Goo character recently and what caused her particular concern was the launch of a single, initially on YouTube and with the ultimate intention of becoming a chart topper, such that Lady Goo Goo was now "trespassing" into Lady Gaga's core market. What is more, Lady Gaga's company had a registered trade mark dating back to 2010, and had launched a branded area within children's online game Farmville in May 2011. Moshi Monsters tried to register its own trade mark for the Lady Goo Goo name in April 2011 and launched Lady Goo Goo's song the Moshi Dance Song, in the game and then on YouTube, in June. In September 2011, the case was set in motion.

What was Lady Gaga trying to stop?

At this emergency stage, Lady Gaga's company was only trying to stop the release of the Moshi Dance Song, leaving the question of the character itself to a later stage. Moshi Monsters originally denied that the Moshi Dance Song bore any resemblance to Lady Gaga's hit "Bad Romance". However, the case relates not to copyright (i.e. does not look at whether the Moshi Dance Song is too close to Bad Romance) but at whether the Lady Goo Goo character's name infringed the Lady Gaga trade mark.

Trade mark issues

For the purposes of the emergency court application, Moshi Monsters accepted that there was "a serious case to be tried" (one of the criteria for getting an emergency injunction) under trade mark law, both on the basis that the Lady Goo Goo name was similar to Lady Gaga and there existed a "likelihood of confusion" and on the basis that Lady Gaga was a famous brand and Lady Goo Goo might take unfair advantage of its distinctive character. These are two of the tests for trade mark infringement in Europe.

Against that backdrop, the judge's task was to assess whether the song should be enjoined until a full trial took place. Amongst other things, Lady Gaga wanted Moshi Monsters to take the song off YouTube, even though both sides realised that there was little they could do to stop users putting it back on again.

Was this a parody?

First, the judge looked at how trade mark law applies to parodies. For example, in a South African case, use of the Carling Black Label trade mark on t-shirts which had a political message did not infringe Carling's rights.

However, the judge made it plain that he felt that this was a very different case. This was not a question of a protest or a simple spoof, but it seemed that Lady Goo Goo had “morphed into ... a character who is being used to enhance the commercial success of the Moshi Monsters brand, and now to sell records” – it was clear that she was no longer a “pure parody”. The case therefore shifted away from the law on parody and towards classical trade mark infringement.

One of the criteria in assessing infringement was whether people would be confused between the two brands. The judge held that it was strongly arguable that people would make a clear connection between Lady Gaga and Lady Goo Goo and might well think that the two were commercially connected. It was noteworthy that Moshi Monsters had tagged the song on You Tube so that if a user searched for “Lady Gaga”, he or she would find the Moshi Dance Song. In short, “some, if not many, average consumers ... would be confused”. Indeed, the blogs displayed a large element of confusion with people referring to Lady Gaga in the same breath as Lady Goo Goo.

On the second type of trade mark infringement, relating to Lady Gaga being a famous mark, the judge also held that the relevant criteria were present. Unlike the recent cases relating to Google ad word (for example, the use by Marks and Spencer of the ad word Interflora) it was not clear that Lady Gaga and Lady Goo Goo were unconnected. It was in fact quite likely that people would think that Lady Gaga must have approved the animated character and there was therefore a good arguable case that the distinctive character of the Lady Gaga mark would be damaged.

Given the similarity between the songs (and the admittedly annoying nature of the Moshi Dance Song!) there was also a real risk of damage to Lady Gaga’s brand through “tarnishment”.

Should the court grant an injunction?

Finally, the judge looked at where the balance of convenience lay and whether an injunction should be granted. Both sides stood to suffer damage if they lost at this interim stage. Moshi Monsters had already spent some \$200,000 on producing and publicising the song, but Lady Gaga could suffer incalculable loss to her brand. The judge decided that whilst Moshi Monsters could carry on using Lady Goo Goo in the Moshi Monsters game for the time being, the new musical release of the song should be prevented by an injunction. He took into account the fact that Moshi Monsters went into this with their “eyes wide open”. Lady Gaga’s company was ordered to put up £300,000 as a condition of the injunction being granted.

The dividing line was between allowing Lady Goo Goo to remain within the confines of the children’s game on the one hand, and allowing her to become a pop star in her own right on the other. The full case will be crucial for the Moshi Monsters game and its other parody characters.

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