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Ice Cube May Need to Check Himself

Introduction

In March of this year, the rapper Ice Cube, filed a claim against Robinhood, a popular online stock trading platform. Ice Cube alleges Robinhood used his likeness, and one of his catchphrases, Check Yo Self ("CYS"), in a newsletter article. Ignoring some differences between U.S. and Canadian trademark law, Ice Cube's claim raises interesting questions. This short paper will assess a hypothetical of how Ice Cube could pursue a trademark infringement claim if the events occurred in Canada. Ultimately, Ice Cube's hypothetical claims would be unlikely to succeed.

Registering "CYS" in Canada

First, assume that Ice Cube was able to successfully register a trademark in Canada for the phrase CYS, used in conjunction with assorted goods and services. This is a reasonable assumption. CYS originates from Ice Cube's original song lyrics, is relatively distinctive, and has been associated with his persona since that time. CYS appears registrable according to s. 12(1) and (2) of the Trademarks Act. According to s. 2 of the Trademarks Act, Ice Cube would not need to show he has actually used CYS for each associated good and service on his trademark application. We will also assume the trademark has not been expunged for non-use per s. 45.

Infringement on the "CYS" Trademark

If Robinhood used CYS in a newsletter on their hypothetical Canadian site, Ice Cube could try and make two claims.

a. Confusion

First, he could claim infringement under s. 20 of the Trademarks Act. This section deems infringement if a trademark is used for different goods or services in a way that would cause confusion. This claim is unlikely to succeed. The Mattel case shows that courts will focus on whether an "ordinary hurried purchaser" will be confused as to the source of goods or services. Robinhood's newsletter is accessed via their website, or via subscription. There is little chance that Robinhood's customers would think Ice Cube was the source of the newsletter article.

b. Depreciating Goodwill

Second, Ice Cube could claim infringement under s. 22 of the Trademarks Act. This section prevents use of a trademark in a way that devalues its goodwill. The Veuve Clicquot case establishes that s. 22 claims should be assessed carefully, by looking for proof of four discrete elements.

1) Is the Plaintiff's trademark "used" in connection with the Defendant's goods or services, providing some notice of association?
2) Is the Plaintiff well-known to have goodwill?

3) Is the Defendant's "use" likely to be linked or connected with the Plaintiff's goodwill?
4) Is the likely effect to depreciate the Plaintiff's goodwill?

Ice Cube's claim is likely to fail on element four - Robinhood's use of CYS is unlikely to depreciate Ice Cube's goodwill in the trademark.

i. Is the Plaintiff's trademark "used" in connection with the Defendant's goods or services, providing some notice of association?

In this case, "use" is an interesting question. Robinhood is primarily in the services business. In s. 4(2) of the Trademarks Act, a trademark is deemed used if it is displayed in the advertising of services. In the real-life, U.S. scenario, Robinhood has claimed their newsletter is for editorial, non-commercial purposes. In Canada, they could argue their use of CYS was not done while advertising services, and therefore not "use" per s. 4(2) of the Act.

Looking more closely at Robinhood's newsletter, it is likely to be viewed as a form of advertisement. The newsletter can be accessed via their main company website, under a tab labelled "learn". At that point, visitors can view a few selected articles, or subscribe for more by providing their email address. Presumably, providing your email is an opt-in to other forms of Robinhood advertising. At all times, the visitor has a "sign up" button in the top right corner to join Robinhood's stock trading platform - their primary business. The newsletter articles provide knowledge and advice relevant to stock trading. All these factors suggest that Robinhood's newsletter is an effort to gain business on their platform.

Notice of association is less of an issue here than in Veuve Clicquot. In this case, Robinhood used an image of Ice Cube alongside CYS, to ensure notice of association took place.

ii. *Is the Plaintiff well-known to have goodwill?*

For the purposes of this paper, we can assume that a well-known celebrity, like Ice Cube, has some goodwill in CYS, the title of his famous song, also used frequently by him as a catchphrase.

iii. *Is the Defendant's "use" likely to be linked or connected with the Plaintiff's goodwill?*

In this case, a connection would be possible to prove. As noted earlier, Robinhood's newsletter included a picture of Ice Cube to ensure that consumers make a connection between Robinhood's use of CYS and Ice Cube's trademark.

iv. *Is the likely effect to depreciate the Plaintiff's goodwill?*

This is where Ice Cube's claim is likely to fail. As the court noted in Veuve Clicquot, a mere association does not necessarily depreciate goodwill. Depreciation of goodwill requires some loss of distinctiveness, image dilution, or disparagement.

Here, there is little risk of lost distinctiveness. CYS is already used commonly as slang, or reference to Ice Cube. Ice Cube could argue that Robinhood's actions dilute his goodwill by creating a new association between CYS and Robinhood. This is unlikely to succeed since Robinhood used CYS in a single newsletter that is unlikely to change a person's association with the trademark.

Ice Cube's strongest argument could be that Robinhood's recent negative publicity with GameStop (around the time they used CYS) tarnishes his goodwill in the trademark. While this argument has some merit, Veuve Clicquot shows that possible tarnishment isn't enough. Ice Cube would need to prove likely tarnishment, which would be practically difficult.

Ultimately, the Supreme Court of Canada has established that a s. 22 claim will be difficult unless there is some commercially competitive context. Without that context, and clear proof of likely tarnishment, Ice Cube's claim is likely to fail.