

2022

The Intersection of Trademark Law, Athletes, and Money: A "Three-Peat®"

Abby R. Glaus

Follow this and additional works at: <https://scholarship.law.marquette.edu/sportslaw>



Part of the [Entertainment, Arts, and Sports Law Commons](#)

Repository Citation

Abby R. Glaus, *The Intersection of Trademark Law, Athletes, and Money: A "Three-Peat®"*, 32 Marq. Sports L. Rev. 583 (2022)

Available at: <https://scholarship.law.marquette.edu/sportslaw/vol32/iss2/9>

This Comment is brought to you for free and open access by the Journals at Marquette Law Scholarly Commons. For more information, please contact megan.obrien@marquette.edu.

THE INTERSECTION OF TRADEMARK LAW, ATHLETES, AND MONEY: A “THREE-PEAT[®]”*

ABBY R. GLAUS**

INTRODUCTION

Professional athletes have a distinctive brand.¹ In an effort to grow and protect that brand, athletes have drastically increased the number of trademark applications they file.² This process of growing and protecting their personal brand raises many legal issues.³ This comment analyzes sports industry trends and predicts that the scope of trademark law will continue to widen, and an individual athlete’s power to protect their marks will increase. So, the issue becomes how far this trend will go?

This comment will begin by describing the growth of sports trademarks throughout history and the reason for it. This is followed by an explanation of the laws governing this area and those enacted due to the substantial historical changes in trademark protection. Lastly, this comment seeks to analyze the question of how far trademark law and protection will expand. The industry of sports trademarks will naturally continue to grow. As a result, the scope of what is trademarkable, specifically for athletes, could grow. Additionally, the

* Three-Peat, Registration No. 1552980.

** Abby R. Glaus is a third-year J.D. Candidate at Marquette University Law School and is earning a Sports Law Certificate through the National Sports Law Institute. Abby is currently the Survey and Index Editor of the *Marquette Sports Law Review*. Within the Sports Law Program she also serves as Vice President of Sports Law Society, Internal Competition Chair of the Sports Law Competition Board, and Co-chair of the Alumni Outreach Committee. Abby would like to thank her friend and current Editor-in-Chief of the *Marquette Sports Law Review*, Quinn A. Stigers, for her help with the publication of this comment. Abby would also like to thank her loving friends and family, specifically her fiancé, Austin, parents, two brothers, best friend, Lily, and partner, Laurel, for their support.

1. Christopher Psihoules & Jennette Wiser, *Highlights from Today’s Game: Trademark Coverage on the Offensive*, 88 N.Y. STATE BAR ASS’N J. 11 (2016).

2. *Id.*

3. Vejay Lalla & Albert Tawil, *The Evolving Relationships Between Brands and Athletes: What Comes Next?*, 33 INTELL. PROP. & TECH. L.J. 3 (2021).

comment will explain the notable trend towards near full proof legal protection in all areas of sports-related trademarks.

I. ATHLETE TRADEMARKS

Today's athletes have the ability to protect a wide scope of their brand through trademark law and have the ability to enforce their trademarks, more than the average citizen. A brief history of the interaction between athletes and trademarks is necessary to understand this trend. Even more foundational to understanding this area is the current state of trademark law. This comment starts by describing growth throughout the history of sports-related trademarks and what is causing the growth, followed by the laws allowing for this to occur.

A. "LET'S GET READY TO RUMBLE"⁴

Within sports, trademarking was not prevalent from the very beginning.⁵ It was not until around 1975 that courts started discussing protecting team brands within professional hockey, and started to protect athletic marks.⁶ Over the next few decades, trademark protection in sports changed incredibly. Most important to this inquiry is the growth of trademark applications and ultimately in the number of trademarks related to sports.

This comment will highlight that this trend is still occurring. As of 2014, registered sports industry trademarks "grew for the fourth consecutive year with \$907 million in royalty revenue on retail sales of \$16.6 billion."⁷ There has been a steady growth in the industry since then, that has allowed athletes to profit significantly off trademarks.⁸ For example, Michael Buffer's "Let's get ready to Rumbbbbllllleeeee" has netted the Buffer brothers over \$100 million over the years.⁹ Many trademarks will never be this popular, frankly, because athletes recently attempt to trademark "everything," and it seems as if there is a trend towards quantity over quality. To name a few examples of star athletes participating fully in this trend, there is: Tom Brady has 20 trademarks covering

4. LET'S GET READY TO RUMBLE, Registration No. 2,405,492.

5. Mark A. Kahn, *May the Best Merchant Win: The Law of Non-Trademark Uses of Sports Logos*, 14 MARQ. SPORTS L. REV. 283, 285 (2004).

6. *Bos. Pro. Hockey Ass'n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. 1975); Jennifer M. Adams, *Flag on the Play: Professional Sports Teams Calling Trademark Infringement on their Superfans*, 20 JEFFREY S. MOORAD SPORTS L.J. 631 (2013).

7. Psihoules & Wisner, *supra* note 1.

8. Chuck Onofry, *Intellectual Property of Professional Athletes*, SCHNEIDER & ONOFRY, P.C. (2018), <https://www.soarizonalaw.com/blog/intellectual-property-of-professional-athletes-4/>.

9. ESPN Daily, *Why Athletes Want Trademarks for Everything*, ESPN, at 03:25 (Dec. 23, 2020), https://www.espn.com/radio/play/_id/30587197.

his namesake, including, most recently, Tompa Bay, right after he signed with the Buccaneers,¹⁰ Johnny Manziel has many combinations of his name,¹¹ Robert Griffin III has more than seven trademarks for his name and slogans,¹² Anthony Davis and his unibrow,¹³ and Shaquille O'Neil (who is a master at building his brand) owns many trademarks related to his name and likeness.¹⁴

Attorneys on behalf of athletes will continue to look for opportunities to trademark in any possible way they can, even out of a public relations nightmare. The recent example of Lou Williams is a perfect example of the recent trend of athletes looking to trademark “everything.”¹⁵ Lou Williams of the LA Clippers left the NBA Bubble to attend a funeral, and following that, he stopped at a local favorite that he frequented pre-pandemic, the “Magic City” Strip Club, to get the ‘Lemon Pepper Lou’ wings.¹⁶ This broke the NBA Bubble COVID-19 rules, and he was criticized heavily in the media for his poor choices.¹⁷ When this story broke, Mr. Williams moved to trademark ‘Lemon Pepper Lou’ wings and made money from the initial disaster.¹⁸ Athletes will likely continue to apply for trademarks in record numbers.

The whole trademark industry has grown significantly in 2020 and 2021.¹⁹ The COVID-19 pandemic has not slowed filings down.²⁰ In 2021, total trademark applications reached a record high of around 943,000.²¹ This recent growth, 27.9% more applications than just the prior year, can, of course, not be

10. *Id.* at 14:12.

11. Laura Depta, *Ridiculous Sports Trademarks*, BLEACHER REP. (Mar. 11, 2015), <https://bleacherreport.com/articles/2390759-ridiculous-sports-trademarks>.

12. *Sport Trademarks: Everything You Need to Know*, UPCOUNSEL <https://www.upcounsel.com/sport-trademarks> (last updated Nov. 6, 2020).

13. Depta, *supra* note 11.

14. Diana Muller, *Increased IP Awareness by Professional Athletes and Subsequent Effects on Trademark Registration, Social Media Usage, and Online Impersonation*, GOTTLIEB, RACKMAN & REISMAN, P.C., <https://grr.com/publications/increased-ip-awareness-professional-athletes-subsequent-effects-trade-mark-registration-social-media-usage-online-impersonation/> (last visited Apr. 1, 2022).

15. ESPN DAILY, *supra* note 9, at 08:28.

16. *Id.*

17. *Id.* at 09:46.

18. *Id.* at 09:20.

19. 2020 USPTO TRADEMARK PUB. ADVISORY COMM. ANN. REP. 7, https://www.uspto.gov/sites/default/files/documents/TPAC_2020_Annual_Report.pdf; 2021 USPTO PERFORMANCE & ACCOUNTABILITY REP. 2, <https://www.uspto.gov/sites/default/files/documents/USPTOFY21PAR.pdf>.

20. 2021 USPTO PERFORMANCE & ACCOUNTABILITY REP., *supra* note 19.

21. *Id.*

attributed all to athletes.²² There are a variety of reasons for the growth.²³ The important reasons as they directly relate to sports are explained below.

*B. What Is Causing the Growth? "THAT'S A CLOWN QUESTION, BRO."*²⁴

It is essential to understand why the previously explained trend is occurring. This trend and its reasonings feed a cycle that allows athletes to have a wide scope of their brand protected by trademark and the ability to enforce those trademarks. In turn, these results continue to increase applications by athletes. The main catalysts causing the trend of more applications being filed by athletes are the economic value, social media, ease of applications, nuances of the sports industry, and the recognition of trademarks.

The value of the sports world and specific athletes is astronomical. It is common knowledge that professional athletes get paid high salaries for playing, but that is not all. In terms of the level of protection, the number of applications, and granted trademarks, the industry has grown and created excellent economic value for athletes. It is a billion-dollar industry on top of what athletes already make.²⁵ Why would they not keep applying for trademarks? Recall Michael Buffer saying one sentence has made him over \$100 million.²⁶ The vast majority of trademarks might not be this profitable but still accomplish the main objective, protecting the player's brand.²⁷ Trademark protection is essential for athletes who want to protect and profit from their trademark rights.²⁸

Social media and the internet have impacted this expansion of trademarks.²⁹ Having a recognizable brand as a star athlete is incredibly valuable.³⁰ There is an increase in applications among athletes because of a heightened awareness of the value of a highly regarded brand.³¹ Social media has obviously increased athletes' influence, but social media users have, in turn, impacted the trademark industry and athletes. Users creatively come up with many of the names and slogans that athletes and teams' trademark.³² With the rise of social media, when

22. *Id.* at 81.

23. *Id.* at 2, 81.

24. THAT'S A CLOWN QUESTION, BRO., Serial No. 85651210 (filed June 13, 2012).

25. Psihoules & Wisner, *supra* note 1.

26. ESPN DAILY, *supra* note 9, at 03:25.

27. *Id.* at 04:21.

28. See Onofry, *supra* note 8.

29. See Muller, *supra* note 14.

30. *Id.*

31. ESPN DAILY, *supra* note 9, at 07:41.

32. See *id.* at 12:47.

there is a dazzling play, there is often repetitious coverage of it.³³ Then a creative Twitter user comes up with a clever name or slogan for the player or team.³⁴

For example, on November 15, 2020, during an NFL game between the Arizona Cardinals and Buffalo Bills, Kyler Murray launched a jump ball into the end zone with one second left— immediately, ‘Hail Murray’ was born.³⁵ Within 24 hours, Murray’s team had applied for a trademark.³⁶ The past few years have been a unique time for social media and sports. Social media has been a catalyst for significant growth in trademarks for athletes.³⁷

In addition, applying for a trademark is relatively easy for professional athletes, given the legal team they have surrounding them and plenty of disposable income. The process of applying for trademarks is likely not done personally by the athlete but requires due diligence from whoever is.³⁸ The application for registration and verification of a trademark is governed by United States Code Section 1051.³⁹ The ease of application and prominence of athletes looking to register trademarks will lead to a few future issues that this comment will analyze later.

Another reason causing the increase in athlete-related trademarks is because of the nuances of the sports industry. First, athletes in professional sports have a relatively short career; this is particularly true in highly physical sports.⁴⁰ Because of this short career, it is vital that athletes set themselves up for continued financial success. One way of doing that is using trademarks to protect the brand they created while playing.⁴¹ Second, teams, leagues, and businesses all profit significantly from athletes.⁴² The right to certain trademarks surrounding an athlete can often be owned by the team, league, or business they have partnered with.⁴³ While they get paid accordingly for this transfer of rights, athletes, rightfully so, want control over as much of their brand as possible.⁴⁴

33. Loren J. Weber, *Something in the Way She Moves: The Case for Applying Copyright Protection to Sports Moves*, 23 COLUM-VLA J.L. & ARTS 317, 326 (2000).

34. See ESPN DAILY, *supra* note 9, at 13:00.

35. *Id.* at 00:09.

36. *Id.* at 01:25.

37. *Id.* at 06:10.

38. Justin Lampel, *Due Diligence in the Acquisition of Intellectual Property*, 20 DCBA BRIEF 27 (2008).

39. 15 U.S.C.A. § 1051 (West 2021).

40. See Muller, *supra* note 14.

41. See *id.*

42. See Int’l Laws. Network, *Stop the Insanity! Sports Trademarks Run Amok*, JDSUPRA (Oct. 8, 2019), <https://www.jdsupra.com/legalnews/stop-the-insanity-sports-trademarks-run-80588/>.

43. Lalla & Tawil, *supra* note 3, at 4.

44. See *id.* at 1-4.

Therefore, athletes may apply for more trademarks to protect all areas of their brand.

Lastly, sports and athletes are highly accessible and highly commercialized.⁴⁵ Athletes' victories and failures are immediately known by the public, who can react and interact with the athlete (at least on social media) however they want. This notion naturally leads to athletes looking to control the narrative. By having trademarks protecting their brand, they can attempt to limit any significant uses of their name, image, and likeness because they have a recognizable trademark in the eyes of the law.⁴⁶

It has become imperative for athletes to protect their brand from the beginning of their careers.⁴⁷ Athletes file many trademark applications to do so because of the economic value, impact of social media, the simplicity of applying for a trademark, as well as the uniqueness of the sports industry, including the recognition of their trademarks and, therefore, protection of their brand. With that analysis of how and why trademarks usage is increasing for athletes, it is now time to explain the law in this area.

C. "I LOVE ME SOME [Trademark Law]"⁴⁸

Sports-related trademarks were not explicitly covered by the statutes and case law until the 1970s.⁴⁹ From the discussion thus far, it is clear that trademarks related to sports are now valid and widely utilized. This section will describe the applicable trademark laws that must be understood and analyzed in conjunction with the previously described trends. Of significant importance to this comments analysis is defining what is necessary for a trademark to be valid. The Lanham Act, and specifically Section 1127, states that a trademark:

includes any word, name, symbol, or device, or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to

45. See Weber, *supra* note 33, at 319, 324.

46. *Id.* at 325-326.

47. Michael McCann, *From Beast Mode to 'Onions: ' Trademark Attorney Heitner Builds a Brand on IP*, SPORTICO (Oct. 12, 2020, 8:00 AM), <https://www.sportico.com/law/analysis/2020/athlete-trademarks-1234614409/>.

48. I LOVE ME SOME ME, Registration No. 3,709,364.

49. See *Bos. Pro. Hockey Ass'n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. 1975); Adams, *supra* note 6, at 636.

indicate the source of the goods, even if that source is unknown.⁵⁰

All that is required is the “word, name, symbol, or device, or any combination” must be used in commerce and must distinguish the good or service it represents, meaning it must be distinctive.⁵¹ If a mark meets these requirements set out by the statute, it is protected, even if not registered.⁵² However, registration is beneficial as it comes with further protections.⁵³ To be registered, marks must be used in commerce and distinctive.⁵⁴

Logically for athletes, the requirement to use the mark in commerce in a matter that identifies the good or service, themselves, is not an issue. Therefore, trademark protectability for athletes heavily depends on how distinctive the slogan or mark is.⁵⁵ Generally speaking, a trademark can be naturally distinctive or can become distinctive if it is only descriptive by acquiring secondary meaning.⁵⁶ Secondary meaning and distinctiveness are proven by evidence that consumers associate the mark with the athlete.⁵⁷

An example of a distinctive trademark that continues to make millions is the Jordan ‘Jumpman’ logo.⁵⁸ During a magazine photoshoot, Nike, after a disagreement, took one of the model’s poses and made it into a silhouette that resembled the photograph.⁵⁹ This silhouette caused multiple rounds of litigation, but the image was just different enough for Nike to have ownership.⁶⁰ This silhouette logo turned into what is now known as Jordan’s ‘Jumpman’ logo and is worth billions.⁶¹

A logo such as the ‘Jumpman’ is distinctive. But even when a term is not distinctive, as previously briefly explained, a common descriptive term or even a color could become distinctive, and therefore protectable by establishing

50. 15 U.S.C.A. § 1127 (West 2021).

51. *Id.*

52. Quynh La, *Bully No More: Why Trademark Owners Engage in Trademark Overreach and How to Prevent It*, 96 WASH. L. REV. 667, 672 (2021).

53. *Id.* at 673.

54. 15 U.S.C.A. § 1127 (West 2021).

55. *Id.*

56. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (defining distinctiveness and secondary meaning as applied to trademark law).

57. La, *supra* note 52, at 675.

58. ESPN DAILY, *supra* note 9, at 11:42.

59. *Id.* at 11:52.

60. *Id.* at 12:16.

61. *Id.* at 12:31.

secondary meaning.⁶² The burden of proving this is high and rests with the athlete.⁶³ Athletes are likely to meet this threshold because of how popular and widespread their marks are. Even if it is just within the sports community, many people consume this type of entertainment. Aspects that typically help show most athletes' trademarks have secondary meaning, if they are not already distinctive, is using circumstantial evidence such as the amount and types of advertising, amount of sales/revenue, and the length the mark is used.⁶⁴ Generally, any sports fan can see a blue turf field and knows it belongs to Boise State.⁶⁵ However, the color blue is not self-distinctive; it has developed that secondary meaning and is trademarked because of its notoriety.⁶⁶ This is one of many sports trademarks that now has secondary meaning.

The next important area of trademark law that is necessary for this comments analysis is how a trademark is protected. Trademarks are protected from infringement against:

any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, inaccurate or misleading description of fact, or false or misleading representation of fact, which . . . is *likely to cause confusion*, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.⁶⁷

The case law has helped define what "likely to cause confusion" means.⁶⁸ "The Lanham Act's 'likelihood of confusion' standard is predominantly factual in nature."⁶⁹ The test is "whether a reasonably prudent consumer in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks."⁷⁰

62. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171-72 (1995).

63. *See id.*

64. *See La, supra* note 52, at 690.

65. *Trademark Licensing and Enforcement-Blue Turf*, BOISE STATE U., <https://www.boisestate.edu/licensing/trademarks/blue-turf-blog/> (last visited Apr. 1, 2022).

66. *See, e.g., id.*

67. 15 U.S.C.A. § 1125 (West 2021) (emphasis added).

68. *Id.*

69. *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1024 (3rd Cir. 2008).

70. *Playmakers LLC v. ESPN, Inc.*, 376 F.3d 894, 897 (9th Cir. 2004).

Multiple examples in the sports industry are not “likely confusing” and show the broad scope of trademark availability within sports.⁷¹ The cases in this area tend to be the most famous and well-defined trademarks looking to protect themselves from infringers. This includes the circumstances of the IRONMAN⁷² or “March Madness”⁷³ trademarks. Marks can cause confusion when someone wants to register something that looks or sounds a little too similar to a well-established mark, or when someone is utilizing an athlete’s trademark for something the athlete did not approve of.

One example of this occurred when Nike opposed NFL player Rob Gronkowski’s spiking logo because it was too similar to the ‘Jumpman’ logo.⁷⁴ In situations such as this, the parties can work out an agreement amicably.⁷⁵ By amicably, it is meant that the powerhouse Nike and other widely known brands can squash other similar, potentially infringing, marks by threatening suit or paying money to athletes or lesser brands. These examples are where we start to see the power of a well-established athletic trademark.

II. THE FUTURE OF SPORTS TRADEMARKS

This comment has shown the trend of an increase in trademark applications and why that is occurring. Followed by legal protection provided to the acceptable marks. Athletes are looking to protect any piece of their brand, leading to opportunistic claims.⁷⁶ When analyzed, this trend with a knowledge of the law provides a foundation for what future trademark protection will look like. The following will explain and predict that given the current trends, athletes specifically will be able to trademark a wider scope of their brand and have a more full-proof power to protect their brand.

A. It’s “Unbelievably Believable”⁷⁷ What Will Be Protected

The trends in trademark law create questions about what will be protectable in the future. Trademark law has been liberally allowing athletes to register

71. *Mont. Pro. Sports, LLC v. Leisure Sports Mgmt., Inc.*, 422 F. Supp. 2d 1271, 1278-1282 (M.D. Fla. 2006).

72. *World Triathlon Corp. v. Dawn Syndicated Prods.*, 2007 WL 2875456, at 1 (M.D. Fla. Sept. 28, 2007).

73. *Ill. High Sch. Ass’n v. GTE Vantage Inc.*, 99 F.3d 244 (7th Cir. 1996).

74. Darren Rovell, *Nike Opposes Rob Gronkowski Logo, Says Too Similar to Jumpman*, ESPN (June 30, 2017), https://www.espn.com/nfl/story/_id/19775346/nike-says-logo-rob-gronkowski-too-similar-air-jordan-jumpman-logoman-logo.

75. *Id.*

76. ESPN DAILY, *supra* note 9, at 05:00.

77. UNBELIEVABLY BELIEVABLE, Serial No. 85521225 (filed Jan. 20, 2012).

unique slogans, logos, poses, and names to maintain exclusive rights.⁷⁸ Trademark law will likely continue to widen its scope. A trademark is “any word, name, symbol, or device, or any combination of those that is used in commerce to distinguish the good or service.”⁷⁹ But the language of the Lanham Act is not restrictive.⁸⁰ Trademark law has a wide subject matter that it covers.⁸¹ Most important to the inquiry is not the “ontological status” of the mark, for example, word, color, shape, etc. but the ability for the mark to distinguish the source.⁸²

Athlete trademarks are easily distinctive in most cases based on their conceptual strength, or more likely, based on commercial power.⁸³ Consumers in the marketplace can probably easily associate an athlete’s mark with the athlete it belongs to.⁸⁴ It then becomes clear that athletic type marks are very likely to be distinctive because of their commercial strength resulting from the significant brand recognition professional sports create.⁸⁵ Distinguishability being the most important and athletes marks being easily distinguishable, it is clear that the scope of trademark law will likely continue to widen. Potentially as far as allowing trademark protection for anything that can be detected by the human’s sense and distinguishes the source of a good or service.⁸⁶

A critical limit on this growth of what can be protected under trademark law is the functionality doctrine.⁸⁷ This bars protection for marks with a functional aspect.⁸⁸ Colors, body symbols, sounds, smells, and designs are all able to be protected.⁸⁹ There are questions regarding whether sports plays or celebratory dances will ever be trademarkable.⁹⁰ Because of the functionality doctrine,

78. Lee B. Burgunder, *Opportunistic Trademarking of Slogans: It’s No Clown Issue, Bro*, 31 CARDOZO ARTS & ENT. L.J. 769, 801 (2013).

79. 15 U.S.C.A. § 1127 (West 2021).

80. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

81. *Id.*

82. *Id.* at 164.

83. *See generally* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 1, 10 (2d Cir. 1976) (describing a trademark reaching distinctiveness through conceptual strength and commercial power).

84. *Id.*

85. *Id.*

86. J. THOMAS MCCARTHY, § 7:105. NONTRADITIONAL TRADEMARK FORMATS: POLICY ISSUES, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (5th ed. 2021).

87. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 164 (1995).

88. *Id.*; *see also* 15 U.S.C.A § 1052(e)(5) (West 2021).

89. Scott M. Sisun, *The Ball Is in Your Court: An Update on Trademarks (and Copyright) in Sports*, ENT. & SPORTS LAW. 64, 71 (2017).

90. Joshua A. Crawford, *Trademark Rights for Signature Touchdown Dances*, VA. ST. BAR 1, 9 (2014), https://www.vsb.org/docs/sections/intellect/Joshua_A_Crawford_-

sports plays will likely never have trademark protection.⁹¹ On the other hand, dances and celebration poses, the actual “performance” of them, could be protectable.⁹² These categories mentioned within this section cover nearly every area of an athlete’s brand they would need to protect. With the continued growth in applications for sports-related trademarks and the acceptance of trademark law, we see a continuously widening scope of trademark protectability.

B. “Stomp You Out.”⁹³ You, Meaning the Competition.

Lastly, this comment will analyze and show that trademark law surrounding athlete trademarks creates a veil of protection that is often unbeatable. This is a result of athletes’ ability to apply and the current trend to do so, the distinctiveness of athletes’ marks, athletes’ ability to sue, and new modern laws that allow further protection. These reasons are making athletes and their trademarks nearly untouchable.

Trademark law has a perpetual cycle, particularly with athletes. Athletes are highly publicized, so each move they make or word they speak is publicized and gives immense brand recognition. This brand recognition creates distinct and protectable trademarks. The protection of the brand means profitability for the athletes. The great potential for profits demonstrates to consumers and other athletes that there is value in these marks. Athletes then continue to take action to protect their unique brand. This then causes the growth of trademark applications that is happening and will continue to. The unique protectable trademarks, and, most importantly, licensable athlete brands bring more eyes in. It creates more publicity. The cycle starts over, and the growth in this area can be significant.

Athletes have an easy ability to apply and are tending to do so. With agents and lawyers receiving guidance to trademark everything possible to “safeguard future rights in a mark,” it gives these wealthy athletes continued priority to use a wide variety of marks.⁹⁴ The perpetuity of a trademark is long; it is as long as it is used in commerce.⁹⁵ With so many applications and trademarks being

Trademark_Rights_for_Signature_Touchdown_Dances.pdf; Giuliana R. García, *He Shoots, He Scores...and Receives Copyright Protection? How the Current State of Intellectual Property Law Fumbles with Sports*, 11 U. OF DENV. SPORTS & ENT. L.J. 81, 83 (2011).

91. García, *supra* note 90, at 83-84.

92. *Id.* at 86.

93. STOMP YOU OUT, Serial No. 85606531 (filed Apr. 24, 2012).

94. Donna M.D. Thomas, *Proactive Steps to Protect Your Client’s Copyrights and Trademarks*, MD. B.J. 54, 56 (2003).

95. Daniel R. Kimbell, *Intellectual Property: An Attorney’s Guide*, 27 BEVERLY HILLS B. ASS’N J. 109, 112 (1993).

registered, particularly for less unique names and slogans, this blocks others' right to protection for a lifetime or more.⁹⁶ When the athletes and their teams have available legal staff and funding to complete trademark applications, they have nothing to lose by applying for protection.⁹⁷ Trademarking a phrase, name, logo, etc., keeps others from profiting off an athlete's reputation and instead gives the athlete both profit and protection.⁹⁸

Of course, athletes do not automatically get all their trademark applications accepted. But arguably, it is a lot easier for them given the requirements necessary.⁹⁹ As previously mentioned, athlete trademarks are generally easily found to be distinctive.¹⁰⁰ So, athletes are applying for complete protection of their brand and then likely getting that protection for as long as they want (as long as the mark is used in commerce). Even if the applied for mark is only descriptive, as some can be, they are so widespread.¹⁰¹ Athletes receive so much media attention that their marks take on a secondary meaning far easier than other trademarks.¹⁰² This commercial success and brand recognition creates powerful protection for trademarks by athletes.¹⁰³

Having an attorney, which is not required when applying, is an asset. The attorney can communicate with the examining trademark attorney on the athletes' behalf. For example, trademark attorney Darren Heitner convinced the examining attorney of his trademark application that Bill Raftery, broadcaster and former Seton Hall basketball coach, catchphrase "onions" has no likelihood of confusion with The Onion, a satirical website.¹⁰⁴ Even in situations such as this, where it is a descriptive word, attorneys' who can argue and make these distinctions are a powerful asset for those in the sports industry. This ease in getting trademark applications accepted based on distinctiveness was explained previously but is important to this analysis as it is another addition to creating a full-proof protected trademark.

96. *Id.*

97. *Sport Trademarks*, *supra* note 12.

98. *Id.*

99. *See* 15 U.S.C.A. § 1127 (West 2021).

100. *See generally* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2d Cir. 1976) (defining how trademarks are deemed distinctive).

101. Jeanna Hamburg & Joseph A. Farco, *Common Issues in Patent and Trademark Litigation*, NAT'L. L. REV. (Feb. 12, 2021), <https://www.natlawreview.com/article/common-issues-patent-and-trademark-litigation>.

102. *See generally* *Abercrombie & Fitch Co.*, 537 F.2d at 10 (noting that a trademark distinctiveness through conceptual strength and commercial power).

103. *See* Hamburg & Farco, *supra* note 101.

104. McCann, *supra* note 47.

Taking the ability to apply, mixed with the ability to get most of their trademarks accepted, athletes have a relatively easy way to protect their brand. On top of that, athletes, for a number of reasons, have the ability to sue or settle with any infringers. This includes having the financial capability and legal team to follow through on trademark claims, extra protections specifically for famous marks, and the recent developments modernizing trademark law aid their ability to sue as well.

Athletes tend to have agents or a team of attorneys they can pay to take care of this process for them. This only furthers the power of athletes' trademarks. Giannis Antetokounmpo, in just the past two years, has filed over fifty lawsuits against trademark infringers.¹⁰⁵ Giannis has the money to pay professionals to protect his brand in a way that many businesses and individuals cannot. It would be a disservice if this comment did not highlight a king in building a brand that lasts long after they are done playing, that is Shaquille O'Neal. "Shaq" and his company have many registered trademarks connected to his name, and they take action to continuously protect them from infringers.¹⁰⁶

On top of being able to pursue legal action by suing, athletes, given their power, are able to "bully" those using an athlete's marks, or name, image, and likeness into stopping without filing an actual lawsuit.¹⁰⁷ It seems obvious that a small online retailer might not want to play one-on-one with the MVP Giannis. Often, these infringers do not have the same financial strength or legal team backing them up, meaning when a cease-and-desist letter is sent, or a settlement is offered, they comply. This strength in and out of the courtroom is powerful for athletes' trademark protection.

Switching gears to another prominent area of protection for these unique, highly publicized, and therefore famous marks is the Trademark Dilution Revision Act of 2006.¹⁰⁸ This applies only to famous marks.¹⁰⁹ Which, in most cases, athletes' marks are. This creates an extra layer and a more protective shield around these already prominent trademarks that others do not receive. Dilution is not trademark infringement. It can happen even in situations where

105. Christopher Kinney, *A Force on the Basketball Court and in the Courtroom: A Deeper Look into Giannis Antetokounmpo's Recent String of Intellectual Property Disputes*, J. HIGH TECH. L. (Nov. 30, 2021), <https://sites.suffolk.edu/jhtl/2021/11/30/a-force-on-the-basketball-court-and-in-the-courtroom-a-deeper-look-into-giannis-antetokounmpo-recent-string-of-intellectual-property-disputes/>.

106. Muller, *supra* note 14.

107. La, *supra* note 52, at 672-73.

108. Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat 1730 (codified in various sections of Title 15).

109. *Id.*

consumers are not misled.¹¹⁰ If it would even get that far, a court would look at all the relevant factors to determine if a famous mark (athletes' marks fall under this standard) is diluted.¹¹¹ These include:

(1) the degree of similarity; (2) the degree of inherent or acquired distinctiveness of the famous mark; (3) the extent to which the owner of the famous mark is engaging in the substantially exclusive use of the mark; (4) the degree of recognition of the famous mark; (5) whether the user of the mark or trade name intended to create an association with the famous mark; and (6) any actual association between the mark or trade name and the famous mark.¹¹²

These standards are likely to be met, particularly with the help of an attorney, which adds a strong protection layer and seemingly expands the goal of trademarks past simply consumer protection and economic efficiency, to a broader protection for those with famous marks.¹¹³

Now this added protection is rational. Famous marks of athletes will face at a higher rate what is called "cybersquatting."¹¹⁴ This is when a third party is opportunistic and either files for trademark protection, takes a URL, etc., that is related to the athlete, and uses it to tarnish or cloud their reputation.¹¹⁵ In the age of social media, everyone has the ability to say what they want online with few restrictions. As a result, many people are able to use an athlete's trademark and name, image, and likeness in a way that the athlete disapproves of.¹¹⁶ Because of this modern issue, it is rational that athletes can benefit from an additional protective layer based on having a famous mark, which prevents this issue and further strengthens the protective "shield" athletes have.

The last area that adds to the near full-proof protection created for athletes' trademarks is the modernization of trademark law. Given the changes in the world, moving even more virtual than ever in the past few years, trademark law has needed to adapt. The United States Patent and Trademark Office has

110. Richard Stim, *What is Trademark Dilution?*, NOLO, <https://www.nolo.com/legal-encyclopedia/what-trademark-dilution.html> (last visited Apr. 1, 2022).

111. *Id.*

112. *Id.*

113. Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 828 (1927).

114. Barret R. Arthur, Comment, *Always Protect Your Brand: Trademark Infringement Protection for Athletes Using Social Media Sites*, 10 DEPAUL J. SPORTS L. & CONTEMP. PROBS. 83 (2014).

115. *Id.*

116. Muller, *supra* note 14.

recently done so. The Trademark Modernization Act has recently come into effect and will continue to instill changes this year.¹¹⁷ Given that this new trend makes the trademark process more efficient and creates clearer ways to protect trademarks, it is important to note here.¹¹⁸ Athletes, as we know, have a generally easier time than most protecting their brands. The modernization of trademark law helps others outside of sports and big businesses, but it does not exclude the already powerful from the benefits of this act.¹¹⁹

Ultimately, trademark law aims to protect others from confusing the source of goods and services and protects the trademark owner from misappropriation of their mark.¹²⁰ This comment has provided insight showing that the protection is wide in scope and extensive in power for athletes.

CONCLUSION

This comment explained the brief history of sports trademarks, the trend that they are rapidly increasing in popularity, and why. In addition, it was necessary to have an understanding of the basics of what is necessary for a valid trademark. In laying this foundation, this comment was then able to analyze the cyclical growth in trademark law and protection that will continue for years to come. This includes the widening scope of what will be protectable for athletes and the ease with which they are able to do so. Additionally, and most importantly, the growth has and will continue to provide nearly full-proof protection to athletes' already powerful and wealthy brands through the use of trademarks. The "Three-Peat"¹²¹ of trademark law, athletes, and money is proving to be changing the goals and outcomes of trademark protection in the sports industry.

117. Changes to Implement Provisions of the Trademark Modernization Act of 2020, FED. REG. (Nov. 17, 2021), <https://www.federalregister.gov/documents/2021/11/17/2021-24926/changes-to-implement-provisions-of-the-trademark-modernization-act-of-2020>.

118. *USPTO Implements the Trademark Modernization Act*, USPTO, <https://www.uspto.gov/trademarks/laws/2020-modernization-act> (last visited Apr. 1, 2022).

119. *Changes to Implement Provisions of the Trademark Modernization Act of 2020*, *supra* note 117.

120. *See* Fourth Toro Fam. Ltd. P'ship v. PV Bakery, Inc., 88 F.Supp.2d 188, 195 (S.D.N.Y. 2000).

121. THREE-PEAT, Registration No. 1,552,980.