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COMMENTS

WII NEED CLARITY: A PROPOSED FEDERAL AMENDMENT TO TRADEMARK CONFUSION TESTS THROUGH THE LENS OF ESPORTS AND ELECTRONIC WORD MARKS

PATRICK K. DOLL*

I. INTRODUCTION

As the landscape of eSports and video games has rapidly changed over the past fifty years, can it be said that trademark laws from the 1940s¹ have evolved sufficiently to protect intellectual property trademark word rights of professional eSports players and streamers into the 2020s and beyond? eSports are a relatively new form of sport and entertainment that has exploded in popularity recently.² For the uninitiated, eSports are defined as “play[ing] [video

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¹ 15 U.S.C.A. § 1051 (West 2024).

² See Werner Geyser, *The Incredible Growth of eSports [+ eSports Statistics]*, INFLUENCER MKTG. HUB, <https://influencermarketinghub.com/esports-stats/> (Oct. 18, 2023).

games] in a[n] . . . organized[,] competitive environment.”³ eSports games vary widely; from real-time strategy games to first-person shooter games, eSports, like traditional sports, have a variety of flavors that appeal to different fans.⁴

eSports professionals also take different forms. From streamers that broadcast their gameplay through the internet on platforms like Twitch⁵ to professional teams that attend multi-million-dollar tournaments and events,⁶ the industry varies in its deliverance of content. The popularity of eSports is not slowing down anytime soon either, with viewership numbers projected to increase moving forward into the decade.⁷ As seen with professional athletes in traditional sports, such as soccer or basketball, video gaming celebrities in their respective eSport also arise.⁸ This fame often procures notoriety, leading some eSports professionals to utilize trademark laws to protect their intellectual property rights.⁹

First, this comment discusses how traditional video games have evolved from the 1970s to today’s entertainment behemoths. The non-legal history of the industry will lay the foundations for understanding the present issue within eSports. Next, a legal background of American trademark law for word marks will be examined. This portion of the comment will examine how trademarks are defined, how a prospective mark holder can acquire trademark protection, what words are protectable, and how a trademark, once acquired, can be infringed upon. Furthermore, this section will discuss how trademark confusion is determined and why the current district-by-district approach is inadequate for electronic marks. Finally, a streamlined proposal for a federal solution to

³ Marc Leroux-Parra, *Esports Part 1: What are Esports?*, HARVARD INT’L REV. (Apr. 24, 2020, 6:28 PM), <https://hir.harvard.edu/esports-part-1-what-are-esports/>.

⁴ *Different Types of Esports*, MARYVILLE UNIV. (Apr. 5, 2022), <https://online.maryville.edu/blog/different-types-of-esports/>.

⁵ *About*, TWITCH, <https://www.twitch.tv/p/en/about/> (last visited Oct. 31, 2023) (stating “Twitch is where millions of people come together live every day to chat, interact, and make their own entertainment together”); As of August 2023, Twitch has 140 million unique visits each month, with thirty-one million daily active users. Daniel Ruby, *Twitch Statistics 2023 – (Users, Revenue & Insights)*, DEMAND SAGE (Aug. 2, 2023), <https://www.demandsage.com/twitch-users/>.

⁶ See Roxette Rubio, *The 10 eSports Tournaments With The Biggest Prize Pools, Ranked*, CBR (Nov. 7, 2022), <https://www.cbr.com/esports-tournaments-with-the-biggest-prize-pools-ranked/#7-742-070---honor-of-kings-world-champion-cup-2021>.

⁷ Christina Gough, *eSports Audience Size Worldwide From 2020 to 2025, By Type of Viewers*, STATISTA (Oct. 16, 2023), <https://www.statista.com/statistics/490480/global-esports-audience-size-viewer-type/>.

⁸ Several famous eSports players have Instagram follower counts that exceed 100,000, with some having over 1,000,000 followers. *The Most-Followed Esports Players on Instagram*, ONLINESLOTS, <https://www.onlineslots.com/esports-social-media-stars/> (last visited Oct. 31, 2023).

⁹ See Calvin R. Nelson & William C. Lawrence, *IP and Advertising Considerations for Esports*, VENABLE LLP (Oct. 25, 2021), <https://www.venable.com/insights/publications/2021/10/ip-and-advertising-considerations-for-esports>.

trademark confusion will be discussed, which considers the precedent history and how it applies to eSports professionals and streamers. This solution considers the unique nature of the eSports industry and why its adoption is required to protect word mark aliases from trademark confusion in the realm of eSports. Because current trademark confusion laws are inadequate to deal with the realities of the 21st century, a uniform, federal standard for electronic marks must be amended to the Lanham Act to protect and clarify word mark holders.

II. BODY

A. Background on the Non-legal History of eSports and Video Games

eSports today are the result of natural advancement in a constantly evolving enterprise. To understand where this industry is today, one must understand where it has come from. The first home video game console, the Magnavox Odyssey, graced store shelves in 1972.¹⁰ Later that year, and perhaps more identifiable, Atari's *Pong* was released to the public,¹¹ helping further popularize the video game industry. *Pong* was essentially electronic ping pong; two paddles would connect to the console, one player would control either paddle, a virtual, pixelated ball would go back and forth,¹² and the objective was to get the ball past the opponent's paddle. While *Pong* originally was a coin-operated arcade attraction,¹³ its popularity spurred a home release in 1975,¹⁴ furthering the accessibility of the new technology and introducing a countless number of people to the video game craze.

As the industry started to develop, American companies took notice. Eager to join the latest fad in entertainment, these companies developed their own video game consoles and released them to the market. Arguably the most popular system of the late 1970s and early 1980s, the *Atari 2600*, sold as many as thirty million units over three decades.¹⁵ As crucial as the consoles were in introducing consumers to the new technology, their success depended on the quality of games available for consumers to play on the systems. Without

¹⁰ *The 8 Generations of Video Game Consoles*, BBC, <https://www.bbc.co.uk/archive/the-8-generations-of-video-game-consoles/zvcjkty> (last visited Oct. 31, 2023).

¹¹ *Pong Electronic Game*, ENCYC. BRITANNICA, <https://www.britannica.com/topic/Pong> (Sep. 12, 2023).

¹² *Id.*

¹³ Chris Kohler, *How Pong and the Odyssey Console Launched the Videogame Era*, WIRED (Jan. 9, 2015, 6:30 AM), <https://www.wired.com/2015/01/ralph-baer-al-alcorn-pioneer-award-dice/>.

¹⁴ Angela Modany, *Pong, Atari, and the Origins of the Home Video Game*, NAT'L MUSEUM OF AM. HIST. (Apr. 17, 2012), <https://americanhistory.si.edu/blog/2012/04/pong-atari-and-the-origins-of-the-home-video-game.html>.

¹⁵ *Atari Console*, ENCYC. BRITANNICA, <https://www.britannica.com/technology/Atari-console> (Aug. 11, 2023).

quality games, video game consoles cannot succeed. This reality is, in large part, why the video game crash of 1983 occurred, discussed below.

While *Pac-Man* was technically a success for Atari, with around eight million units sold,¹⁶ it is widely considered one of the reasons that eventually eroded trust in the company.¹⁷ The game was considered the “worst coin-op conversion of all time,”¹⁸ intended to port the arcade experience to home television sets. However, with flickering ghost effects, the limited hardware capability of the *Atari 2600* to fully capture the arcade version’s gameplay, and an unimpressive color scheme, criticism of the game helped contribute to an overall lack of interest in the system.¹⁹

Other than lousy arcade ports, the games of this time also created controversy with their stories. One game, *Custer’s Revenge*, saw the players take the role of George Custer, a famous American cavalry general.²⁰ The game’s goal was to avoid arrows fired at the player and reach the end of the screen.²¹ If “successful,” the player would arrive at a Native American woman at the end of the screen, tied to a cactus, and then proceed to rape the woman.²² Criticism for the game was strong, with numerous women’s rights groups, Native American spokespersons, and legislators declaring the game distasteful.²³ Los Angeles County ended up banning the game and other X-rated video games in its jurisdiction by a three-to-one vote.²⁴ The prevailing opinion nowadays is that *Custer’s Revenge* is one of the most racist video games of all time.²⁵

¹⁶ David Mikkelson, *Buried Atari Cartridges*, SNOPEs (Mar. 25, 2001), <https://www.snopes.com/fact-check/five-million-et-pieces/>.

¹⁷ An example of Atari’s confidence is in the fact it produced over twelve million *Pac-Man* cartridges, while only ten million consoles were owned and used. In other words, Atari had a surplus of two million *Pac-Man* cartridges it could not sell. *See Id.*

¹⁸ Staff, *What the Hell Happened?*, NEXT GENERATION MAG., Apr. 1998, at 41.

¹⁹ Mikkelson, *supra* note 16.

²⁰ *Custer’s Revenge – Mystique – Atari 2600*, ATARIAGE, https://atariage.com/manual_html_page.php?SoftwareLabelID=119 (last visited Oct. 31, 2023); *George Armstrong Custer*, ENCYC. BRITANNICA, <https://www.britannica.com/biography/George-Armstrong-Custer> (Aug. 9, 2023).

²¹ *Custer’s Revenge – Mystique – Atari 2600*, *supra* note 20.

²² *See* John Rather, *Video Games Pose Thorny Legal Issue*, N.Y. TIMES (Jan. 23, 1983), <https://www.nytimes.com/1983/01/23/nyregion/video-games-pose-thorny-legal-issue.html>.

²³ *Id.*; Associated Press, *L.A. Supervisors Vote to Ban Video Sex Games*, TIMES-STANDARD (Nov. 17, 1982), <https://archive.org/details/1982-11-15-people/1982-11-17-TimesStandardEurekaCalifornia-AssociatedPress/mode/1up>.

²⁴ Associated Press, *supra* note 23.

²⁵ *See* K. Thor Jensen, *The 11 Most Racist Video Games*, UGO (Nov. 30, 2010), <https://www.ugo.com/games/the-11-most-racist-video-games.html>.

These games, lacking in quality and coupled with the aforementioned controversies, all contributed to the video game market crashing in 1983.²⁶ Another primary reason for the crash was the oversaturation of the market.²⁷ Companies that had seen the initial success of the *Atari 2600* were eager to join the market with their competing video game systems and games.²⁸ Consoles like the *Atari 2600* were popular, but other systems like the *Astrocade*, *Intellivision*, and more flooded the market, creating ideal conditions for market saturation.²⁹ As these systems overpopulated the market and the quality of the games decreased, consumer confidence in video games also decreased.³⁰ In fact, from 1982 to 1985, video game sales dropped from \$3.2 billion in the United States to just over \$100 million in 1985, a ninety-seven percent decrease.³¹ Thousands of jobs were lost, and subsidiaries of Atari reported losses of \$180 million in just the third quarter alone in 1983.³² Unlike the American console market today, where consumers have the choice of an Xbox, PlayStation, or Nintendo console,³³ consumers had too many options back then. Personal computers also became more popular during this time; as these devices could play games and take on more productive tasks, consumers did not have as much incentive to purchase video game consoles.³⁴ Taken as a whole, these factors all contributed to creating an imperfect storm for video games, ultimately dooming the industry at this time.

²⁶ Coleman Gailloro, *The Great Video Game Crash of 1983: What Caused the Console-Pocalypse?*, SCREENRANT (Mar. 8, 2020), <https://screenrant.com/video-game-market-crash-1980s-why-how-details/>.

²⁷ Lawrence “Malystryx” Phillips, *The History of Esports*, HOTSPAWN (Apr. 1, 2020, 4:01 PM), <https://www.hotspawn.com/other/guides/the-history-of-esports>.

²⁸ See generally N.R. Kleinfeld, *Video Game Industry Comes Down to Earth*, N.Y. TIMES (Oct. 17, 1983), <https://www.nytimes.com/1983/10/17/business/video-games-industry-comes-down-to-earth.html>; see also Kate Tremaine, *10 Factors That Caused The Video Game Crash of 1983*, CBR (June 29, 2022), <https://www.cbr.com/causes-of-video-game-crash-1983/>.

²⁹ Gailloro, *supra* note 26; see also PocketEpiphany, *15 Real Reasons the Video Game Market Crashed in the 1980s*, EBAUM’S WORLD (Dec. 7, 2020), <https://gaming.ebaumsworld.com/pictures/15-real-reasons-the-video-game-market-crashed-in-the-1980s/86482866/>.

³⁰ Helen A. Lee, *The Truth About the Video Game Crash of 1983*, SVG (Jan. 23, 2023, 12:40 PM), <https://www.svg.com/291826/the-truth-about-the-video-game-crash-of-1983>.

³¹ David Beren, *What Was the Video Game Crash of 1983 and Why Did It Happen?*, HIST.-COMPUT., <https://history-computer.com/what-was-the-video-game-crash-of-1983-and-why-did-it-happen/> (July 30, 2023).

³² Kleinfeld, *supra* note 28.

³³ This does not account for gamers that play on PC or mobile devices; rather, the article focuses only on the console market. The console market gives prospective gamers the choice of the three consoles (Xbox, PlayStation, Switch). See Derek Strickland, *Big 3 market share: PlayStation, Xbox, and Nintendo slightly fluctuate in 2022*, TWEAKTOWN, <https://www.tweaktown.com/news/90321/big-3-market-share-playstation-xbox-and-nintendo-slightly-fluctuate-in-2022/index.html> (Mar. 7, 2023, 7:31 PM).

³⁴ Beren, *supra* note 31; see also PocketEpiphany, *supra* note 29.

Following the 1980s video game crash and several years of indifference to the industry, two Japanese companies saw an opportunity. First, the Japanese company Nintendo released the *Nintendo Entertainment System* (“NES”) in 1986 to the American market.³⁵ The NES was a success, as sales surpassed sixty million units.³⁶ With quality games released alongside the console, such as *Duck Hunt*, *Super Mario Bros.*, and *The Legend of Zelda*, the system was a smash hit.³⁷ Three years later, in 1989, another Japanese company, Sega, released the *Genesis* console.³⁸ With Sega selling over thirty-million *Genesis* units,³⁹ competition between Sega and Nintendo spurred during the 1990s.⁴⁰ Competition between the systems increased the popularity of the consoles and availability to the consuming public, helping enhance the industry as a whole.⁴¹

With competition came innovation. Nintendo’s NES, available to consumers for three years before the *Genesis*’ release, was designed with an 8-bit CPU.⁴² 8-bit CPUs limited the graphical power and compute times of the NES and other computers of the time, offering low resolutions and simplistic sounds.⁴³ 8-bit processors have a maximum addressable memory allocation of

³⁵ *Nintendo console video game console*, ENCYC. BRITANNICA, <https://www.britannica.com/technology/Nintendo-console> (Aug. 21, 2023).

³⁶ *Id.*

³⁷ Josh West, *The 10 Best NES Games of All Time*, GAMESRADAR+ (June 19, 2022), <https://www.gamesradar.com/best-nes-games-all-time/>.

³⁸ D.S. Cohen, *History of the Sega Genesis – Dawn of the 16-bit Era*, LIFEWIRE (Sept. 19, 2020), <https://www.lifewire.com/history-of-sega-genesis-dawn-729670>.

³⁹ Emmanuel Ocbazghi, *The rise and fall of Sega*, BUS. INSIDER (Jan. 21, 2021, 1:30 PM), <https://www.businessinsider.com/sega-nintendo-rise-fall-90s-genesis-dreamcast-sonic-console-2020-1>.

⁴⁰ Sega ran numerous advertising campaigns against Nintendo during the early 1990’s period. *See* Alethia, *Genesis does what Nintendo’n’t!*, YOUTUBE (May 30, 2006), <https://www.youtube.com/watch?v=k7nsBoqJ6s8>. Nintendo also ran ads depicting its competitors in a negative light; *see* Rafi Letzer, *Nintendo once made a six-minute ad depicting Sega and Sony kidnapers torturing Mario*, BUS. INSIDER (July 28, 2015, 4:10 PM), <https://www.businessinsider.com/nintendo-once-made-a-six-minute-ad-depicting-sega-and-sony-kidnapers-torturing-mario-2015-7>; *see also* Matthew Walden, *Sega vs. Nintendo: A History of the Epic Video Game Rivalry*, GAME SPOT (May 29, 2015, 4:00 PM), <https://www.gamespot.com/gallery/sega-vs-nintendo-a-history-of-the-epic-video-game-/2900-165/>.

⁴¹ *See* Kotaku UK, *How Sonic Helped Sega Win the Early 90s Console Wars*, KOTAKU (Oct. 31, 2014), <https://kotaku.com/how-sonic-helped-sega-win-the-early-90s-console-wars-1653185046#:~:text=In%20the%20early%201990s%2C%20Sega,%2C%20with%2065%25%20market%20share;see%20also%20Leo%20Kelion,%20Sega%20v%20Nintendo%20Sonic,%20Mario%20and%20the%201990%27s%20console%20war.> BBC (May 13, 2014), <https://www.bbc.com/news/technology-27373587>; *see also* Ben Wilson, *Arcade History: Nintendo and Sega’s Early Console War*, HISTORYHIT (July 5, 2021), <https://www.historyhit.com/gaming/arcade-history-nintendo-sega-console-war/>.

⁴² Margaret Rous, *What Does 8-Bit Mean?*, TECHOPEDIA, <https://www.techopedia.com/definition/17358/8-bit> (Dec. 27, 2016).

⁴³ *Id.*

sixty-five kilobytes.⁴⁴ The *Genesis*, meanwhile, was a 16-bit CPU⁴⁵ with a maximum addressable memory allocation of one megabyte.⁴⁶ In other words, the Sega *Genesis*' CPU had around fifteen times more allocatable memory than the *NES*,⁴⁷ meaning the *Genesis* could offer better graphics, sounds, and resolutions than its *NES* counterpart.⁴⁸ The *Genesis*, released in 1988, took advantage of its 16-bit processor and superior graphical power to compete against Nintendo's market stranglehold.⁴⁹ Not to be undone, in 1991, Nintendo released its 16-bit competitor to the *Genesis*, the *Super Nintendo Entertainment System* ("SNES").⁵⁰ The competition between Sega and Nintendo officially became known as the "Console Wars," which helped lay the foundation of the gaming industry we see today.⁵¹ In today's console gaming industry, similar competition exists between Microsoft's *Xbox*, Sony's *PlayStation*, and Nintendo's *Switch* consoles.⁵²

Akin to how console manufacturers compete against each other, the desire to determine the world's best video gamer players naturally arose. As early as the 1970s, video game competitions began appearing throughout the United States. The first recorded video game competition, hosted at Stanford

⁴⁴ *Definition of 16-bit Computing*, PC MAG., <https://www.pcmag.com/encyclopedia/term/16-bit-computing> (last visited Nov. 3, 2023).

⁴⁵ Jeremy Parish, *Sega Genesis 25th Anniversary: The Rise and Fall of an All-Time Great*, VG 247, <https://www.vg247.com/sega-genesis-25th-anniversary-the-rise-and-fall-of-an-all-time-great> (Aug. 14, 2014).

⁴⁶ *Definition of 16-bit Computing*, *supra* note 44.

⁴⁷ There are 1000 kilobytes in one megabyte. *CS 101: Kilobytes Megabytes Gigabytes Terabytes*, STANFORD.EDU, <https://web.stanford.edu/class/cs101/bits-gigabytes.html> (last visited Nov. 3, 2023). This means that the 16-bit, one megabyte processor has the equivalent of 1000 kilobytes of allocatable memory. To calculate the allocatable memory disparity between 8-bit CPUs and 16-bit CPUs, an algebraic equation can be used to solve for the difference in computing power: $65x = 1000$, where x represents the difference between 8-bit CPUs and 16-bit CPUs. Applying rudimentary algebra in solving for x , $x \approx 15.385$. This figure indicates the difference in allocatable memory between an 8-bit CPU and a 16-bit CPU.

⁴⁸ Another example illustrating the power differential between an 8-bit and 16-bit CPU is in the color gamut each processor can display; while an 8-bit processor can display just over sixteen million colors, a 16-bit processor can display over 280 trillion colors. Justin Heyes, *8-Bit vs 16-bit Images*, SLR LOUNGE, <https://www.slrlounge.com/8-bit-vs-16-bit-images-a-visual-demonstration/> (last visited Nov. 3, 2023).

⁴⁹ *See Sega Corporation*, ENCYC. BRITANNICA, <https://www.britannica.com/topic/Sega-Corporation> (Sept. 30, 2023).

⁵⁰ Plato, *Nintendo's SNES turns 30 years old, fans celebrate the classic system*, ZEPHYRNET (Aug. 23, 2021, 8:32 PM), <https://zephyrnet.com/nintendos-snes-turns-30-years-old-fans-celebrate-the-classic-system/>.

⁵¹ Kelion, *supra* note 41.

⁵² *See generally* Emma Basaran, *Strategy showdown in gaming: Nintendo vs. Sony vs. Microsoft*, DAILY SABAH (Mar. 29, 2021, 2:50 PM), <https://www.dailysabah.com/life/strategy-showdown-in-gaming-nintendo-vs-sony-vs-microsoft/news>; *see also* Eduardo, *Microsoft compares Xbox console sales to PlayStation and Nintendo Switch sales*, FRAGSTER (Dec. 31, 2022), <https://www.fragster.com/microsoft-compares-xbox-console-sales-to-playstation-and-nintendo-switch-sales/>.

University, occurred in 1972.⁵³ The game, *Spacewar!*, allowed twenty-four competitors an opportunity to win a *Rolling Stones* magazine subscription for a year.⁵⁴ Eight years later, the first organized video game competition involved the classic arcade game *Space Invaders*; 10,000 participants competed in numerous regional events across the country, with the regional winners receiving an all-expense paid trip to New York to determine who amongst them was the best *Space Invaders* player.⁵⁵ The winner of this tournament, Rebecca Heineman, is recognized as one of the most notorious figures in eSports history, with her contributions helping create the environment for gamer celebrities of today to thrive.⁵⁶ Other gaming competitions took place afterward,⁵⁷ with the winners gaining even more notoriety. In the 1990s, for example, Dennis Fong, known by his online alias “Thresh,” was called the “Michael Jordan” of video games, winning numerous competitions throughout the decade in games like *Doom* and *Quake*.⁵⁸

Today, numerous eSports players and video game streamers have recognizable aliases. For example, streamers like Ninja, shroud, or xQc are as identifiable in eSports communities as traditional sporting figures like Michael Jordan, Tom Brady, or Cristiano Ronaldo are in their respective sports.⁵⁹

⁵³ Florian Larch, *History of eSports: How It All Began*, ISPO (Feb. 8, 2023), <https://www.ispo.com/en/markets/history-esports-how-it-all-began>.

⁵⁴ *Id.*

⁵⁵ Niko Stratis, *The Secret Trans History of Gaming, According to Rebecca Heineman*, XTRA MAG. (Oct. 29, 2020, 11:29 AM), <https://xtramagazine.com/culture/rebecca-heineman-gaming-trans-high-score-183508>; see generally *High Score: Boom & Bust* (Netflix Aug. 19, 2020).

⁵⁶ See generally *Rebecca Heineman*, ATARIWOMEN, <https://www.atariwomen.org/stories/rebecca-heineman/> (last visited Nov. 3, 2023) (stating Rebecca Heineman developed 275 games in a thirty-nine year career); see also Brian C. Bell, *40 years on, videogames icon Rebecca Heineman found herself beyond her 'escape'*, OUTSPORTS (Nov. 12, 2020, 7:00 AM), <https://www.outsports.com/2020/11/12/21561349/rebecca-heineman-atari-space-invaders-transgender-1980-champion-interplay-olde-skuul-bards-tale> (stating Rebecca Heineman was the first of its kind Atari national video game champion).

⁵⁷ During the 1990's, Nintendo held numerous gaming competitions across the United States. One of these events was the Nintendo Campus Challenge in 1992, where numerous colleges and universities took part in hosting the event. See Frank Cifaldi, *The Story of the First Nintendo World Championships*, IGN, <https://www.ign.com/articles/2015/05/13/the-story-of-the-first-nintendo-world-championships> (July 14, 2016, 3:58 PM); see also sibeteosyn, *Nintendo Campus Challenge*, NES WARP ZONE (Jan. 4, 2010, 8:40 PM), <https://www.neswarpzone.com/nintendo-campus-challenge/>; see also theshrimp and Evan G, *Nintendo Campus Challenge*, SNES CENTRAL, <https://snescentral.com/article.php?id=0790> (July 17, 2019). First-person shooter tournaments in the 1990's helped pave the way for the popularity of first-person shooters of today such as Call of Duty, Overwatch, and Halo. See *About Esports: History*, S. ILL. UNIV. EDWARDSVILLE, <https://www.siue.edu/esports/about/history.shtml> (last visited Nov. 3, 2023).

⁵⁸ Mark Leibovich, *King of the Gamers*, WASH. POST (Dec. 23, 1999), <https://www.washingtonpost.com/wp-srv/WPcap/1999-12/23/093r-122399-idx.html>.

⁵⁹ The mentioned streamers have amassed over eleven million followers on Twitch. *Top 100 Most Followed Twitch Accounts (Sorted by Followers Count)*, SOCIAL BLADE, <https://socialblade.com/twitch/top/100> (last

Arguably, these gamer aliases today are more recognizable than the games from which these streamers gained notoriety. Given the fame these players procure, it is imperative that their respective intellectual property rights are adequately protected and, even more fundamentally, can be protected.

B. Overview of Trademark Law in the United States

At the most basic level, American trademarks are codified and protected in the Lanham Act of 1946. It defines trademarks as “any word, name, symbol, or device . . . (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 . . . to identify . . . his or her goods[.]”⁶⁰ To have a protectable word trademark, the mark must be distinctive; this means the word has a certain level of conceptual and commercial strength, with consumers able to associate a mark with a particular product or service.⁶¹ In clarifying a word’s conceptual strength, courts use the *Abercrombie* spectrum to assign one of four levels to a mark; from weakest to strongest, the levels are (1) generic, (2) descriptive, (3) suggestive, and (4) fanciful and arbitrary.⁶²

Generic terms are not afforded trademark protection “because they do not identify the source of a product.”⁶³ A term is generic “if the relevant public primarily understands a mark as describing ‘what’ the particular good or service is”⁶⁴

Descriptive terms are not inherently distinctive and thus not protectable on their own, but if the term can acquire secondary meaning, it can serve as a mark.⁶⁵ To acquire secondary meaning, courts look for either direct evidence through consumer surveys or circumstantial evidence such as advertising, the

visited Nov. 3, 2023). Competition is so fierce for eSports talent and personalities that Twitch’s competing platforms, like Kick, are offering multi-million-dollar exclusive streaming deals. Kellen Browning, *Twitch Star Signs \$100 Million Deal with Rival Platform*, N.Y. TIMES, <https://www.nytimes.com/2023/06/16/business/twitch-kick-xqc.html> (June 21, 2023) (stating xQc recently signed a two-year, roughly seventy-million-dollar deal, with incentives reaching one-hundred million).

⁶⁰ 15 U.S.C. § 1127.

⁶¹ See Connely Doizé, *Destruction, the Rebirth of Art: Analyzing the Right of Integrity’s Role in Modern Art*, 29 J. INTEL. PROP. L. 139, 150–51 (2021).

⁶² *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

⁶³ *Elliott v. Google Inc.*, 860 F.3d 1151, 1155 (9th Cir. 2017).

⁶⁴ *Id.* at 1156.

⁶⁵ 15 U.S.C. § 1052(f).

volume of sales, and the term's length and manner of use.⁶⁶ If secondary meaning is established, a descriptive term can be protected.⁶⁷

A suggestive term "requires imagination, thought, and perception to reach a conclusion as to the nature of goods."⁶⁸ Suggestive terms are inherently distinctive and do not require a showing of secondary meaning.⁶⁹ Courts will look to four factors in determining whether a term is suggestive or descriptive: (1) the dictionary definition of the term; (2) the imagination test, where if it requires imagination to ascertain the nature of the goods, it is suggestive; (3) competitor's need in determining whether competitors would be disadvantaged if they could not use the term; and (4) competitor's actual use, where an inquiry is made to see if the term has been used by others marketing a similar product or service.⁷⁰

A fanciful term is a word that is invented as a product or service name.⁷¹ In contrast, an arbitrary word is an existing word used for a product or service unrelated to the word's ordinary meaning.⁷² Further, a term can be one of the four levels in a particular market and be a different level in another market.⁷³

To have a valid claim for trademark infringement, for both registered and unregistered marks, generally two or three elements need to be satisfied: (1) the plaintiff must establish ownership of a valid mark; (2) require the plaintiff to demonstrate the defendant is using the mark in commerce; and (3) the mark is used in a way that is likely to cause confusion as to the source, sponsorship, or authorization.⁷⁴ Should all three elements be met, a plaintiff has a valid claim for federal trademark infringement.⁷⁵ If the case is in a jurisdiction that considers the second element, such as the Second Circuit, any use of a plaintiff's mark for commercial purposes is a use in commerce except a purely internal use for a defendant's business.⁷⁶ Regarding the third element of trademark infringement, confusion tests vary between jurisdictions; each court uses its own multi-factor

⁶⁶ *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 119 (5th Cir. 1979); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983), *abrogated by* *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 125 S. Ct. 542, 160 L. Ed. 2d 440 (2004).

⁶⁷ *Abercrombie & Fitch Co.*, 537 F.2d at 10.

⁶⁸ *Stix Prod., Inc. v. United Merch.'s & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968).

⁶⁹ *Abercrombie & Fitch Co.*, 537 F.2d at 11.

⁷⁰ *Zatarains, Inc.*, 698 F.2d at 792-93.

⁷¹ *Abercrombie & Fitch Co.*, 537 F.2d 11-12.

⁷² *Id.*

⁷³ *Id.* at 12.

⁷⁴ 15 U.S.C. § 1114.

⁷⁵ *Id.*

⁷⁶ *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123, 127 (2d Cir. 2009).

analysis to determine if the confusion element has been met.⁷⁷ The tests do not simply count each factor; instead, the weight of each factor is considered in evaluating whether confusion has occurred.⁷⁸ Trademarks can either be unregistered or federally registered. Federal registration can offer numerous benefits⁷⁹ to holders of such marks, with the registration status lasting so long as the holder continues to use the mark in commerce⁸⁰ and can provide evidence of its continued use.⁸¹

C. Trademarks and their Application to eSports

The section above details how trademark laws apply to word marks. The problem with eSports players and their respective gamertags,⁸² however, is how to confer their distinctiveness to their brands. Specifically, the most popular streamers tend to be famous for certain games and create their brands based on performances in particular video games. What would happen if another gamer with a similar gamertag—but who has grown notoriety with a different game—challenges the brand distinctiveness of the original gamer’s alias? Is the second gamer with a similar gamertag, but who grew fame from another game, infringing upon the first gamer’s moniker? This hypothetical scenario is a plausible situation a court may need to address one day. Gamertags are a critical tool to confer brand distinctiveness in eSports, as they help identify a gamer’s

⁷⁷ The Sixth Circuit, for example considers eight elements for determining if there is a likelihood for confusion amongst consumers. They include the following: strength of the plaintiff’s mark; relatedness of the goods; similarity of the marks; evidence of actual confusion; marketing channels used; likely degree of purchaser care; defendant’s intent in selecting the mark; and likelihood of expansion of the product lines. *Frisch’s Rest.’s, Inc. v. Elby’s Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982); *see also Likelihood of Confusion Factors*, LIKELYTOCAUSECONFUSION, <https://likelytocauseconfusion.com/likelihoodofconfusionfactors.html> (last visited Nov. 5, 2023) (lists the factors each of the thirteen circuits considers).

⁷⁸ *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 215 (3d Cir. 2000).

⁷⁹ Josh Gerben, *Top 5 Advantages of U.S. Trademark Registration*, GERBEN LAW, <https://www.gerbenlaw.com/blog/top-5-advantages-of-u-s-trademark-registration/> (last visited Nov. 5, 2023) (Five benefits of federally registering trademarks include: (1) Protection against infringement, (2) federal trademark registration provides nationwide validity, (3) federal trademark registration procures a valuable asset for businesses, (4) unique trademarks can help customers identify trademarked businesses more easily, and (5) federal registration can provide a springboard to eventual international registration.).

⁸⁰ *Why Register Your Trademark?*, USPTO, <https://www.uspto.gov/trademarks/basics/why-register-your-trademark> (last visited Nov. 3, 2023).

⁸¹ *Id.*

⁸² *See Sam Quirke, What is a Microsoft Account? A Guide to Setting Up on Xbox*, TRUEACHIEVEMENTS (Dec. 25, 2019), <https://www.trueachievements.com/n39992/sign-up-microsoft-account-xbox-gamertag> (defining a gamertag as an identifiable “user name and identity in the Xbox ecosystem.” While gamertags are terms used to distinguish players on the Microsoft Xbox console, they have gained notoriety for identifying gamers on other platforms besides the Xbox console.).

brand, reputation, and connection to their fans;⁸³ thus, any infringement upon such gamertags may lead to brand dilution or confusion amongst consumers, as can arise with infringement of other trademarks.

The importance of gamertags in the eSports industry can be analogized and better understood through trademarks of traditional professional sports and their athletes and teams. Professional sports teams from the big four leagues (National Football League, National Basketball Association, National Hockey League, Major League Baseball) fight yearly to protect one of their clubs' most valuable assets: trademarked merchandise sales.⁸⁴ From sales by the league and their respective clubs to prospective businesses looking to license the leagues' products,⁸⁵ these sales procure substantial revenue for the leagues.⁸⁶ In fact, these leagues fight against counterfeit goods that claim to be authentic merchandised sales to protect their valuable trademarked products.⁸⁷ Considering the impact on revenue that trademarked merchandise sales can have, it is no wonder leagues fight vehemently against any counterfeit goods or products claiming to be authentic merchandise. The logic of why professional sports leagues fight to protect their respective trademarks also applies to eSports.

⁸³ See generally Caleb Rainey, *Esports Nicknames and Their Purpose*, READYSPORTS, <https://readyesports.com/esports-nicknames-and-their-purpose/> (Nov. 5, 2023).

⁸⁴ Retail sales of merchandising/licensing in each of the four leagues: NFL—\$ 4 billion; NBA—\$1.46 billion; NHL—\$1.4 billion; MLB—\$3.4 billion. See *How the NFL Turned Football into a Billion-Dollar Business*, BISON & BIRD, <https://www.teambisonandbird.com/post/nfl-business> (last visited Nov. 5, 2023); see also Dimitrije Curcic, *NBA Revenue Statistics (2001-2022)*, RUNREPEAT (Nov. 1, 2023), <https://runrepeat.com/nba-revenue-statistics>; see also Sean Shapiro, *NHL Revenues Reach Record High Thanks to Jump in Sponsorship, Licensing Deals*, THE ATHLETIC (June 25, 2022), <https://theathletic.com/3382650/2022/06/25/nhl-revenues-reach-record-high-thanks-to-jump-in-sponsorship-licensing-deals/>; see also Natalie Sherman, *Orioles Merchandise Sales Spike*, THE BALTIMORE SUN (Sept. 28, 2014, 12:00 AM), <https://www.baltimoresun.com/business/bs-xpm-2014-09-29-bs-bz-orioles-merchandise-20140929-story.html>.

⁸⁵ Before an NFL license is granted to a business, a prepaid royalty guarantee of \$100,000 is required. *NFL Trademarks: Everything You Need to Know*, UPCOUNSEL, <https://www.upcounsel.com/nfl-trademarks> (Oct. 1, 2020).

⁸⁶ See *supra* note 84.

⁸⁷ In one example, the NFL frequently partners with governmental agencies, like U.S. Immigration and Customs Enforcement (ICE), to fight counterfeit league merchandise being sold at the Super Bowl. At the time the article was written, it was the fifth consecutive year of the partnership. Alicia Jessop, *The NFL and Federal Government Team Up to Combat Against Counterfeit Super Bowl Merchandise*, FORBES (Jan. 31, 2013, 12:20 PM), <https://www.forbes.com/sites/aliciajessop/2013/01/31/the-nfl-and-federal-government-team-up-to-combat-against-counterfeit-super-bowl-merchandise/?sh=6a3a18c0187d>.

This issue of trademarked recognition also arises with eSports teams and organizations regarding their branding.⁸⁸ Different tests in the thirteen districts create an inefficient system that leads to unnecessary uncertainty for eSports professionals and organizations. Further, considering how eSports brand recognition is nationwide and not limited to a geographical area, the current trademark laws create a district-by-district analysis that is slow, inefficient, impractical, and confusing for eSports players, organizations, and streamers.⁸⁹

D. Author's Solution

Without amending the Lanham Act, confusion about what can and cannot be protected for eSports professionals will continue to persist. The comment's proposed framework aims to introduce a federal standard for electronic trademarks concerning trademark confusion, traditionally element (3) of a trademark infringement claim. This proposed amendment would help streamline and simplify the process of determining if the mark is likely to cause confusion. Additionally, this framework would ensure that any non-electronic trademark goods that have either registered or unregistered trademark protection can maintain their brands, while eSports professionals can obtain their marks for their respective aliases. This electronic trademark solution would help avoid cases like *FAZE Apparel v. Faze Clan*, where the Faze Clan eSports organization's team merchandise would likely confuse consumers with FAZE Apparel's merchandise, a casual men's clothing brand, who owned federal trademark registrations for "FAZE" and "F.A.Z.E."⁹⁰

The framework, recognizing the current district-by-district analysis for the confusion of word marks, aims to procure one test that electronic word trademark seekers need to be aware of. The amendment to the Lanham Act would codify and specify that for word marks of a primarily electronic nature, the following factors would be considered: (1) the strength of the mark; (2) the similarity of competing marks; (3) the similarity of the markets the plaintiff and defendant are in; (4) the defendant's intent by use of the purported infringed mark; and (5) actual confusion. Simply counting these factors would not suffice to satisfy trademark infringement; instead, a weighing of their respective importance would be determined on a case-by-case, fact-by-fact basis to allow for maximum flexibility in deciding if trademark confusion has occurred.

⁸⁸ *FAZE Apparel, LLC v. Faze Clan, Inc.*, No. 218CV02052RGKJEM, 2018 WL 3830027 (C.D. Cal. May 22, 2018) (court held in favor of FAZE Apparel over Faze Clan, with the eSports organization Faze Clan unable to sell team merchandise with its name).

⁸⁹ *Likelihood of Confusion Factors*, *supra* note 77.

⁹⁰ *FAZE Apparel*, 2018 WL 3830027.

The author has primarily selected these factors for their intuitive nature, relatively simplistic application, and conciseness in solving the potential problem. These factors allow courts to have a concrete, solidified test to determine whether an electronic trademark is infringed upon. By implementing this framework, any confusion of what may or may not constitute trademark confusion of electronic marks can be eliminated. Judicial efficiency would improve, and the singular test for trademark confusion would offer a streamlined approach, meaning eSports organizations and professionals would better understand what constitutes confusion.

The proposed framework is needed because of the unique characteristics electronic trademarks possess. While a regional analysis for localized trademarks may make sense, especially how businesses and marks can have a certain meaning in one part of the country and an entirely different meaning in another region, the nature of electronic marks does not limit them to a single geographical area. Due to their ease of access through electronic marketing channels, primarily via the internet, anyone from any geographical location can infer what an electronic mark may mean. In simplest terms, it is illogical to use various regional tests when the marks are not conferred to a particular region. By adopting this framework, judicial efficiency can increase when determining whether trademark confusion is present and thus determine whether a trademark has been infringed upon more quickly.

III. CONCLUSION

By amending the Lanham Act with this comment's proposed framework, confusion on what may or may not constitute trademark infringement of electronic marks will subside. The proposed framework will streamline judicial efficiency, procure a more robust understanding for eSports professionals, and bring trademark laws into the 21st century. Because the very nature of eSports is not constrained to a limited geographical area, it makes sense to introduce a federal solution that does not limit electronic businesses, like eSports, to one geographical location. By weighing (1) the strength of the mark; (2) the similarity of competing marks; (3) the similarity of the markets the plaintiff and defendant are in; (4) the defendant's intent by use of the purported infringed mark; and (5) actual confusion present, courts will have a simple solution to a complicated problem.