

Collegiate Athletes and the Right to Their Marks

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I. INTRODUCTION

In the world of trademark law, collegiate athletes play without a coach. Collegiate athletes may compete with third parties, while they are strictly barred from profiting off their marks. When it comes to trademark application, registration, and protection, collegiate athletes are aimless individuals who face difficulty in developing their brands at the most basic level—trademark protection. Trademark rights serve as a basic protection against the unauthorized use of one’s marks—a collegiate athlete’s name, nicknames, and catchphrases. Under the current system, collegiate athletes are forced to travel highly uncharted territories. This comment serves to shed light on the approaches of prior collegiate superstars, the current collegiate athletic system,

relevant trademark law, issues with the current system, and proposed solutions.

II. WHAT COLLEGIATE ATHLETES HAVE DONE

The National Collegiate Athletic Association (NCAA) governs collegiate athletics through its Constitution and Bylaws. While several collegiate athletes have been presented with conflicts between their intellectual property rights and the NCAA governing legislation, only a few examples are discussed below. The conflict concerns how a collegiate athlete reconciles his or her limitations due to the NCAA rules and a desire to protect one's intellectual property. The short answer: collegiate athletes do not typically apply for federal trademark registration. For a multitude of reasons, collegiate athletes forego application. They might not apply for trademark registration due to a lack of knowledge about trademark law, fear that filing an application will result in ineligibility or sanctions against the player or the team, confusion about the NCAA's stance, or shortsightedness.¹ The first thing on a collegiate athlete's mind is most likely not applying for trademark registration. Furthermore, due to the NCAA Bylaws, a collegiate athlete cannot contract with an agent for help in understanding the complicated trademark laws without risking ineligibility.² Furthering a lack of knowledge about law and policy, the NCAA has not published a statement or policy concerning the possibility of an athlete filing an intent to use trademark application.³ Additionally, universities and colleges typically do not persuade their collegiate athletes to properly protect their intellectual property.⁴

Collegiate athletes likely do not have the foresight to consider their long-term intellectual property rights. Their primary focus probably lies in development of their athletic abilities in hopes of entering a professional draft, without thinking that their nickname or catch phrase deserves proactive application with the United States Patent and Trademark Office (USPTO). All of these factors lead to a big picture issue that many professional athletes have recently faced: third parties applying for the right to use their intellectual property.

Some collegiate athletes can become high-profile public figures and household names. Without proper and timely filings of trademark applications, they risk the chance that a third party will file an application and begin to use

1. See Darren Heitner, *Should Current NCAA Student-Athletes File for Federal Trademark Protection?*, FORBES (Dec. 9, 2013), <http://www.forbes.com/sites/darrenheitner/2013/12/09/should-current-ncaa-student-athletes-file-for-federal-trademark-protection/>.

2. See NAT'L COLLEGIATE ATHLETIC ASS'N, 2015-16 NCAA DIVISION I MANUAL art. 12.1.2(g) (2015) [hereinafter NCAA MANUAL].

3. See Heitner, *supra* note 1.

4. *Id.*

their nicknames or catchphrases for profit. These so-called “trademark trolls” willingly pounce on the opportunity to lay claim to collegiate athletes’ marks, because collegiate athletes simply do not file applications. The lack of proper and timely trademark application filing has led professional athletes to resort to litigation and to fight for the right to use and protect their own intellectual property. While an athlete who encounters a third party applicant would most likely succeed in his or her legal battle, the costs of litigation may not only be expensive, but unnecessary. If collegiate athletes were capable of acquiring better knowledge about the law and proactively seek to protect their marks, then legal battles may not have to occur for them to retain their intellectual property rights from the start.

Vince Young, Anthony Davis, and Johnny Manziel provide textbook examples of what collegiate athletes have done or not done in the past. Each of these three men became nationally recognizable names and collegiate superstars in their respective sport. They each had nicknames or unique characteristics, which could have provided the opportunity to grow their individual brands. As we will see, the choices made by these athletes during and immediately after their collegiate careers had an effect on their future intellectual property rights.

A. *Vince Young*

The day after Vince Young led the University of Texas to a college football national championship in the Rose Bowl in 2006, trademark applications to use his initials (VY) and his nickname (INVINCIBLE) were filed to sell products without Young’s permission.⁵ Moreover, Young was unaware that applications were even filed to use his initials and nickname in commerce.⁶ Young was forced to commence a lawsuit against the third party who filed the applications to fully receive his intellectual property rights, which, again, were rightfully his from the beginning. Young did not file any applications to register his marks while in college, which appears typical for collegiate athletes from the famous to the run-of-the-mill. Young’s inattentiveness and shortsightedness to the necessity of applying for trademark protection led him down the path of litigation. Although he ultimately settled the case and received the rights to his initials and nickname, Young spent two years of time and attorney fees to retrieve his trademark rights.⁷ Perhaps if Young knew more about trademark

5. See *Vince Young Files Trademark Suit in Texas for Use of Initials, Nickname*, USA TODAY, Dec. 19, 2008, http://usatoday30.usatoday.com/sports/football/nfl/titans/2008-12-19-young-trade-mark-lawsuit_N.htm.

6. See *id.*

7. See *Young v. Vannerson*, 612 F. Supp. 2d 829 (S.D. Tex. 2009).

law or was persuaded to file an application prior to third parties, then he could have avoided a drawn out legal battle that seemingly persisted past his professional career.

B. Anthony Davis

Anthony Davis of the National Basketball Association (NBA) became a freshman phenomenon while playing for the University of Kentucky. He led the Wildcats to a NCAA National Championship victory in 2012. After his freshman year, Davis entered the NBA Draft and went on to be the number one pick. Before his draft day, Davis filed trademark applications for “FEAR THE BROW,”⁸ “RAISE THE BROW,”⁹ “AD23,”¹⁰ “BROW DOWN,”¹¹ and “ANTHONY DAVIS.”¹² Davis was fairly proactive in protecting his intellectual property, but, for two of his marks, he was not the first person or entity to file an application. “FEAR THE BROW” and “BROW DOWN” both had trademark applications filed in late 2011.¹³ The real fear in 2012 was not of the brow, but of how Davis would acquire full protection of his intellectual property rights. The options, at the time, were either that Davis file a lawsuit against the prior applicants or pay the third party for the rights. However, as time passed, the prior applicants abandoned their marks in November, 2012¹⁴ and March, 2013,¹⁵ respectively. Davis was able to avoid a potentially lengthy, expensive litigation, or paying out a large sum of money, and now has successfully registered his marks.¹⁶ These prior applications were filed with the USPTO before Davis had finished his first semester at Kentucky and, seemingly, as soon as Davis started his first NCAA basketball season. The situation worked out well for Davis, but imagine if he wished to stay in school for another three years. Moreover, the prior applicants may have been able to profit off Davis’s likeness until he left college, which could have led to extensive litigation. All for the rights to phrases derived from Davis’s physical feature—his unibrow.

8. FEAR THE BROW, Registration No. 4,660,490.

9. RAISE THE BROW, Registration No. 4,660,491.

10. AD23, Registration No. 4,653,775.

11. BROW DOWN, Registration No. 4,653,774.

12. U.S. Trademark Application Serial No. 85/643,436 (filed June 5, 2012).

13. U.S. Trademark Application Serial No. 85/477,805 (filed Nov. 21, 2011) [hereinafter *FEAR THE BROW*]; U.S. Trademark Application Serial No. 85/473,719 (filed Nov. 16, 2011) [hereinafter *BROW DOWN*].

14. *BROW DOWN*, *supra* note 13.

15. *FEAR THE BROW*, *supra* note 13.

16. Except for the “ANTHONY DAVIS” mark.

C. Johnny Manziel

Johnny Manziel, the 2012 Heisman Trophy Winner, has also been proactive in applying for trademark registration. Manziel entered the NFL in the 2014 draft and was arguably the highest-profile draftee—infamous for his on the field play and off the field lifestyle. Manziel and his company, JMAN2 Enterprises LLC (JMAN2), have filed sixteen trademark applications. Manziel and JMAN2 have filed trademark applications for marks such as “Johnny Football,”¹⁷ “The House That Johnny Built,”¹⁸ and “Johnny Cleveland.”¹⁹ “Johnny Football” has become the focus of two main trademark battles.

First, JMAN2 filed a complaint against Eric Vaughan for using the mark on a t-shirt.²⁰ Here, Manziel, through his company, effectively protected his mark. The case eventually settled and Vaughan stopped selling the shirts on his website.²¹ Second, Manziel potentially faced litigation against Kenneth R. Reynolds Family Investments, who applied for the rights to “Johnny Football” three months before Manziel.²² Litigation was avoided by the USPTO’s rejection of Reynolds’s application, allowing JMAN2 to move ahead with its application for the trademark.²³ Manziel also faced a competing trademark application from a company owned by the family of a longtime friend, Nate Fitch, for the mark “The House That Johnny Built,” who filed an application a month before Manziel.²⁴ This dispute did not evolve into a lawsuit. Fitch’s company abandoned the mark in November 2014.²⁵ Manziel’s trademark history exemplifies what an athlete should do with their marks—apply for trademark registration and actively protect the use of that mark throughout the process.²⁶

17. U.S. Trademark Application Serial No. 85/839,336 (filed Feb. 2, 2013).

18. U.S. Trademark Application Serial No. 86/178,965 (filed Jan. 29, 2014).

19. U.S. Trademark Application Serial No. 86/370,885 (filed Aug. 19, 2014).

20. See Michelle Keahey, “Johnny Football” Files Trademark Infringement Lawsuit over Shirts, SE. TEXAS REC. (Feb. 22, 2013), <http://setexasrecord.com/news/282039-johnny-football-files-trademark-infringement-lawsuit-over-shirts>.

21. See Jeff Mosier, *Johnny Manziel’s Family Settle T-shirt Lawsuit*, DALL. MORNING NEWS, Nov. 1, 2013, <http://thescoopblog.dallasnews.com/2013/11/johnny-manziels-family-settle-t-shirt-lawsuit.html/>.

22. See Chase Goodbread, *Johnny Manziel Wins ‘Johnny Football’ Trademark Case*, NFL (Mar. 21, 2014), <http://www.nfl.com/news/story/0ap2000000335932/article/johnny-manziel-wins-johnny-football-trademark-case>.

23. See *id.*

24. See Chase Goodbread, *Johnny Manziel, Longtime Friend Set to Battle for Trademark Rights*, NFL (Apr. 3, 2014), <http://www.nfl.com/news/story/0ap2000000339271/article/johnny-manziel-longtime-friend-set-to-battle-for-trademark-rights>.

25. U.S. Trademark Application Serial No. 86/153,461 (filed Dec. 27, 2013) (abandoned on Nov. 13, 2014).

26. In addition, a couple more recent applications have been filed by current collegiate athletes.

D. What To Take Away

The three prior examples show two approaches former collegiate athletes have taken to protect their marks. On the one hand, Vince Young neglected to timely file trademark applications for his initials and nickname. He then had to resort to the court system to retrieve the rights to his marks, which took years.²⁷ Meanwhile, Young saw his once promising professional career dwindle to a life of backup positions, practice squads, and free agency. By the time Young won his trademark battle, he no longer played for a NFL team. On the other hand, Anthony Davis and Johnny Manziel proactively applied for trademark protection prior to being drafted. They also actively protected their marks by seeking out those who either wrongfully applied before them or were using their mark in commerce without their consent. Preferably, more collegiate athletes will follow the Davis/Manziel approach and not Young's mistakes.

III. THE CURRENT NCAA SYSTEM

A. NCAA Rules

The NCAA Constitution and Bylaws govern collegiate athletes and determine eligibility for competition.²⁸ Eligibility allows a collegiate athlete to participate in inter-collegiate sports.²⁹ The bylaws regulate the minimum grades a collegiate athlete must achieve, the acceptance of payment, use of agents, promotional activities, ethical conduct, recruitment, financial aid, and many other facets.³⁰ All of those may have an effect on a player's eligibility to compete inter-collegiately.³¹

Amateurism is a foundational principle of the NCAA and collegiate athletics.³² Eligibility requirements are tailored to "assure proper emphasis on educational objectives, to promote competitive equity among institutions and to prevent exploitation of student-athletes."³³ If a collegiate athlete loses amateur status, he or she becomes ineligible to compete in that particular

Ezekiel Elliott has filed applications with the USPTO for marks, e.g. "HERO IN A HALF SHIRT," U.S. Trademark Application Serial No. 86/732,902 (filed Aug. 21, 2015). *See also* U.S. Trademark Application Serial No. 86/732,892 (filed Aug. 21, 2015), U.S. Trademark Application Serial No. 86/717,843 (filed Aug. 7, 2015), and U.S. Trademark Application Serial No. 86/717,832 (filed Aug. 7, 2015). Dak Prescott has filed applications for his marks as well, e.g. "WHO DAK," U.S. Trademark Application Serial No. 86/546,163 (filed Feb. 25, 2015).

27. *See* Young v. Vannerson, 612 F. Supp. 2d 829 (S.D. Tex. 2009).

28. *See* NCAA MANUAL, *supra* note 2.

29. *See id.* art. 12.01.

30. *See id.* art. 12.

31. *See id.*

32. *See Amateurism*, NCAA, www.ncaa.org/amateurism (last visited Oct. 17, 2015).

33. *See* NCAA MANUAL, *supra* note 2, art. 2.12.

sport.³⁴ An individual loses amateur status if he or she (1) uses his or her athletic skill for pay in any form in that sport; (2) accepts a promise of pay, even if that pay is to be received after completion of collegiate competition; (3) signs a contract or commitment to play professional athletics; (4) receives any financial assistance from a professional sports organization; (5) competes on any professional athletic team, even if he or she receives no pay; (6) enters into a professional draft; or (7) enters into an agreement with an agent.³⁵ Pay is defined as “the receipt of funds, awards or benefits not permitted” by the NCAA’s governing legislation.³⁶ An agent is defined as anyone who either (1) “[r]epresents or attempts to represent an individual for the purpose of marketing his or her athletic ability or reputation for financial gain” or (2) “[s]eeks to obtain any type of financial gain or benefit from securing a prospective student-athlete’s enrollment at an educational institution or from a student-athlete’s potential earnings as a professional athlete.”³⁷ An agent may include a financial advisor, marketing representative, or brand manager.³⁸

When analyzing United States trademark law and the NCAA Constitution and Bylaws, it may seem that collegiate athletes are barred from acquiring trademark protection for their name, likeness, slogans, etc. Under NCAA Bylaw 12.5.2.1, a collegiate athlete loses eligibility for participation in intercollegiate athletics if he or she “[a]ccepts any remuneration for or permits the use of his or her name or picture to advertise, recommend or promote directly the sale or use of a commercial product or service.”³⁹ Additionally, NCAA Bylaw 12.4.4 states that a collegiate athlete cannot use his or her name, photograph, appearance, or athletic reputation to promote his or her own business.⁴⁰ Therefore, a collegiate athlete cannot use his or her personal brand to profit, contract with an agent to facilitate such use, use his or her name or likeness to promote another commercial business or product, or allow the use of his or her brand with a promise of future pay.⁴¹ While all these limitations exist in the current NCAA system, collegiate athletes could conceivably acquire federal trademark registration.⁴²

34. *See id.* art. 12.1.2.

35. *See id.* art. 12.1.2 (a)–(g).

36. *See id.* art. 12.02.8.

37. *See id.* art. 12.02.1.

38. *See id.* art. 12.02.1.1.

39. *See id.* art. 12.5.2.1.

40. *See id.* art. 12.4.4.

41. *See id.* art. 12.

42. *See infra* Part IV.A.

B. NCAA Rules and Trademark Law

For our purposes, trademarks can be applied for through two primary routes: § 1(a)⁴³ and § 1(b)⁴⁴ bases. An application for a trademark on a § 1(a) basis (use in commerce basis) involves a mark that is currently used in commerce.⁴⁵ An application on a § 1(b) basis (intent to use basis) involves a bona fide intent to use a mark in commerce.⁴⁶ This comment will emphasize the possibility of a collegiate athlete to file on both bases. NCAA rules greatly restrict the ability to file on a use in commerce basis. According to the NCAA Bylaws, a collegiate athlete loses eligibility if he or she receives remuneration for or permits the use of his or her name or likeness in commerce.⁴⁷ NCAA rules also impact the effectiveness of the intent to use basis. A collegiate athlete who files on an intent to use basis does not explicitly violate any NCAA Bylaw and would not lose eligibility.⁴⁸ A collegiate athlete could apply on an intent to use basis and, once his or her college career has ended, begin using the mark in the commerce. Once their collegiate career ends, collegiate athletes are out of the NCAA's jurisdiction and can begin to profit off their names or likenesses.

Outside of federal registration, trademark law already confers some protections for collegiate athletes. "The unauthorized misappropriation of an athlete's persona violates . . . the Lanham Act if it causes consumer confusion regarding whether he or she has endorsed or sponsored particular products or services."⁴⁹ The First Amendment, however, limits the protections conferred by the Act.⁵⁰ The protections, though, apply to unregistered marks: unfair practices provisions protect unregistered marks.⁵¹ Therefore, even though a collegiate athlete's mark may be unregistered, the Act provides for civil remedies against unauthorized use.⁵²

43. See 15 U.S.C. § 1051(a) (2012).

44. See 15 U.S.C. § 1051(b) (2012).

45. See § 1051(a).

46. See § 1051(b).

47. See NCAA MANUAL, *supra* note 2, arts. 12.1.2, 12.5.

48. See Christie Cho, *Protecting Johnny Football[R]: Trademark Registration for Collegiate Athletes*, 13 NW. J. TECH. & INTELL. PROP. 66 (2015).

49. MATTHEW J. MITTEN, *SPORTS LAW IN THE UNITED STATES* 165 (Roger Blanpain et al. eds., 2d ed. 2014); *see also* 15 U.S.C. § 1125(a) (2012).

50. See *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013).

51. See 15 U.S.C. § 1125(a); MITTEN, *supra* note 49; *see Birthright v. Birthright, Inc.*, 827 F. Supp. 1114, 1136 (D. N.J. 1993); *see Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767 (1992).

52. See 15 U.S.C. § 1125(a); MITTEN, *supra* note 49.

IV. ISSUES THAT ARISE FOR A COLLEGIATE ATHLETE IN TRADEMARK LAW

Issues for collegiate athletes in the trademark world arise in both the use in commerce and intent to use bases. The NCAA's restriction on the acceptance or promise of payment strengthens barriers to trademark registration. The issues that arise under both bases are discussed below. Use in commerce basis issues arise on a *prima facie* level, namely the lack of any potential monetary gain; thus, the issues for this basis are not discussed in vast detail. Attention is given to the inability of a collegiate athlete to receive payment.⁵³ Intent to use basis issues receive more attention below due to the suggestion that collegiate athletes should focus their trademark application efforts under this basis.⁵⁴ Those issues include the limitations of applying on an intent to use basis and lack of objective intent.

A. Use in Commerce Basis

Filing on a use in commerce basis requires that the mark be presently in use in commerce.⁵⁵ The Lanham Act defines "commerce" as "all commerce which may lawfully be regulated by Congress,"⁵⁶ a sweeping definition. The Act defines "use in commerce" as

the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is

53. Other issues that may arise are not discussed in this comment.

54. See generally Cho, *supra* note 48.

55. 15 U.S.C. § 1051(a) (2012).

56. 15 U.S.C. § 1127 (2012).

engaged in commerce in connection with the services.⁵⁷

The combination of the requirements of a use in commerce basis and NCAA rules may lead one to conclusively believe that the rules bar a collegiate athlete from effectively applying on a use in commerce basis. While the NCAA's rules limit a collegiate athlete's ability to register a mark under this basis, the rules may not completely bar such registration. Later in this comment, we will explore a promising route that could lead to more federal trademark registrations on a use in commerce basis.⁵⁸

Limitations applied by the NCAA rules include the restriction on accepting any form of payment⁵⁹ or any promise of payment.⁶⁰ At first glance, it appears that collegiate athletes would not be able to satisfy the "use in commerce" requirement. Indeed, the proscription of payment of any kind, at any time, offers a large barrier to using a mark in commerce. Additionally true, commerce typically involves the exchange or buying and selling of a good or service on a large scale.⁶¹ The restrictions imposed by the NCAA rules effectively bar a collegiate athlete from registering on a use in commerce basis for *his or her own* use in commerce, as commerce typically connotes the selling of goods or services for some gain.

B. Intent to Use Basis

1. Limitations of Applying on an Intent to Use Basis

Intent to use requires both actual intent to use and objective evidence that such an intent exists.⁶² An applicant usually can prove bona fide intent to use through "a written plan of action."⁶³ An applicant's state of mind cannot demonstrate the requisite intent to use.⁶⁴ The policy considerations behind these requirements are strong. Congress surely did not intend nor want the intent to use application system to allow for applicants to merely place a claim over a mark which they did not actually intend to use in commerce.⁶⁵

57. *Id.*

58. *See infra* Part IV.A.

59. *See* NCAA MANUAL, *supra* note 2, art. 12.1.2.1.

60. *See id.* art. 12.1.2(b).

61. *See Commerce*, MERRIAM-WEBSTER, available at <http://www.merriam-webster.com/dictionary/commerce> (last visited Oct. 25, 2015).

62. *See* Aktieselskabet AF 21 November 2001 v. Fame Jeans Inc., 525 F.3d 8 (D.C. Cir. 2008).

63. *W. Brand Bobosky v. Adidas AG*, 843 F. Supp. 2d 1134, 1140 (D. Or. 2011) (quoting 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 19:14 (4th ed. 2011)).

64. *See id.*

65. *See* S. Rep. No. 100-515, at 6 (1988), *reprinted in* 1988 U.S.C.A.N. 5577, 5582.

On opposition, a collegiate athlete looking to maintain an intent to use application must objectively show his or her intent to actually use the mark in commerce. The issue under this objectivity standard is that collegiate athletes perhaps cannot conceive of a “written plan of action” to use their mark in commerce. Additionally, composing a written plan, while not explicitly violating NCAA rules, could lead the collegiate athlete into eligibility trouble if additional steps are taken.⁶⁶

“Intent to use a mark, like a naked registration, establishes no rights at all.”⁶⁷ While intent to use applicants may seem to have rights to their marks, in reality, they do not. Intent to use applications do have benefits, but the mere fact that someone, even with a bona fide intent to use, desires to use a mark and has a plan to do so, does not create a legally protectable right.⁶⁸ Upon registration, only a rebuttable presumption of use exists from the date of filing.⁶⁹

What does this mean for collegiate athletes? Simply put, even though collegiate athletes can technically apply for registration under intent to use,⁷⁰ their rights to protect their marks only come to fruition once the good is actually used in commerce. And, then, they only have a rebuttable presumption that their marks are in use as of the filing date. Thus, a third party, who uses the mark in commerce prior to the collegiate athlete filing under intent to use, could be safe from legal action for that prior use. Only when the collegiate athlete uses the mark in commerce does constructive use apply retroactively to the date of filing.⁷¹ However, under current NCAA rules, actual use in commerce is restricted and may cause delay of use until after graduation or cessation of intercollegiate athletic participation.

2. Lack of Objective Intent

In *Aktieselskabet AF 21 November 2001 v. Fame Jeans Inc.*,⁷² the D.C. Circuit held that that Bestseller sufficiently stated a claim that Fame lacked a bona fide intent to use the mark “Jack & Jones.”⁷³ In doing so, the court noted that an “opposer may defeat a trademark application for lack of a bona fide intent . . . by proving the circumstances at the time of filing did not demonstrate that intent.”⁷⁴ In this case, Fame filed an intent to use application for the mark

66. See, e.g., NCAA MANUAL, *supra* note 2, art. 12.5.

67. *Zazu Designs v. L’Oreal S.A.*, 979 F.2d 499, 504 (7th Cir. 1992).

68. See *id.*

69. See *id.*

70. See Cho, *supra* note 48.

71. See 15 U.S.C. § 1057(c) (2012).

72. See *Aktieselskabet AF 21 November 2001 v. Fame Jeans Inc.*, 525 F.3d 8 (D.C. Cir. 2008).

73. See *id.* at 23.

74. See *id.* at 21.

allegedly to thwart Bestseller's entrance into the U.S. market.⁷⁵ The court found that Bestseller's allegations sufficiently showed circumstances that refuted Fame's good faith intent to use the mark in commerce.⁷⁶ The court here also concluded that, under § 2(d), "an intent to use applicant prevails over any opposer who began using a similar mark after the intent to use filing date."⁷⁷ Furthermore, to succeed in a § 2(d) claim, the opposer must show there is a likelihood of confusion with a mark "previously used"—for intent to use applicants the only date applicable is the filing date.⁷⁸

Applying the D.C. Circuit's opinion to collegiate athletes, the problem that collegiate athletes face has two main parts. First, if a third party already has an intent to use application pending with the USPTO, then the athlete must be able to show that he or she used the mark prior to the third party's filing date. When it comes to collegiate athletes, this proves nearly impossible, because, due to NCAA rules, they are restricted in using their mark in commerce—this could lead to profiting off their name or likeness, which is a clear violation of NCAA rules.⁷⁹ Second, if the collegiate athlete filed an intent to use application prior to an opposing third party, then that third party could allege that the collegiate athlete lacked a bona fide intent by showing that the circumstances at the time of filing did not demonstrate that intent. The third party could show that, due to the NCAA rules, the athlete could not have had a bona fide intent to use the mark, because the athlete was barred from such use.⁸⁰ Additionally, a third party could allege that the athlete's intent to use application was merely intended to either thwart a third-party user, or put a placeholder on the mark until that athlete ceased intercollegiate athletics. These allegations would not be unfounded. Under the current system, an athlete filing on an intent to use basis would be doing so to prevent others from using the mark and/or putting a placeholder on that mark.

3. Creating A Plan of Action

In *Young v. Vannerson*,⁸¹ Vince Young alleged infringement on his common law trademark in VY and INVINCIBLE.⁸² The defendant had filed intent to use applications with the USPTO for those marks, of which Young

75. *See id.* at 22.

76. *See id.*

77. *See id.* at 18.

78. *See id.*

79. *See* NCAA MANUAL, *supra* note 2, art. 12.5.

80. *See id.* art. 12.5.

81. *See* *Young v. Vannerson*, 612 F. Supp. 2d 829 (S.D. Tex. 2009).

82. *See id.* at 833.

claimed he was a senior user.⁸³ The District Court for the Southern District of Texas, Houston Division agreed with the defendant on the point that a mere trademark application does not confer rights to a party, but also stated that plaintiffs alleging infringement did not have to wait until registration is granted to file suit.⁸⁴ The court further acknowledged that a controversy does not arise when a defendant has not used the mark with any product or “taken any steps to sell, transport, distribute, market, or advertise . . . any products or samples of products.”⁸⁵ The court found that there was a sufficient controversy and denied Vannerson’s motions to dismiss, because Vannerson had taken steps to design, manufacture, license, and sell products with the marks.⁸⁶

Creating a business plan or a plan of action to use their mark could theoretically expose collegiate athletes to litigation if there are other users of the mark.⁸⁷ The cost of fighting to defend their trademark rights in court could be expensive, which could lead to many athletes with claims to marks to simply give up. There would potentially be little incentive for collegiate athletes to press on and fight an expensive battle in court when they are fighting for the rights to a mark from which they cannot presently profit. Additionally, the court system can be slow-going, so they could have a litigation lingering over their heads, possibly past the cessation of their inter-collegiate activities.

The overarching issue is that, in order to claim rights under an intent to use application, the athlete needs to develop an objective plan of action, but, by doing so, he or she opens himself or herself up to potential litigation from third parties who may be wrongfully using the marks. Now, the athlete could probably prevail in such a situation, but, with the high cost of litigation and little incentive to push forward through years of litigation for a theoretical future benefit, the third party (potential infringer) could prevail almost by default.

The current NCAA system leaves athletes on their own to protect their marks. Even when an athlete is foresighted enough to file an intent to use application, they can be exposed to litigation battles that they likely can neither afford nor want to pursue. And, if litigation does not occur initially, once the athlete leaves the NCAA’s control and pursues development of his or her brand, then litigation from third party users (who potentially have been using the mark in commence for years) can bring suit against the athlete. The system is flawed and could use some fine tuning to focus on the well-being of the athletes—a

83. *See id.*

84. *See id.* at 845.

85. *See id.* at 843 (citing *United Am. Indus., Inc. v. Cumberland*, No. CV-06-1833-PHX-FJM, 2007 U.S. Dist. LEXIS 894, 2007 WL 38279 at *2 (D. Ariz. Jan. 5, 2007)).

86. *See id.* at 847.

87. The roles in *Young* are reversed for this hypothetical scenario, but the main idea persists.

system where the NCAA actively aids its athletes throughout this process instead of ignoring their rights to their own marks.

V. PROPOSED SOLUTIONS

A. *Use in Commerce Basis*

As alluded to above,⁸⁸ the primary issue arising under the use in commerce basis involves the inability for collegiate athletes to receive payment or a promise of payment while maintaining eligibility. Collegiate athletes would then not be able to satisfy the use in commerce requirement as they could not introduce their mark into commerce independently. Although the payment problem deserves its own discussion, our focus will be on how a collegiate athlete could have their mark in use in commerce while remaining eligible by not violating any NCAA rules. Furthermore, the NCAA has yet to state its stance on collegiate athletes applying for federal trademark registration. A proposed solution, which would allow application on a use in commerce basis, involves a nonprofit organization, a collegiate athlete, and a licensing agreement.

A nonprofit organization can surely benefit from the advantages of federal trademark registration. Nonprofits can apply for and have received registration for their marks.⁸⁹ Nonprofit activity falls into the Lanham Act's definitions of commerce, because Congress has already proven its jurisdiction over nonprofits by claiming prerogative to grant the benefit of nonprofit status over the organizations.⁹⁰ Nonprofits that use trademarks in connection with a good or service may acquire ownership rights with evidence of competition.⁹¹

The next actor in this scenario is the collegiate athlete looking to satisfy the use in commerce requirement. Considerations to keep in mind while discussing a collegiate athlete's role in this route to registration primarily include the proscription on receipt of payment or promises of payment in the future. Therefore, the end result of this scenario will not involve any present monetary gain or a promise for pay.

88. See *supra* Part III.A.

89. See, e.g., PEER CONNECTIONS, Registration No. 4,804,033; BRIDGING THE GAP, Registration No. 4,587,793; THIS IS SCOUTING, Registration No. 4,742,246; and BE PREPARED, Registration No. 4,811,796.

90. See IRC § 501 (2012), as amended by P. L. 114-113; see Karl Emerson, *Who Should Regulate Nonprofits?*, ASS'N OF FUNDRAISING PROFS., http://www.afpnet.org/Publications/Article_Detail.cfm?ItemNumber=852. (last visited Oct. 25, 2015).

91. See *generally* *Planetary Motion, Inc. v. Techsplosion, Inc.*, 261 F.3d 1188, 1199 (11th Cir. 2001) (the court was speaking about eleemosynary individuals, but the same idea can be applied towards eleemosynary organizations).

The final actor is the hypothetical licensing agreement between the nonprofit and the collegiate athlete. Under this proposal, the collegiate athlete would license his or her marks to a nonprofit as an act of charity, expecting nor accepting any remuneration in exchange for the right to use the mark. The nonprofit could then use these marks in their fundraising efforts. Since nonprofits can register their marks with the USPTO, then, conceivably, their use of a collegiate athlete's mark could constitute use to satisfy the use in commerce requirement. "Years of precedent make it very clear that proper use of a mark by a trademark owner's licensee or related company constitutes 'use' of that mark attributable to the trademark owner."⁹² This attribution of the nonprofit's (licensee) use in commerce is akin to the use in commerce of a related company. For this to work, the collegiate athlete would need to file a trademark application and license the mark to the nonprofit, as the "related companies" doctrine only applies to registered marks or applied for marks.⁹³ A collegiate athlete would also be required to maintain sufficient control over the nonprofit's use of his or her mark.

For this scenario to work, the nonprofit must fall within the Lanham Act's definition of a related company. A "related company" is "any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used."⁹⁴ The collegiate athlete needs to exercise control over the nonprofit's use of the mark, but not over the nonprofit's broader actions.⁹⁵ Whether the collegiate athlete exhibits enough control is decided on a factual basis by tribunals.⁹⁶ Circuit courts evaluating the sufficiency of control have differed on the requisite amount of control necessary.⁹⁷ The concern within this proposal revolves around whether the license arrangement could be considered a naked licensing, which may lead to abandonment.⁹⁸ With the proper exercise of control over the nonprofit, a collegiate athlete then would succeed in receiving registration of his or her mark.

92. *Quality Candy Shoppes/Buddy Squirrel of Wisconsin, Inc. v. Grande Foods*, 90 U.S.P.Q.2d (BNA) 1393 (T.T.A.B. 2007).

93. *See* 2 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 6.04(2)(b)(i) (2015).

94. 15 U.S.C. § 1127 (2012).

95. 2 GILSON ON TRADEMARKS, *supra* note 93, at §6.04(2)(b)(iii); *Estate of Coll-Monge v. Inner Peace Movement*, 524 F.3d 1341, 1348 (D.C. Cir. 2008).

96. 2 GILSON ON TRADEMARKS, *supra* note 93, at §6.04(4).

97. *Id.* §6.04(4)(b).

98. *See* 1 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 3.05(9) (2015).

B. Intent to Use Basis

Under this proposal, the collegiate athlete applies on an intent to use basis for his or her marks. The NCAA has already shown that it will not stand in the way of an athlete seeking to protect his or her brand—allowing unpaid collegiate athletes to prevent others from using their marks.⁹⁹ However, the NCAA does not have a clearly articulated stance on collegiate athletes applying for trademark registration on an intent to use basis. The collegiate athlete runs the risk that his or her actions will cross some imaginary line, set up by the NCAA, resulting in ineligibility. So, the NCAA’s acquiescence with collegiate athletes fighting to protect the use of their marks does not line up well with their strong stance against an athlete profiting.

In her article, Christie Cho points out many excellent reasons as to why the intent to use application works within the current NCAA system.¹⁰⁰ Cho concludes that the Manziel “loophole” suggests a new solution to the issue of protecting collegiate athletes’ rights that is compatible with amateurism.¹⁰¹ Furthermore, Cho acknowledges that trademark rights will become ever more important and vital if the NCAA were to adopt a pay-for-play or the Olympic Model.¹⁰² Cho’s conclusion that continuing to utilize the intent to use basis recognizes collegiate athletes’ intellectual property rights as students and future professional athletes.¹⁰³ However, the ability to apply should not be so limited, as seen in the issues presented *infra* in Part III.B.

Cho’s article illustrates and exposes one possible method to working trademark law into the current NCAA system. However, the ultimate issues still arise by following the status quo. The assumption that collegiate athletes can wait until they enter professional athletics to profit off their marks definitely works for the high-profile, Manziel-type athletes (given that they are as proactive about seeking trademark protection as Manziel), but the number of collegiate athletes entering professional sports is very low.¹⁰⁴ Under the current NCAA system, this solution works well. Alternatively, the NCAA system could adjust itself for the benefit of collegiate athletes.

99. As evidenced in the NCAA’s stance with Johnny Manziel. *See generally* Clay Travis, *Johnny Manziel Opens Massive Loophole in Paying Players Rule*, FOX SPORTS (Feb. 25, 2013), <http://www.foxsports.com/college-football/outkick-the-coverage/johnny-manziel-opens-massive-loophole-in-paying-players-rule-022513>.

100. *See* Cho, *supra* note 48.

101. *See id.* at 84.

102. *See id.* at 83.

103. *See id.* at 85.

104. *See Probability of Competing In Sports Beyond High School*, NCAA, <http://www.ncaa.org/about/resources/research/probability-competing-beyond-high-school> (last visited Mar. 26, 2015).

C. Olympic Model

In his comment, Arash Afshar argues that the Olympic Model serves as a sufficient solution to affording collegiate athletes their rights of publicity within the amateurism system.¹⁰⁵ Afshar draws comparisons between the historic Olympic amateurism model and that of the present NCAA.¹⁰⁶ The premise of which contemplates that the NCAA should be able to do the same, with similar results, because the Olympics survived affording competitors their intellectual property rights.¹⁰⁷ Furthermore, Afshar concludes that the Olympic Model can coexist with NCAA amateurism.¹⁰⁸

The comparisons between the Olympics and the NCAA are stark and enlightening. Both systems strive for a system based on amateurism. One, the Olympics, allows competitors to obtain endorsements (and get paid for them), while, on the other hand, the NCAA would see this as a violation of its bylaws.¹⁰⁹ The Olympic Model serves as a good solution to the restrictions placed on a collegiate athlete in exercising his or her intellectual property rights. Under such a change, collegiate athletes would be able to use their marks in commerce and have the money to defend their marks against unauthorized users. More than likely, endorsement deals and licensing would be the primary route that collegiate athletes would benefit from being allowed to fully utilize their marks.

One could imagine the scenario where, after national signing day, graduating high school seniors become bombarded with offers from potential agents and companies seeking their endorsement. As such, the NCAA would likely want to offer protection to collegiate athletes from this bombardment. Additionally, one could imagine that agents going after eighteen year olds, who have not established themselves as collegiate athletes yet, could conceivably seek to benefit from these young men and women (perhaps by taking large cuts from any potential profits). The NCAA reasonably should desire to protect collegiate athletes from such a situation. Another possible solution would be for the NCAA to take a proactive role in aiding collegiate athletes through the processes of application, licensing, and protecting their marks.

105. See Arash Afshar, *Collegiate Athletes: The Conflict Between NCAA Amateurism and a Student Athlete's Right of Publicity*, 51 WILLAMETTE L. REV. 101 (2014).

106. See *id.* at 111.

107. See *id.* at 112 (The argument that the rule changes would destroy the Olympic games was proved wrong by its increased popularity).

108. See *id.* at 133.

109. See NCAA MANUAL, *supra* note 2, art. 12.5.

D. An NCAA-Created Body

If the NCAA wishes to maintain the principle of amateurism in college sports, which it reasonably may, then one ideal solution involves a hands-on approach by the NCAA. Under this proposal, the NCAA could set up a body that would serve to promote, encourage, and aid collegiate athletes in applying for and defending their marks—and, ideally, the broader right to publicity. Although some view the ultimate goal as allowing collegiate athletes a claim to their publicity rights, the focus in the present should rest on trademark protection.¹¹⁰ First, trademark law is fairly settled, which would allow for an immediate impact on players' rights, while publicity rights are less definite.¹¹¹ Second, providing for and encouraging the protection of collegiate athletes' marks is an excellent starting point to build upon. This proposal within the NCAA involves an agent-like body and needs a system of distributing the generated income.

The NCAA would become more of a partner—working with collegiate athletes to increase their brand's worth, primarily through trademark law. In this proposed system, the NCAA's newly created body could serve as the athletes' legal representative and agent working to file trademark applications and develop a plan of action to use the marks in commerce. This body would work with the athletes to promote their marks, find third party licensees, and defend against unauthorized use. Remember that these collegiate athletes are young men and women who presumably do not understand their intellectual property rights—they need the representation. The NCAA, considering its present state, serves as the best entity to aid collegiate athletes in this manner.

Now, with the promotion and use of marks in commerce, comes another issue—what to do with the money that is generated. We could envision why the NCAA would prefer the money not go straight to the collegiate athlete. This hesitation could exist for many possible reasons: avoiding income disparity between superstars and their teammates; keeping the ideals of student-first, athlete-second; or providing for fair and collegial competition. In this regard, the NCAA could set up trust funds for the collegiate athletes utilizing its intellectual property services. The NCAA could structure these trusts to distribute income as it sees fit—to cover educational expenses, room and board, travel home, etc.—while withdrawing administrative and legal fees. Although tax issues may arise, the consequences of those are beyond the scope of this comment.

110. See generally Cho, *supra* note 48.

111. See *id.* at 84.

VI. CONCLUSION

This comment serves to shed light on a very basic issue within the NCAA system—tough restrictions on the ability for collegiate athletes to promote and better protect their marks. Proposals for applying under the use in commerce and intent to use bases reflect the persistent amateurism culture in the NCAA. These proposals look at methods, which are consistent with the current NCAA system, to promote trademark registration by collegiate athletes. Proposals for an Olympic Model or an NCAA-created body would be undertaken only after considerable thought on the part of the NCAA as changes that would allow collegiate athletes broader intellectual property rights would undeniably affect its current amateurism stance. Operating under the current, outdated system, however, harms collegiate athletes. Change could occur within the NCAA's system to benefit collegiate athletes, while preserving the general ideals of amateurism. The Olympic Model could serve this purpose well, but reservations about exposing young men and women to the open market could prevent the NCAA from adopting such a model. The NCAA creating a body to serve as collegiate athletes' legal representatives and agents could be an effective solution. It would cover any reservations the NCAA may have about the Olympic Model.

As for the present, collegiate athletes should start furthering protection of their marks through federal trademark registration. They could conceivably apply and register their trademarks on a use in commerce basis by following a proposal as described in this comment. Alternatively, they could apply on an intent to use basis, as already performed by recent collegiate athletes. Under this approach, collegiate athletes can take steps to further protect their trademark rights, but remember that this proposal comes with potential problems. Today, collegiate athletes should start applying for federal trademark registration to advance their intellectual property rights.

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