Sports Litigation Alert

Reprinted from Sports Litigation Alert, Volume 9, Issue 15, August 24, 2012. Copyright © 2012 Hackney Publications.

Competing Before the PTO: Four Things a Professional Athlete Should Consider When Seeking a Federal Trademark Registration

By Ryan S. Hilbert

Today's athletes have become increasingly proactive and savvy about ways in which they can and should protect their trademarks. As an example, shortly after former University of North Carolina basketball star Harrison Barnes became the seventh pick in the 2012 NBA Draft, he stated that he had already given tremendous thought to what his "brand" would be and even had an artist friend design his logo. As it turns out, Barnes had even gone so far as to file a trademark application with the U.S. Patent and Trademark Office ("USPTO") for the word mark THE BLACK FALCON – his nickname at UNC – on August 19, 2011, months before his college career was over and almost a full year before he was selected to play in the NBA.

Of course Barnes is not alone. Right around the time Barnes was discussing his brand aspirations, another former college basketball standout and the top pick of the 2012 NBA Draft, Anthony Davis, was making headlines for a number of trademark applications he had filed for words based on his connected eyebrows, or "unibrow." At the time, Davis told CNBC sports business reporter Darren Rovell that he filed the applications – which included marks like RAISE THE BROW, FEAR THE BROW and BROW DOWN – because he did not want anyone "to try to grow a unibrow because of [Davis] and then try to make money off of it." Now, because of his foresight, Davis is in a position in which he can soon obtain a number trademark registrations for those words or phrases uniquely associated with him, despite the fact that he has yet to play an official NBA game.

With each passing year, it seems like more and more professional athletes are doing the same thing Barnes and Davis are doing – seeking trademark protection for those words, phrases or designs with which they have become associated. Indeed, numerous professional athletes from a variety of sports have already obtained or are seeking trademark registrations from the USPTO, including NBA phenomenon Jeremy Lin, (LINSANITY), former Denver Bronco and current New York Jet quarterback Tim Tebow (TEBOWING), current New York Jet cornerback Darelle Revis (REVIS ISLAND), and former NBA great Shaquille O'Neal (SHAQTACULAR), among others. To the extent a prospective or established professional athlete wishes to join these ranks, there are four things he or she should keep in mind when considering whether, when and how to obtain a federal trademark registration.

1. **Be Proactive**. In today's fast-paced world, more and more athletes are filing applications with the USPTO only to find out that some opportunistic fan or business associate has already beaten them to the punch. There are numerous examples in which this has

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occurred, including Baltimore Ravens linebacker Terrell Suggs, who filed a number of applications for BALL SO HARD UNIVERSITY only to find out that someone had filed before him; Jeremy Lin, who filed an application for LINSANITY only to find himself third in line; and Tim Tebow, who, after finally getting around to filing applications for TEBOWING, was surprised to discover there were already two pending applications in front of him.

Even well-known San Francisco Giants relief pitcher Brian Wilson is familiar with this. By the time Wilson filed an application for FEAR THE BEARD – which is a reference to the lengthy, dark-black beard Wilson famously grew during the Giants' improbable run to winning the 2010 World Series – he discovered that Duck Commander Inc., the company that is the subject of the A&E reality series *Duck Dynasty*, had already filed for that mark seven days earlier.

Even though, as discussed below, there are ways in which these athletes may be able to get around these prior applications, the better approach is to try and preempt such filings before they occur. The best way to do this is to be proactive and file as early as possible.

2. **Think Broadly**. When filing a trademark application, it is generally a good idea to seek protection for not only those goods and services with which one is *currently* using the mark, but also for those goods and services with which one *intends* to use the mark in the future. Section 1(b) of the Lanham Act expressly allows for this possibility so long as one has a "bona fide" intent to use a mark in connection with certain goods and services.

   The benefit to filing an "intent-to-use" (ITU) application under Section 1(b) is that it effectively holds one's place in line. Eventually one will have to use the mark in commerce in order to obtain a federal trademark registration. However, once an ITU application proceeds to registration, one receives constructive nationwide rights dating back to the date the application was filed, regardless of when the mark was ultimately used in commerce.

   A perfect example of this is Harrison Barnes. As explained above, Barnes filed an ITU application for the word mark THE BLACK FALCON on August 19, 2011, almost a full year before he embarked on his professional career. Now that Barnes' college career is over and the NCAA bylaws no longer preclude Barnes from using his name and likeness for commercial purposes, he can commence use of his mark in commerce and obtain a registration. Once he does so, Barnes will obtain a fully enforceable federal trademark registration with rights dating back to August 19, 2011 – *i.e.*, the date the application was filed. The fact that Barnes was an amateur at the time he filed, or that he could not and did not commence use of the mark until months later, is immaterial.

3. **Think Creatively**. Even though it is possible for one to obtain trademark rights in his or her name standing alone, the better option is to seek protection for those novel words or phrases an athlete has coined or with which an athlete is associated. In the examples given above, for instance, Anthony Davis is seeking trademark protection for a number of phrases related to his unibrow; Brian Wilson is seeking protection for a phrase related to his beard; and Harrison Barnes is seeking protection for THE BLACK FALCON, his nickname in college. Other unique marks include THE BIG UNIT, which was the nickname of former MLB pitcher Randy Johnson; THAT'S A CLOWN QUESTION, BRO, a phrase made popular just this year by Washington Nationals rookie Bryce Harper; and I LOVE ME SOME ME, which is owned by former NFL player Terrell Owens.

   It is also a good idea for a professional athlete to consider a design element with which he or she may or can be associated. As an example, in addition to seeking protection for the word mark THE BLACK FALCON, Harrison Barnes has stated that he already has an accompanying logo consisting of

Barnes' initials "standing side-by-side, with wings spreading off the 'B' in homage to Barnes' nickname." Generally speaking, such design marks, like the novel words or phrases discussed above, are easier to obtain and can offer a greater scope of protection to the rights holder.

4. **Be Persistent**. No matter how proactive or creative a professional athlete may be, there is always the risk that someone will beat them to the USPTO. Thankfully, all is not lost even in such situations.

   It is well known that a mark that falsely suggests a connection with a person, living or dead, is not entitled to registration under Section 2(a) of the Lanham Act. Over the years, celebrities and athletes have been able to use this provision in order to successfully challenge others' attempts to register words or phrases with which those celebrities or athletes have become associated. As an example, in *Buffett v. Chi-Chi's Inc.*, 226 U.S.P.Q. 428 (TTAB 1985), singer Jimmy Buffet successfully contested a restaurant's application to register the mark "Margaritaville" based on evidence that the public associated that term, which was the title of Buffett's most famous song, with Buffett. Similarly, earlier this year, Tim Tebow successfully contested prior applications for TEBOWING on the ground that they falsely suggested a connection to Tebow.

   Filing a challenge under Section 2(a) is but one of the options a sophisticated trademark attorney has at his or her disposal. Depending on the timing and nature of a prior registration, another option is to enter into some form of agreement under which a professional athlete agrees to coexist in the USPTO and/or the marketplace. Regardless, so long as a professional athlete is willing to be persistent, there is a good chance he or she will eventually be rewarded with a valuable and enforceable registration.

Owning a federal trademark registration can be extremely valuable to a professional athlete. Not only can an athlete enforce a registration in order to regulate how those words or slogans with which he or she is associated are used, one can also generate tremendous revenue by licensing the rights conferred by the registration to others. Of course, as the above examples demonstrate, obtaining a federal trademark registration is not always simple and straightforward, especially for a professional athlete. But one thing is certain: by heeding the four suggestions raised above, a professional athlete can improve his or her chances of obtaining a federal trademark registration in the quickest and most cost-effective way possible.