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Protecting Johnny Football®: Trademark Registration for Collegiate Athletes

Christie Cho

Northwestern University School of Law

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N O R T H W E S T E R N
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**Protecting Johnny Football®: Trademark
Registration for Collegiate Athletes**

Christie Cho



Protecting Johnny Football®: Trademark Registration for Collegiate Athletes

By Christie Cho*

While the issue of publicity rights for college athletes has intensified, “Johnny Football” illustrates a different property interest for student athletes, one that is independent from the rights of the NCAA. Trademark protection for symbols, names, and other marks affiliated with student-athletes provides an intriguing solution, especially at a time when the future of amateur college sports is uncertain. Furthermore, the availability of the “intent to use” application makes trademark registration a viable means of protecting intellectual property interests of student-athletes. This Comment uses “Johnny Football” as an example to illustrate this potential game-changer in defining and protecting the rights of student-athletes, regardless of the future of amateurism in collegiate athletics.

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* Candidate for Juris Doctor, 2015, Northwestern University School of Law. I would like to thank my family and Mark for their constant love and support.

INTRODUCTION

¶1 In 2012, Johnny Manziel became the first freshman to win the Heisman Trophy, adding to his growing notoriety as one of the most exciting quarterbacks in college football. As media scrutiny and expectations intensified, Johnny Manziel, his family, and his university sought to trademark the nickname that had become synonymous with his exciting, improvised style of play: “Johnny Football.”¹ When Eric Vaughan began manufacturing t-shirts with the phrase “Keep Calm and Johnny Football,” the family sued and sought an injunction as well as damages.² In a surprising twist, the National Collegiate Athletic Association (NCAA) ruled that Manziel and his family could keep any financial awards from the lawsuit, even while Manziel remained a collegiate athlete.

¶2 In addition to his on-field accomplishments, Johnny Manziel pioneered—even if inadvertently—a way for a student-athlete to profit from his fame with the blessing of the NCAA. However, while the issue of publicity rights for college athletes has intensified, “Johnny Football” actually illustrates a different property interest for student-athletes, one that is independent from the rights of the NCAA. Potential trademark protection for symbols, nicknames, and other marks affiliated with student-athletes is an intriguing concept, especially at a time when the future of amateur college sports is uncertain. This Comment analyzes the scope of this property interest and suggests trademark registration, specifically through the “intent-to-use” application, as a way to protect the individual property interests of student-athletes.

¶3 Part I introduces Johnny Manziel, the “Johnny Football” trademark, and his lawsuit against a t-shirt manufacturer for trademark infringement. Part II puts the Johnny Football trademark issue in context, analyzing the emerging and game-changing litigation surrounding the right of publicity for student-athletes. Part III distinguishes Johnny Football and the potential for trademark protection for student-athletes from the ongoing controversy surrounding their right of publicity. Part IV examines the various elements and requirements of trademark registration and identifies “intent to use” as a viable means of protecting the intellectual property interests of current student-athletes. Basing trademark registration on the “intent to use” balances the interests of student-athletes as both “amateurs” under NCAA regulation and future professional athletes with valuable personal brands. Finally, this Comment examines the implications of this trademark approach to college sports in general, especially in light of the current litigation about the right of publicity.

I. THE RISE OF JOHNNY FOOTBALL

¶4 Johnny Manziel had not yet completed his freshman season as the quarterback for the Texas A&M Aggies (Texas A&M) when the university recognized the potential issues arising from his increasing fame. In addition to sending numerous cease-and-desist letters to those selling unauthorized “Johnny Football” merchandise, the university recommended that Manziel’s family apply for trademark protection for the “Johnny

¹ Darren Rovell, *A&M, Family Covet “Johnny Football,”* ESPN (Nov. 11, 2012), http://espn.go.com/college-football/story/_id/8619087/johnny-manziel-family-trademark-johnny-football.

² Complaint, *JMAN2 Enters. v. Vaughan*, No. 6:13-cv-00158-MHS (E.D. Tex. Feb. 15, 2013).

Football” nickname.³ While collaborating with the Manziel family to trademark his nickname, Texas A&M officials cited their common goal of preventing unauthorized use of “Johnny Football,” which could jeopardize Johnny Manziel’s eligibility as an amateur college athlete.⁴ On February 2, 2013, JMAN2 Enterprises, LLC, a company registered to Johnny Manziel’s family, filed a trademark application for “Johnny Football.”⁵ On December 31, 2013, the Trademark Office suspended the application due to previously submitted and still pending applications for “Johnny Football,”⁶ and for the existence of similar marks, such as “Johnny Basketball” and “Johnny Baseball.”⁷

¶15 Meanwhile, Eric Vaughan (and others) began selling merchandise bearing the words “Johnny Football.” Vaughan did not stop manufacturing “Keep Calm and Johnny Football” t-shirts, even after both Manziel and Texas A&M sent cease-and-desist letters.⁸ Eventually, JMAN2 Enterprises, the same entity that applied to trademark “Johnny Football,” filed a lawsuit against Vaughan for trademark infringement and unfair competition.⁹ On March 1, 2013, JMAN2 Enterprises also filed suit against Kevin Doolan, whose company—Cubby Tees—similarly manufactured “Johnny Football” t-shirts.¹⁰ In both cases, Manziel sought injunctive relief as well as compensatory damages, but ultimately settled with both Vaughan and Doolan.¹¹

¶16 The NCAA ruled that Manziel could keep any financial earnings from the lawsuits without losing his status as an amateur athlete.¹² This decision sparked accusations of an NCAA-created “loophole.” Could college football boosters now intentionally infringe on athletes’ trademarks, be sued, and essentially pay the student in “legal” damages?¹³ Soon after the decision, the NCAA clarified its stance by specifically exclaiming any such “orchestrated event between a student-athlete and a booster” as a violation.¹⁴ Moreover, the NCAA noted that even if Manziel’s trademark application were accepted *and* he

³ Allen Reed, *Manziel Mania Prompts Quarterback’s Family to Trademark “Johnny Football,”* THE EAGLE (Nov. 17, 2012), http://www.theeagle.com/news/local/article_85bb1ade-1e0e-5a26-a492-d1d598b87e29.html.

⁴ *Id.*

⁵ U.S. Trademark Application Serial No. 85,839,336 (filed Feb. 2, 2013).

⁶ The Kenneth R. Reynolds Family Investments filed for the “Johnny Football” mark three months before JMAN2 Enterprises’ application. U.S. Trademark Application Serial No. 85,769,563 (filed Nov. 1, 2012). However, the Patent and Trademark Office sent a final office action to the Kenneth R. Reynolds Family Investments refusing registration because the “Johnny Football” referred to a living person and the applicant did not have the written consent of the individual to which “Johnny Football” refers. Office Action, U.S. Trademark Application Serial No. 85,769,563 (issued Mar. 20, 2014).

⁷ U.S. Trademark Application Serial No. 85,791,489 (filed Nov. 30, 2012); U.S. Trademark Application Serial No. 85,791,517 (filed Nov. 30, 2012).

⁸ Complaint, JMAN2 Enters. v. Vaughan, No. 6:13-cv-00158-MHS (E.D. Tex. Feb. 15, 2013).

⁹ *Id.*

¹⁰ Complaint, JMAN2 Enters. v. Doolan, No. 6:13-cv-00215 (E.D. Tex. Mar. 1, 2013).

¹¹ Jeff Mosier, *Johnny Manziel’s Family Settle T-Shirt Lawsuit*, DALL. NEWS (Nov. 1, 2013), <http://the-scoopblog.dallasnews.com/2013/11/johnny-manziels-family-settle-t-shirt-lawsuit.html/>.

¹² Darren Rovell, *Suit Claims Nickname Infringement*, ESPN (Feb. 23, 2013), http://espn.go.com/college-football/story/_/id/8977054/lawsuit-filed-claims-johnny-football-infringement.

¹³ See Ira Boudway, *Johnny Football and the NCAA Loophole*, BUS. WK. (Feb. 27, 2013), <http://www.businessweek.com/articles/2013-02-27/johnny-football-and-the-ncaa-loophole>; see also Mark Helm, *Did Johnny Manziel’s Lawsuit Create a Loophole to Pay Athletes?*, AL.COM (Feb. 25, 2013), http://www.al.com/sports/index.ssf/2013/02/did_johnny_manziels_lawsuit_cr.html.

¹⁴ Andy Staples, *NCAA Rules Clarification Closes Johnny Football “Loophole,”* SPORTS ILLUSTRATED (Feb. 26, 2013), <http://sportsillustrated.cnn.com/college-football/news/20130226/johnny-manziel-ncaa-loophole>.

prevailed in court, neither he nor Texas A&M could directly profit from his trademark as long as he remained a student-athlete. Johnny Manziel eventually declared for the 2014 National Football League (NFL) Draft, where the Cleveland Browns selected him in the first round.¹⁵

II. THE NCAA'S STRUGGLE TO BALANCE AMATEURISM AND PUBLICITY RIGHTS OF STUDENT-ATHLETES

¶17 During a time already fraught with tension between the NCAA and student-athletes,¹⁶ Johnny Manziel intensified the growing discourse about the rights and exploitation of college athletes. Shortly before the start of his much-anticipated sophomore season, the NCAA began to investigate allegations that Manziel had accepted a five-figure sum of money in exchange for his autographs, which would clearly violate NCAA policies.¹⁷ While acknowledging a lack of evidence that Manziel received compensation for autographs, the NCAA nonetheless suspended him for half of a game, asserting that Manziel should have known that numerous autographs in one signing session might be sold commercially.¹⁸ In doing so, the NCAA affirmed its stance that student-athletes must not only abstain from profiting from their fame, but must also take affirmative measures to prevent others from commercializing on their fame.¹⁹

¶18 For many, this investigation highlighted the absurdity and hypocrisy of the NCAA's stance. Some suggested that the pending lawsuit against the NCAA by former student-athletes influenced the NCAA's decision.²⁰ Others more bluntly criticized the rationale behind the NCAA's rule against paying college athletes, especially when Texas A&M could raise tens of thousands of dollars from Manziel's presence at a school fundraiser.²¹ These critics argue that even if Manziel did sell his autographs, any profit he would have made would be miniscule compared to the money that the NCAA, Texas

¹⁵ Ken Belson, *Johnny Manziel to Start Season as Browns' Backup Quarterback*, N.Y. TIMES (Aug. 20, 2014), <http://www.nytimes.com/2014/08/21/sports/football/browns-to-start-brian-hoyer-over-johnny-manziel.html>.

¹⁶ In yet another escalation of the conflict between the NCAA and student-athletes, football players at Northwestern University filed a petition with the National Labor Relations Board to unionize. The NCAA responded that such efforts undermined the educational mission of college sports. Zac Ellis, *Northwestern Football Players Seek to Unionize: What Does the Development Mean?*, SPORTS ILLUSTRATED (Jan. 28, 2014), <http://college-football.si.com/2014/01/28/northwestern-football-kain-colter-labor-union/>.

¹⁷ See Daniel Uthman, *Report: Johnny Manziel Accepted Money for Autographs*, USA TODAY (Aug. 5, 2013), <http://www.usatoday.com/story/sports/ncaaf/sec/2013/08/04/texas-am-aggies-johnny-manziel-money-for-autographs/2617413/>.

¹⁸ See George Schroeder, "No Evidence" Manziel Took Money for Autographs, A&M Says, USA TODAY (Aug. 28, 2013), <http://www.usatoday.com/story/sports/ncaaf/sec/2013/08/28/johnny-manziel-suspended-for-first-half-of-texas-am-opener-vs-rice/2723767/>.

¹⁹ See *infra* text accompanying notes 25 and 26.

²⁰ See, e.g., Alicia Jessop, *A Different Take on Johnny Manziel's Half-Game Suspension*, FORBES (Aug. 31, 2013), <http://www.forbes.com/sites/aliciajessop/2013/08/31/a-different-take-on-johnny-manziels-half-game-suspension/> ("[O]ne has to question whether the light penalty imposed against Manziel . . . was an NCAA maneuver to pad itself against future personality rights lawsuits.").

²¹ Texas A&M sold seats at a table with Manziel at a fundraising banquet. Dan Wetzel, *NCAA Probe of Johnny Manziel Raises Questions About Amateurism Rules*, YAHOO! SPORTS (Aug. 4, 2013), <http://sports.yahoo.com/news/ncaaf--ncaa-probe-of-johnny-manziel-raises-questions-about-amateurism-rules-230350855.html> ("The investigation into Manziel . . . shines an even brighter spotlight on the NCAA's system of 'amateurism' that is under significant attack both legally and politically.").

A&M, and their licensing partners make from student-athletes like Johnny Manziel.²² Simply stated, many believe that it is the sheer amount of money at stake in college sports that “makes the continued ‘amateur’ status of the players so untenable.”²³

A. NCAA Bylaws

¶9 Section 12 of the NCAA Bylaws codifies amateurism in college sports. A student-athlete is ineligible 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 of a commercial product.”²⁴ Furthermore, the NCAA requires student-athletes to *proactively* prevent unauthorized commercial use of his or her name:

If a student-athlete’s name or picture appears on commercial items (e.g., T-shirts, sweatshirts . . .) or is used to promote a commercial product sold by an individual or agency without the student-athlete’s knowledge or permission, the student-athlete (or the institution acting on behalf of the student-athlete) is required to take steps to stop such an activity in order to retain his or her eligibility for intercollegiate athletics.²⁵

This provision has recently come under fire for placing too heavy a burden on student-athletes, who not only cannot profit from their fame, but must also ensure that others refrain from doing so as well.²⁶ As long as student-athletes have this affirmative duty to prevent commercial use of their images, however, they have an interest in seeking protection for such marketable aspects of their identities.

¶10 Meanwhile, the NCAA, the Bowl Championship Series (BCS), Texas A&M, their partner businesses, and sports-news outlets such as ESPN can profit from the student-athlete’s name because of the Student-Athlete Statement (the Statement). By signing the Statement, the student-athlete not only affirms that he meets the amateur-status requirement, but also acknowledges the following: “You authorize the NCAA . . . to use your name or picture in accordance with NCAA Bylaw 12.5, including to promote NCAA championships or other NCAA events, activities or programs.”²⁷ This Statement essentially gives the NCAA exclusive control over the name and image of student-athletes, which the NCAA can then license to its member organizations and business

²² *Id.*

²³ Joe Nocera, Op-Ed., *Johnny Football’s Payday*, N.Y. TIMES (Sept. 6, 2013), <http://www.nytimes.com/2013/09/07/opinion/nocera-johnny-football-payday.html>. *But see* Sally Jenkins, *NCAA Touts Amateurism Rules over Open Market, but Which Is More Corrupt?*, WASH. POST (Sept. 20, 2013), http://www.washingtonpost.com/sports/colleges/ncaa-touts-amateurism-rules-over-open-market-but-which-is-more-corrupt/2013/09/20/511e18ea-2204-11e3-a358-1144dee636dd_story.html (predicting some of the “awful consequence[s] of an open market” replacing the NCAA’s amateurism model).

²⁴ ACADEMIC & MEMBERSHIP AFFAIRS STAFF, NAT’L COLLEGIATE ATHLETIC ASS’N, NCAA DIVISION I MANUAL § 12.5.2.1 (2013) [hereinafter NCAA MANUAL].

²⁵ *Id.* § 12.5.2.2.

²⁶ *See* Complaint, *O’ Bannon v. Nat’l Collegiate Athletic Ass’n*, No. 4:2009cv03329 (N.D. Cal. July 21, 2009); *see also* Dan Wetzel, *Johnny Manziel’s Suspension Exposes Ridiculousness of NCAA’s Double Standards*, YAHOO! SPORTS (Aug. 28, 2013), <http://sports.yahoo.com/news/ncaaf--johnny-manziel-s-suspension-exposes-ridiculousness-of-ncaa-s-double-standards-012517037.html>.

²⁷ FORM 13-3A: STUDENT ATHLETE STATEMENT – NCAA DIVISION I (2013) [hereinafter STUDENT-ATHLETE STATEMENT] (otherwise known as Form 08-3a).

partners. Citing the Statement's far-reaching implications, some critics argue that this agreement between the NCAA and student-athletes is an unenforceable contract.²⁸

B. NCAA's Stance on Amateurism

¶11 Despite the lucrative partnerships and television contracts that the right to student-athletes' names and images has brought to the NCAA and its member institutions, the NCAA maintains that it is committed to amateurism.²⁹ Until recently, courts generally deferred to the NCAA's authority to define and determine amateur status of student-athletes.³⁰ However, the NCAA's stance on amateurism is increasingly difficult to defend in light of the professional level of marketing and revenue generated for and by college football and basketball.³¹ Salaries of coaches, athletic directors, and other administrators have increased dramatically.³² Annually, the BCS receives more than \$150 million for broadcast rights to BCS bowl games,³³ while the NCAA gets \$700 million for the rights to the "March Madness" tournament.³⁴ Moreover, college athletic departments directly feature college athletes in advertising campaigns, some of which air during national broadcasts of college football games.

¶12 Meanwhile, student-athletes, often living in poverty,³⁵ are prohibited from accepting extra benefits, even though athletic scholarships do not cover the full cost of

²⁸ See Kristal S. Stippich & Kadence A. Otto, *Carrying a Good Joke Too Far? An Analysis of the Enforceability of Student-Athlete Consent to Use of Name & Likeness*, 20 J. LEGAL ASPECTS OF SPORT 151, 172 (2010) (arguing that the NCAA's Student-Athlete Statement is unenforceable because it is an adhesion contract which student-athletes enter into under duress). *But see* Kendall K. Johnson, *Enforceable Fair and Square: The Right of Publicity, Unconscionability, and NCAA Student-Athlete Contracts*, 19 SPORTS LAW. J. 1, 47–48 (2012) (arguing that the Student-Athlete Statement is enforceable because it is not the role of courts to ensure contracts are fair).

²⁹ *Amateurism*, NCAA, <http://www.ncaa.org/amateurism> (last visited Aug. 27, 2014); see Zachary Stauffer, *NCAA President Defends Amateurism in College Sports*, PBS FRONTLINE (June 19, 2014, 11:11 PM), <http://www.pbs.org/wgbh/pages/frontline/sports/money-and-march-madness/ncaa-president-defends-amateurism-in-college-sports/>.

³⁰ See Brian Welch, Comment, *Unconscionable Amateurism: How the NCAA Violates Antitrust by Forcing Athletes to Sign Away Their Image Rights*, 44 J. MARSHALL L. REV. 533, 541 (2011) ("[T]he aggregate effect of [*NCAA v.*] *Board of Regents* and the decisions that followed was to allow the notion of amateurism to become a viable defense of justification for any anti-competitive NCAA rules in the face of an antitrust challenge.").

³¹ The 2009 complaint in the *O'Bannon* suit against the NCAA details the various sources of revenue for the NCAA and its member schools, which include jersey sales, media rights to broadcast games, merchandise sales, and rebroadcasts of "classic games." Complaint at 104, *O'Bannon v. Nat'l Collegiate Athletic Ass'n.*, No. 4:2009cv03329 (N.D. Cal. July 21, 2009).

³² *College Football Coaches Salaries Database*, USA TODAY (July 1, 2013, 12:34 PM), <http://www.usatoday.com/story/sports/ncaaf/2012/11/19/ncaa-college-football-head-coach-salary-database/1715543/>.

³³ Chris Smith, *The Money Behind the BCS National Championship*, FORBES (Jan. 7, 2013, 4:09 PM), <http://www.forbes.com/sites/chris-smith/2013/01/07/the-money-behind-the-bcs-national-championship/>.

³⁴ Curtis Eichelberger, *NCAA Play in March Proving Madness Without College Profit*, BLOOMBERG (Mar. 20, 2013, 11:00 PM), <http://www.bloomberg.com/news/2013-03-21/ncaa-play-in-march-proving-just-madness-without-college-windfall.html>.

³⁵ Arian Foster pointed out the injustice of such a system in an interview for an upcoming documentary. After playing in a 100,000-seat stadium, he and his teammates did not have money to buy dinner and their coach bought them some food, technically in violation of NCAA rules. He also recalled seeing his coach's brand new luxury car the next day. Chip Patterson, *Arian Foster: "I Was Getting Money on the Side" at Tennessee*, CBS SPORTS (Sept. 20, 2013, 2:13 PM), <http://www.cbssports.com/collegefootball/eye-on-college-football/23750851/arian-foster-i-was-getting-money-on-the-side-at-tennessee>; see also Gregg Doyel, *Time to Pay College Football Players: Changing Times, Money Say So*, CBS SPORTS (Sept. 25,

attending college and demanding practice schedules preclude collegiate athletes from working even part-time jobs. Worse yet, current and former student-athletes end up with medical bills stemming from athletic injuries.³⁶ The class action lawsuit, led by former basketball player Ed O’Bannon, encapsulates the resulting tension between the NCAA and student-athletes who have made lucrative television and licensing deals possible.³⁷

C. Former Student-Athletes Sue NCAA

¶13 In May 2009, former University of Nebraska quarterback Sam Keller filed a class action lawsuit against Electronic Arts (EA),³⁸ the NCAA, and the Collegiate Licensing Company (CLC) for misappropriating the name and likeness of student-athletes in videogames.³⁹ Shortly thereafter, Ed O’Bannon, who played basketball at the University of California, Los Angeles, brought a class action lawsuit against the NCAA and CLC for antitrust and unjust enrichment claims.⁴⁰ After the two lawsuits were consolidated in March 2010, current student-athletes joined the class action as named plaintiffs.⁴¹

¶14 While EA and CLC settled with the plaintiffs,⁴² the NCAA refused, instead choosing to defend its stance in court,⁴³ leaving a decision with huge implications for college sports to the hands of a single judge.⁴⁴ On August 8, 2014, Judge Claudia Wilken

2013, 9:39 AM), <http://www.cbssports.com/general/writer/gregg-doyel/23838595/its-time-pay-college-football-players-changing-times-money-say-so> (noting drastic changes in “the business of college football,” except in the compensation of players).

³⁶ See Complaint at 169, *O’Bannon v. Nat’l Collegiate Athletic Ass’n*, No. 4:2009cv03329 (N.D. Cal. July 21, 2009) (“[M]any former student-athletes have continuing medical bills and treatments resulting from their participation in intercollegiate athletics . . . [which] can continue long after the conclusion of a student athlete’s collegiate sports career.”).

³⁷ During the 2013 college football season, several players adorned the letters “A.P.U.”—short for “All Players United”—to show their support for the players in the *O’Bannon* lawsuit and to urge for NCAA reform. Chip Patterson, *All Players United Campaign Launched with “APU” on Wrist Tape*, CBS SPORTS (Sept. 21, 2013, 4:46 PM), <http://www.cbssports.com/collegefootball/eye-on-college-football/23769680/all-players-united-campaign-launched-with-apu-on-wrist-tape>.

³⁸ Electronic Arts (EA) makes the NCAA Football, NCAA Basketball, and NCAA March Madness videogames. These games feature digital players with similar physical features, hometowns, and jersey numbers as their real-life counterparts. Moreover, consumers can download and integrate actual college team rosters into the game. See, e.g., GAMEROSTERS, <http://www.gamerosters.com> (last visited Oct. 5, 2014).

³⁹ Complaint at 61, *Keller v. Elec. Arts Inc.*, No. 4:09-cv-01967-CW (N.D. Cal. May 5, 2009).

⁴⁰ Complaint, *O’Bannon v. Nat’l Collegiate Athletics Ass’n*, No. 4:2009cv03329 (N.D. Cal. July 21, 2009).

⁴¹ See Steve Berkowitz, *Judge Will Allow Current Player to Join O’Bannon Suit*, USA TODAY (July 5, 2013, 6:24 PM), <http://www.usatoday.com/story/sports/college/2013/07/05/ed-obannon-ncaa-likeness-lawsuit/2492981/>.

⁴² In the right of publicity cases against EA, courts determined that the use of player likenesses in a videogame did not constitute “transformative use.” *Hart v. Elec. Arts*, 717 F.3d 141, 166 (3d Cir. 2013); *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1271 (9th Cir. 2013) (“[EA’s use] literally recreates Keller in the very setting in which he has achieved renown.”), *aff’g Keller v. Elec. Arts*, No. C 09-1967 CW (Feb. 8, 2010). See also *Players to Receive \$40 Million*, ESPN (Sept. 28, 2013, 9:02 AM), http://espn.go.com/college-football/story/_/id/9731696/ea-sports-clc-settle-lawsuits-40-million-source.

⁴³ Steve Berkowitz, *NCAA Vows to Fight O’Bannon Suit to the Supreme Court*, USA TODAY (Sept. 26, 2013, 3:13 PM), <http://www.usatoday.com/story/sports/ncaab/2013/09/26/ncaa-ed-obannon-ea-sports-lawsuit-supreme-court/2877579/>.

⁴⁴ Jonathan Mahler, *The Lawsuit That Could Bring down the NCAA*, BLOOMBERG (May 2, 2013, 6:00 PM), <http://www.bloomberg.com/news/2013-05-02/the-lawsuit-that-could-bring-down-the-ncaa.html>.

of the Northern District of California ruled in favor of the current and former college athletes, determining that “the challenged NCAA rules unreasonably restrain trade in the market for certain education and athletic opportunities offered by NCAA Division I schools.”⁴⁵ The NCAA could fulfill its goals of providing educational opportunities and promoting intercollegiate competition through less restrictive means, such as by providing a stipend to cover the full cost of attendance or a trust fund to distribute to former collegiate athletes their share of the licensing revenue.⁴⁶ By rejecting the NCAA’s traditional amateurism defense for its anticompetitive practices, Judge Wilken “delivered a decisive and crushing end to the era of amateurism in college athletics.”⁴⁷ Although the NCAA is appealing the decision, reversal seems unlikely.⁴⁸

¶15 This decision highlights the need to clarify the contours of collegiate-athletes’ intellectual property rights, which the athletes may now assert themselves in certain circumstances. Moreover, despite the contentious legal battle, the parties all agree on one thing: student-athletes *do* have an intellectual property interest that is *separable* from that of the NCAA and its member institutions. For example, the NCAA recognizes that certain aspects of a student-athlete’s image belong solely to the student-athlete, and forbids its member schools from selling jerseys or other merchandise bearing the actual names of student-athletes.⁴⁹ Furthermore, the NCAA stopped selling even nameless jerseys through its website, and admitted that it “probably never should have been in the business” of selling player merchandise in the first place.⁵⁰

III. WHY TRADEMARK PROTECTION?

¶16 If Judge Wilken’s decision in *O’Bannon* undermined the NCAA’s case for amateurism, then the Johnny Football trademark saga both defines additional intellectual property rights for student-athletes and provides a potential framework for dealing with such rights within the evolving college-sports model. Regardless of how the NCAA appeals or implements Judge Wilken’s decision, trademark law provides a relatively uncontroversial, partial solution to the increasingly hostile and high-stakes debate over the intellectual property rights of collegiate athletes.

⁴⁵ *O’Bannon v. Nat’l Collegiate Athletic Ass’n*, 7 F. Supp. 3d 955, 955 (N.D. Cal. Aug. 8, 2014).

⁴⁶ *Id.* at 1007–08.

⁴⁷ Stewart Mandel, *O’Bannon Ruling Deals Crushing End to Amateurism in NCAA Athletics*, FOX SPORTS (Aug. 9, 2014, 12:08 AM), <http://www.foxsports.com/college-football/story/o-bannon-decision-deals-decisive-end-to-amateurism-in-ncaa-athletics-080814>.

⁴⁸ *See id.*

⁴⁹ See Andy Staples, *Online Jersey Sales Highlight NCAA’s Hypocrisy on Amateurism*, SPORTS ILLUSTRATED (May 28, 2014), <http://www.si.com/college-football/2013/08/07/jersey-ncaa-sales-manziel-clowney>.

⁵⁰ Until August 2013, the NCAA sold, through its website, jerseys with jersey numbers, but omitted the names of student-athletes. However, Jay Bilas of ESPN exposed the direct linking of jerseys with searches for specific player names. Upon searching for “Manziel,” the NCAA online store displayed Texas A&M jerseys with the number “2”—Johnny Manziel’s jersey number. Jay Bilas, TWITTER, <https://twitter.com/JayBilas/status/364809647498088448> (Aug. 6, 2013, 11:06 AM). Bilas repeated the search with names of other prominent college football players, such as A.J. McCarron and Marqise Lee, which yielded similar results. The NCAA ceased selling team and individual player merchandise on its website. NCAA president Mark Emmert admitted the perceived hypocrisy of the NCAA’s online jersey sales. Mark Schlabach, *NCAA Puts End to Jersey Sales*, ESPN (Aug. 9, 2013, 1:10 PM), http://espn.go.com/college-sports/story/_/id/9551518/ncaa-shuts-site-jersey-sales-says-hypocritical.

A. *Other Proposals to Reform the Collegiate-Sports Model*

¶17 Even after Judge Wilken’s decision, proposed resolutions for the publicity-rights dilemma in college sports involve extensive reform of NCAA policy, either internally or through further judicial or legislative action. One such solution is the notion of “pay-for-play,” which would upend the NCAA’s amateurism model.⁵¹ However, some argue that the increased commercialization of college football has already compromised this model’s utility. The fact that most schools fund nonrevenue-generating sports, such as most women’s sports, with revenue from football and basketball creates further problems.⁵² Paying players would diminish the funds available for these nonrevenue-generating sports.⁵³ Ultimately, “pay-for-play” raises more questions than it answers, such as how much to pay the athletes and whether the NCAA should pay certain athletes more than others.⁵⁴

¶18 A popular solution is the “Olympic Model,” which would allow student-athletes to solicit endorsement deals similar to those signed by Olympians.⁵⁵ Commercial sponsors would pay student-athletes for their fame and marketability. However, even the Olympic Model requires drastic changes to the NCAA’s definition of amateurism and its defense thereof, which prohibits benefits stemming from a student’s collegiate-athlete status. Most importantly, Judge Wilken’s decision preserved the NCAA’s right to prohibit such commercial endorsements.⁵⁶ Thus, a unilateral change of heart by the NCAA is ultimately unlikely, especially given its unrelenting position prohibiting compensation for a collegiate athlete’s likeness.⁵⁷

¶19 Another proposal calls for the establishment of a trust fund for former student-athletes,⁵⁸ which Judge Wilken considers a “less restrictive” alternative to the NCAA’s current anticompetitive practices.⁵⁹ However, the NCAA could both cap the amount held in the trust and require that its member schools offer the same trust fund amount to each

⁵¹ See Mary Grace Miller, Comment, *The NCAA and the Student-Athlete: Reform Is on the Horizon*, 46 U. RICH. L. REV. 1141, 1169 (2012) (“The pure pay-for-play measure seems unworkable if the NCAA is to maintain a sense of amateurism at all.”).

⁵² Steve Berkowitz, *Most NCAA Division I Athletic Departments Take Subsidies*, USA TODAY (July 1, 2013, 12:48 PM), <http://www.usatoday.com/story/sports/college/2013/05/07/ncaa-finances-subsidies/2142443/>.

⁵³ *Id.*

⁵⁴ Charles McClelland, athletic director at Texas Southern University, remarked, “I can’t see the NCAA passing any legislation to allow additional pay just based on revenue-producing sports, knowing all the other sports would be adversely affected. Instead, they would have to come up with some kind of formula that would work for all student-athletes, male and female, versus just those programs that are making money.” Mechelle Voepel, *Title IX a Pay-for-Play Roadblock*, ESPN (July 15, 2011), http://espn.go.com/college-sports/story/_/id/6769337/title-ix-seen-substantial-roadblock-pay-play-college-athletics.

⁵⁵ The Olympic Model would “reconcile the desire to promote athleticism and academics while still providing students with the opportunity to maintain the rights to his or her image and talent.” Miller, *supra* note 51, at 1168.

⁵⁶ *O’Bannon v. Nat’l Collegiate Athletic Ass’n*, 7 F. Supp. 3d 955, 1008 (N.D. Cal. Aug. 8, 2014).

⁵⁷ *NCAA Files Notice of Appeal in O’Bannon Case*, NCAA (Aug. 21, 2014, 3:55 PM), <http://www.ncaa.org/about/resources/media-center/ncaa-files-notice-appeal-o%E2%80%99bannon-case>.

⁵⁸ Leslie Wong, Comment, *Our Blood, Our Sweat, Their Profit: Ed O’Bannon Takes on the NCAA for Infringing on the Former Student-Athlete’s Right of Publicity*, 42 TEX. TECH. L. REV. 1069, 1104 (2010).

⁵⁹ *O’Bannon*, 7 F. Supp. 3d at 1007 (“[The NCAA] could also permit schools to hold limited and equal shares of that licensing revenue [generated from use of student athletes’ likenesses] in trust for the student-athletes until they leave school.”).

recruit.⁶⁰ In practice, the capped stipends would merely supplement the total aid provided to collegiate athletes up to an amount equal to the actual cost of attending college. Moreover, since the trust structure could require all members of a team to receive the same amount from the trust, the stipends may not reflect the relative fame, marketability, and intellectual property interests of each athlete.

B. Distinguishing “Johnny Football” from the O’Bannon Case

¶20 “Johnny Football” highlights a separate kind of intellectual property right protected by trademark law. A trademark like “Johnny Football” would be unique to a single individual and not generally applicable to the rest of the team. When the NCAA allowed Manziel to keep any proceeds from the lawsuit while still playing college football, the NCAA recognized Manziel’s property interest belonging solely to Manziel. For instance, according to Shane Hinckley, assistant vice president of business development at Texas A&M, “[E]veryone felt that if anybody should have ownership of this [trademark], it’s Johnny or his family.”⁶¹

¶21 Further, the nature of a trademark-registerable nickname like “Johnny Football” presents an inherently different kind of property right than that claimed by the plaintiffs in *O’Bannon*. Even if the plaintiffs prevailed in the class action, a damages determination of *how much* money players would be entitled to receive from the videogames would be necessary.⁶² While EA’s videogames may have improperly invoked the identity of actual collegiate athletes, the games also utilized jerseys, stadiums, and school colors—all of which represent intellectual property rights of the university and/or the NCAA—to enhance the realism of the game. In fact, the court in *Hart v. EA* noted that the use of college athletes’ identifiable features *in the context of* a simulated college football game, including the Rutgers jersey worn by the virtual quarterback, made the games *less* transformative, thus finding in favor of the plaintiff.⁶³

¶22 Meanwhile, the Johnny Football trademark can exist wholly separate from any trademarks of Texas A&M, the Southeastern Conference (SEC), or the NCAA. Texas A&M intervened only after finding that approximately 20% of the Johnny Football contraband merchandise *also* infringed on Texas A&M’s marks.⁶⁴ According to Shane Hinckley, the Johnny Football phenomenon is a “three-headed monster” that involves Manziel’s likeness, his intellectual property rights, and the school’s intellectual property rights.⁶⁵ The first of the “three-headed monster,” Manziel’s likeness, is protected under

⁶⁰ *Id.* at 1008 (“[T]he NCAA may enact and enforce rules ensuring that no school may offer a recruit a greater share of licensing revenue than it offers any other recruit in the same class on the same team.”).

⁶¹ Scott Soshnick, *NCAA Handcuffs Family Use While Johnny Football Seeks Trademark*, BLOOMBERG (Nov. 15, 2012), <http://www.bloomberg.com/news/2012-11-14/johnny-football-seeks-trademark-while-ncaa-handcuffs-family-use.html>.

⁶² See Steve Berkowitz, *Distributing \$40 Million EA Settlement Looks Complex*, USA TODAY (Sept. 27, 2013), <http://www.usatoday.com/story/sports/ncaaf/2013/09/27/ed-obannon-sam-keller-ea-court-settlement-payment/2886069/>.

⁶³ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 166 (3d Cir. 2013) (“Not only does the digital avatar match Appellant in terms of hair color, hair style and skin tone, but the avatar’s accessories mimic those worn by Appellant during his time as a Rutgers player.”).

⁶⁴ Andy Staples, *NCAA Rules Clarification Closes Johnny Football “Loophole,”* SPORTS ILLUSTRATED (Feb. 26, 2013), <http://sportsillustrated.cnn.com/college-football/news/20130226/johnny-manziel-ncaa-loophole>.

⁶⁵ *Id.*

the right of publicity doctrine.⁶⁶ Manziel also has intellectual property rights extending beyond this right of publicity. Trademark law protects these intellectual property interests by allowing student-athletes like Manziel to assert their claims on the marks and designs that they have made famous. Trademark law similarly protects universities' intellectual property interests.⁶⁷

¶23 Finally, envisioning the identities of student-athletes as discrete trademarks (or potential trademarks) does not require any changes to the NCAA's current amateurism rules. Even if the *O'Bannon* case or other developments in college athletics lead to compensation of current student-athletes, trademark protection could still play an important role. For example, if the NCAA were to permit student-athletes to pursue endorsement or marketing opportunities, famous marks and nicknames like Johnny Football would be valuable assets in such marketing campaigns. Ultimately, trademark protection for these nicknames or phrases ensures that the student-athlete continues to own and control the commercial use of such marks.⁶⁸

IV. PROTECTION UNDER TRADEMARK LAW

¶24 While Manziel applied to register the Johnny Football mark, registration is not necessary for trademark protection. Trademark protection finds its roots in common law,⁶⁹ which limits protection to “the extent people are made aware of it and placed on notice,” taking into account factors like geographic region and industry.⁷⁰ Moreover, establishing a common law right to a mark requires “win[ning] the race to the marketplace” and being the first to use the mark in commerce.⁷¹ State trademark laws and § 43(a) of the Lanham Act protect marks that are not registered federally.

¶25 The Lanham Act⁷² allows for federal registration of trademarks used in interstate commerce. This effectively expands the territorial limits of common-law trademark rights, since federal registration “creates a presumption that the registrant is entitled to use the registered mark throughout the nation,”⁷³ and serves as “public notice of [one's] claim of ownership of the mark.”⁷⁴ Other advantages of federal registration include use of the registration symbol “®” and federal court jurisdiction.⁷⁵ But substantively, a federally

⁶⁶ In the right of publicity cases against EA, courts determined that the use of player likenesses in a videogame did not constitute “transformative use.” *Hart*, 717 F.3d at 166; *In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 724 F.3d 1268, 1271 (9th Cir. 2013) (“[EA's use] literally recreates Keller in the very setting in which he has achieved renown.”), *aff'g* *Keller v. Elec. Arts*, No. C 09-1967 CW (Feb. 8, 2010).

⁶⁷ TEXAS A&M AGGIES, Registration No. 3,970,755.

⁶⁸ See *infra* text accompanying notes 83–88 for discussion of trademark “use in commerce.”

⁶⁹ Trade-Mark Cases, 100 U.S. 82, 92 (1879) (“The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been long recognized by the common law . . . and by the statutes of some of the States. It is a property right for the violation of which damages may be recovered in an action at law . . .”).

⁷⁰ 22 AM. JUR. 3D *Proof of Facts* § 623 (1993).

⁷¹ *Zazu Designs v. L'Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992) (citations omitted).

⁷² 15 U.S.C. § 1051 (2012).

⁷³ *Draeger Oil Inc. v. Uno-Ven Co.*, 314 F.3d 299, 302 (7th Cir. 2002) (citing 15 U.S.C. § 1057(b) (2012)).

⁷⁴ *Frequently Asked Questions*, USPTO (Apr. 23, 2013, 10:26 AM), http://www.uspto.gov/faq/trademarks.jsp#_Toc275426681.

⁷⁵ *Id.*

registered trademark provides essentially the same rights as those found under state statutes or common law.⁷⁶

A. *Distinctiveness*

¶26 Marks, in order to receive trademark protection, must be distinctive and “are often classified in categories of generally increasing distinctiveness; . . . they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.”⁷⁷ Suggestive, arbitrary, and fanciful marks are inherently distinctive, while descriptive marks require a secondary meaning in order to qualify as “distinctive.”⁷⁸ A person’s name can also qualify for trademark protection if it has acquired a secondary meaning.⁷⁹

¶27 Professional athletes have sought and received trademark protection for recognized nicknames and phrases. For instance, Darrelle Revis received trademark registration for his nickname “Revis Island,”⁸⁰ while Colin Kaepernick registered the term “Kaepernicking,” which refers to his signature celebratory gesture.⁸¹ And former Baylor University quarterback Robert Griffin III applied for trademark registration for his famous initials “RGIII.”⁸² Concerning Mr. Griffin’s mark, the Trademark Office published his applied-for marks in its Official Gazette, which is usually a precursor to registration. Importantly, the Office has not suggested that marks derived from athletes’ names or nicknames lack distinctiveness.

B. *Use and Intent to Use*

¶28 An application for trademark protection must also demonstrate current use or the intent to use the mark in commerce in the future. To be “used in commerce,” the mark “is placed in any manner on the goods or on their containers or the displays associated therewith . . . [and] the goods are sold or transported in commerce.”⁸³ For services, the mark should be “used or displayed in the sale or advertising of services.”⁸⁴ Requiring actual use of marks prevents “banking” or “warehousing”⁸⁵ of marks by applicants, and grants protection for marks that “help consumers identify the source” of the trademark.⁸⁶ Congress buttressed this requirement by “making clear that the trademark rights can be conveyed only through ‘the bona fide use of a mark in the ordinary course of trade, and

⁷⁶ See *Tarin v. Pellonari*, 625 N.E.2d 739, 745–46 (Ill. App. Ct. 1993); see also *Zazu Designs*, 979 F.2d at 503 (“Registration modifies [common law] system slightly, allowing slight sales plus notice in the register to substitute for substantial sales without notice.”).

⁷⁷ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)).

⁷⁸ 1-2 ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 2.01 (Matthew Bender ed., 2014).

⁷⁹ *Id.* § 2.03.

⁸⁰ REVIS ISLAND, Registration No. 77,907,325.

⁸¹ KAEPERNICKING, Registration No. 85,822,700.

⁸² U.S. Trademark Application Serial No. 85,518,373 (filed Jan. 17, 2012).

⁸³ 15 U.S.C. § 1127 (2012).

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Brookfield Commc’ns., Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1051–52 (9th Cir. 1999) (discussing how West Coast’s emails to lawyers and clients were not “sufficient to create an association among the public”).

not [use] made merely to reserve a mark.”⁸⁷ Such use “is based entirely on association of the mark in the public mind with a particular product, regardless of how that association is achieved.”⁸⁸ This will and should depend on the standards and “practices of the industry involved.”⁸⁹

¶29 When an application for trademark protection is based on “intent to use,” the applicant must file an intent-to-use statement, which establishes the applicant’s priority as to the date of filing.⁹⁰ The applicant then must file a statement-of-use within six months to demonstrate actual use, though the applicant may request additional time to file this statement.⁹¹ According to the Lanham Act:

The Director shall extend, for one additional 6-month period, the time for filing the statement of use . . . upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months.⁹²

The applicant’s intent must be bona fide, which is measured by “objective factors”⁹³ that are “specific, concrete steps an applicant has either planned or taken leading to the ultimate introduction of a commercial product.”⁹⁴

¶30 Even after registration, a mark may lose trademark protection through abandonment, which requires both “non-use and intent not to resume use.”⁹⁵ However, three consecutive years of non-use creates “prima facie abandonment,” or “a rebuttable presumption of abandonment.”⁹⁶ To prevent this, owners must use marks in a nontrivial and non-sporadic manner sufficient to maintain public recognition of the mark and its ownership.⁹⁷ This is consistent with the policy behind the Lanham Act, which “prevents

⁸⁷ *Id.* at 1051 (citing 15 U.S.C. § 1127).

⁸⁸ *Marvel Comics Ltd. v. Defiant*, 837 F. Supp. 546, 549 (S.D.N.Y. 1999).

⁸⁹ H.R. REP. NO. 100-1028, at 9 (1988).

⁹⁰ 15 U.S.C. § 1051(b).

⁹¹ *See DSMR, LLC v. Goldberg*, No. 02 c 5203, 2004 U.S. Dist. LEXIS 4879, at *8 (N.D. Ill. Mar. 24, 2004).

⁹² 15 U.S.C. § 1051(d) (2012).

⁹³ Legislative history of the 1988 amendment to the Lanham Act, which added the option to apply based on intent to use, clarified the requirement of “bona fide” intent to use a mark:

A statement of intent to use a mark on specifically identified products in the future may be sufficient. An applicant may safely make this statement in its original application without having taken concrete steps to create and introduce a new product, provided that in fact it intends to use the mark.

S. REP. NO. 100-515, at 23 (1988).

⁹⁴ GILSON LALONDE, *supra* note 78, § 3.04(2)(c).

⁹⁵ *Saratoga Vichy Spring Co., Inc. v. Lehman*, 625 F.2d 1037, 1043 (2d Cir. 1980).

⁹⁶ *Id.* at 1044.

⁹⁷ *Pilates, Inc. v. Current Concepts, Inc.*, 120 F. Supp. 2d 286, 310 (S.D.N.Y. 2000) (citing *Stetson v. Wolf & Assocs.*, 955 F.2d 847, 850 (2d Cir. 1992)).

entrepreneurs from reserving brand names in order to make their rivals' marketing more costly" by requiring actual use of marks.⁹⁸

C. Infringement

¶31 Even after establishing trademark rights, an owner claiming trademark infringement must establish all of the elements for infringement to prevail,⁹⁹ which are the same for registered and unregistered trademarks.¹⁰⁰ In determining whether the elements for infringement are satisfied, courts apply a two-pronged test: "[F]irst whether the plaintiff's mark is valid and entitled to protection, and second whether the defendant's use of the mark is likely to cause confusion as to the origin of the goods."¹⁰¹

V. APPLYING TRADEMARK LAW TO JOHNNY FOOTBALL AND COLLEGE SPORTS

¶32 Although the Johnny Football issue raised many questions and possibilities concerning collegiate-athlete intellectual property rights, Manziel is neither the first¹⁰² nor the last¹⁰³ athlete to have a potential trademark claim over an aspect of his identity. Rather, Johnny Football is a helpful test case for examining the availability and application of trademark protection for student-athletes, providing guidance as to the distinctiveness and use-in-commerce requirements in this context, as well as to the implications for those claiming infringement.

A. Distinctiveness

¶33 A mark based on an aspect of a student-athlete's identity is likely to be sufficiently distinctive for trademark protection. The Johnny Football mark is either suggestive—which would be sufficiently distinctive—or descriptive. Even in the latter instance, there

⁹⁸ *Zazu Designs v. L'Oreal S.A.*, 979 F.2d 499, 503 (7th Cir. 1992).

⁹⁹ The trademark owner must establish that:

(1) it has a valid mark that is entitled to protection under the Lanham Act; and that (2) the defendant used the mark, (3) in commerce, (4) "in connection with the sale . . . or advertising of goods or services" without the plaintiff's consent. In addition, the plaintiff must show that defendant's use of that mark "is likely to cause confusion . . . as to the affiliation, connection, or association of [defendant] with [plaintiff], or as to the origin, sponsorship, or approval of [the defendant's] goods, services, or commercial activities by [plaintiff]."

1-800-Contacts, Inc. v. WhenU.com, 414 F.3d 400, 406–07 (2d Cir. 2005) (citations omitted).

¹⁰⁰ *Id.*

¹⁰¹ *Tiffany, Inc. v. eBay, Inc.*, 576 F. Supp. 2d 463, 495 (S.D.N.Y. 2008).

¹⁰² In 2011, Louisiana State University (LSU) star Tyrann Mathieu experienced a similar meteoric rise to fame as "Honey Badger," a nickname from a viral YouTube video. *See The Crazy Nastys Honey Badger (original narration by Randall)*, YOUTUBE (Jan. 18, 2011), <http://www.youtube.com/watch?v=4r7wHMg5Yjg>. The compliance office at LSU responded to the unlicensed "Honey Badger" merchandise with cease-and-desist letters and a warning to fans of the illicit nature of such items. *Honey Badger Does Care*, LSU COMPLIANCE (Dec. 7, 2011), <http://compliance.lsu.edu/Pages/HoneyBadger.aspx>.

¹⁰³ Even after the lawsuit by Manziel, Cubby Tees still sells shirts bearing the name, nickname, or image of current college athletes. *College Sports Tees*, CUBBY TEES, <http://www.cubbytees.com/CollegePage.html> (last visited Nov. 1, 2013).

would be a strong case for secondary meaning given the widespread recognition of the nickname referring to Johnny Manziel.¹⁰⁴ While the Trademark Office suspended Manziel’s application due to the existence of earlier applications for the Johnny Football mark, the mark did not fail because of a lack of distinctiveness.¹⁰⁵

B. Use in Commerce

¶34 The Trademark Office initially denied Johnny Manziel’s application because the mark used on the specimen in the application was merely ornamental, and thus “did not function as a trademark.”¹⁰⁶ Manziel might overcome the initial denial by “submit[ting] a different specimen (a verified-substitute specimen) that was in actual use in commerce at least as early as the filing date of the application.”¹⁰⁷ If he is unable to do so, he has the remaining options:

(2) Amend to the Supplemental Register, which is a second trademark register for marks not yet eligible for registration on the Principal Register, but which may become capable over time of functioning as source indicators.

(3) Claim acquired distinctiveness [through] . . . proof that applicant’s extensive use and promotion of the mark allowed consumers now directly to associate the mark with applicant as the source of the goods.

(4) Submit evidence that the applied-for mark is . . . already recognized as a source indicator for other goods or services that applicant sells/offers.

(5) Amend the filing basis to intent to use under Section 1(b).¹⁰⁸

¶35 As illustrated above, it is difficult for the student-athlete applicant to demonstrate “use in commerce” without relying on unlicensed merchandise sold by third parties. Per NCAA regulations, Manziel could not sell Johnny Football-branded merchandise while playing football in college.¹⁰⁹ Trademark protection, however, requires commercial use. But the goal of the “use in commerce” requirement is to ensure “sufficient publicity to identify or distinguish” the mark, or in the alternative, to “create an association of the

¹⁰⁴ When the Kenneth R. Reynolds Family Investments applied for the “Johnny Football” trademark, a letter of protest cited the “lack of consent of a living *individual named in the mark*” and produced numerous pieces of evidence to show that “Johnny Football” indeed referred to Johnny Manziel. Letter of Protest Memorandum, U.S. Trademark Application Serial No. 85,769,563 (filed Aug. 16, 2013) (emphasis added) (on file with the U.S. Patent and Trademark Office).

¹⁰⁵ Office Action, U.S. Trademark Application Serial No. 85,839,336 (filed May 22, 2013) (on file with the U.S. Patent and Trademark Office).

¹⁰⁶ The mark does not “indicate the source of applicant’s clothing” or “identify and distinguish applicant’s clothing” because of the placement and size of the mark on the clothing. *Id.*

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ See NCAA MANUAL, *supra* note 24, § 12.5.2.2.

goods” with the mark.¹¹⁰ Accordingly, the use of nicknames, images, and names of college athletes by the school,¹¹¹ media, and the athlete himself likely satisfies this goal.

¶36 Manziel’s use of his nickname might also be sufficiently commercial in the context of “the practice of the industry”¹¹² of college athletics, which is strictly governed by the NCAA. In this case, the “customary practices of a particular industry” include the NCAA’s prohibition of student-athletes profiting from the use of their nicknames or marks.¹¹³ Since the NCAA currently restricts commercial activity by student-athletes, the sufficient use of a trademark by a student-athlete might encompass acts beyond simply making or selling t-shirts with the Johnny Football mark.¹¹⁴

¶37 Moreover, a student-athlete’s social media activity may constitute “use in commerce.” Although neither the student-athlete nor the school may sell merchandise with marks related to the student, both can utilize social media in building a brand. By consistently “using” a mark on social media, the student-athlete can strengthen the association of the mark with himself.¹¹⁵ Regardless of whether the student-athlete seeks to demonstrate actual use or bona fide intent to use the mark, social media is a beneficial tool for demonstrating the public’s association of the mark with the athlete.

¶38 However, granting Manziel or other similarly situated college-athletes trademark protection for marks not yet used commercially raises “warehousing” concerns.¹¹⁶ The applicant or owner of a trademark needs to have more than an “inchoate wish to keep the mark for some vague, unspecified future use.”¹¹⁷ Even if a collegiate star is undoubtedly going to become a professional athlete, he may decide *not* to use an old nickname or mark from his collegiate days.¹¹⁸ Prematurely granting registration for trademarks before establishing actual use in commerce would effectively serve as a “reservation” of a trademark before protection is warranted.¹¹⁹

¶39 If Manziel or another collegiate athlete is unable to prove “use in commerce,” he may consider applying based on his bona fide “intent to use” the mark.¹²⁰ While the Lanham Act requires the applicant to show more than a mere desire to reserve a mark, its

¹¹⁰ *Marvel Comics Ltd. v. Defiant*, 837 F. Supp. 546, 549 (S.D.N.Y. 1999).

¹¹¹ A&M has released videos on YouTube featuring “Johnny Football.” Texas A&M Athletics, *Call Him Johnny Heisman*, YOUTUBE (Dec. 8, 2012), <http://www.youtube.com/watch?v=hjJ7HPfirIvY>; Texas A&M Athletics, *The Amazing Johnny Football*, YOUTUBE (Nov. 16, 2012), <http://www.youtube.com/watch?v=eG7VMdvNPLA>.

¹¹² H.R. REP. NO. 100-1028 (1988).

¹¹³ *See Planetary Motion, Inc. v. Techplosion, Inc.*, 261 F.3d 1188, 1198 (11th Cir. 2001) (determining that making software available to the public for free download under a GNU General Public License constituted sufficient “use in commerce” to establish priority, given the practices of software industry).

¹¹⁴ *See id.*

¹¹⁵ “Most companies have cottoned on to social media as tools for engagement and collaboration. . . . Of course, social media can also boost brand awareness, trial, and ultimately sales, especially when a campaign goes viral.” Patrick Barwise & Seán Meehan, *The One Thing You Must Get Right When Building a Brand*, HARV. BUS. REV., Dec. 2010, at 80, 82.

¹¹⁶ *See supra* text accompanying note 85.

¹¹⁷ *ITC Ltd. v. Punchgini, Inc.*, 373 F. Supp. 2d 275, 283 (S.D.N.Y. 2005) (discussing the abandonment doctrine).

¹¹⁸ Tyrann Mathieu distanced himself from his once-synonymous “Honey Badger” nickname upon entering the NFL. Nate Ulrich, *Tyrann Mathieu Discusses Reviving “Honey Badger” Nickname, Whatever That Means*, YAHOO! SPORTS (June 30, 2013), <http://sports.yahoo.com/blogs/nfl-shutdown-corner/tyrann-mathieu-discusses-reviving-honey-badger-nickname-whatever-145907461.html>.

¹¹⁹ *See Zazu Designs v. L’Oreal S.A.*, 979 F.2d 499, 503 (7th Cir. 1992).

¹²⁰ 15 U.S.C. § 1051(b) (2012).

legislative history suggests that it may extend to certain situations involving delayed use of a mark.¹²¹ All student-athletes will eventually leave the realm of collegiate athletics and the NCAA, at which point they are free to pursue commercial ventures using their name or likeness. Moreover, NCAA regulations do not currently prohibit student-athletes from taking “specific, concrete steps” towards the “ultimate introduction of a commercial product” using the applied-for mark.¹²² Further, athletes tend to use their registered trademarks for clothing merchandising, which narrows the likely intended use of applied-for marks.¹²³

¶40 “Intent to use” is especially practical for elite college athletes because of the typically short duration of their collegiate careers. Players of such fame (or notoriety) are more likely to be upperclassmen with only one or two years of eligibility remaining. Even underclassmen like Johnny Manziel may choose to leave early for the NFL, instead of risking injury or a disappointing senior season in college.¹²⁴ Similarly, college basketball stars are eligible for the National Basketball Association (NBA) after their freshman season, making premature collegial departures even more likely for basketball players.¹²⁵

¶41 In sum, the timing and reality of collegiate athletic careers allow student-athletes like Johnny Manziel to apply for a mark based on his future intent to use; graduate or depart early to become a professional athlete; and *then* file a timely statement of actual commercial use of the mark.¹²⁶ By default, student-athletes have six months to demonstrate actual use of their mark in commerce.¹²⁷ They may also request an automatic six-month extension, and an additional twenty-four-month extension with a showing of good cause.¹²⁸ Together, this gives an applicant a total of thirty-six months to demonstrate actual use. By delaying commercial use of a registered trademark, student-athletes can preserve their NCAA eligibility by avoiding commercial activity until they are no longer subject to NCAA regulations.¹²⁹ The intent-to-use basis for trademark registration thus allows current college athletes superior intellectual property protection that is nevertheless consistent with NCAA regulation.

C. Infringement

¶42 Manziel alleged that Vaughan “ha[d] unfairly competed through false designation of origin, false representation of sponsorship and affiliation, and infringement of

¹²¹ See H.R. REP. NO. 100-1028 (1988); see also S. REP. NO. 100-515, at 23 (1988).

¹²² GILSON LALONDE, *supra* note 78, § 3.04(2)(c).

¹²³ Trademark applications of Colin Kaepernick, Darrelle Revis, and Marshawn Lynch all cited the class for “clothing” and other apparel in their respective trademark applications. See REVIS ISLAND, Registration No. 77,907,325; KAEPERNICKING, Registration No. 85,822,700; see also U.S. Trademark Application Serial No. 86,059,781 (filed Sept. 8, 2013).

¹²⁴ In fact, Manziel declared for the NFL draft after his redshirt sophomore season at Texas A&M. See Belson, *supra* note 15.

¹²⁵ Nicole Auerbach, *Coach K Worries About One-and-Done in College Game*, USA TODAY (Nov. 26, 2013), <http://www.usatoday.com/story/sports/ncaab/2013/11/26/mike-krzyzewski-one-and-done-jabari-parker-andrew-wiggins-julius-randle/3761643/>.

¹²⁶ See DSMR v. Goldberg, 2004 U.S. Dist. LEXIS 4879, at *8 (N.D. Ill. Mar. 24, 2004).

¹²⁷ 15 U.S.C. § 1051(d)(1) (2012).

¹²⁸ *Id.* § 1051(d)(2).

¹²⁹ See *id.*

Plaintiff's common law trademark in violation of Section 43(a) of the Lanham Act."¹³⁰ Since he had not registered the Johnny Football trademark by the time of the lawsuit, Manziel cited § 43 instead of § 32 of the Lanham Act, which addresses *registered* trademarks. Section 43 of the Lanham Act protects unregistered marks by creating civil liability for false descriptions that are "likely to cause confusion" or mistake concerning "the affiliation, connection, or association" of the defendant with another person or of another person's "sponsorship or approval."¹³¹

¶43 While Manziel was an amateur college athlete who could not actually sponsor or endorse anything, NCAA policies suggest that there is a serious likelihood of confusion about endorsements by college athletes. Section 12.5.2.2 of the NCAA Bylaws places an affirmative burden on the student (or his school) to stop the production and sale of "commercial items" bearing his name or image.¹³² In order to comply with this rule and preserve the eligibility of student-athletes, schools like Texas A&M and Louisiana State University have warned fans about the potential risks posed by unauthorized merchandise for student-athlete eligibility.¹³³ Such caution suggests that university leaders feel consumer confusion as to "sponsorship and affiliation" is not only possible, but in fact, likely.

¶44 Moreover, while § 43 protects unregistered trademarks, registration has distinct advantages. Registration of a mark is "prima facie evidence" of "the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce."¹³⁴ Registered marks may also become incontestable, which offers additional assurances and protections for owners of the marks.¹³⁵ In other words, while student-athletes may claim infringement of unregistered marks, registration provides greater security for intellectual property owners if a dispute arises.

¶45 Section 2(c) of the Lanham Act further prohibits registration of a trademark that "consists or comprises of a name, portrait, or signature identifying a particular living individual except by his written consent."¹³⁶ One could argue that this sufficiently protects the interests of college athletes because it prevents third parties from registering a trademark clearly connected to a current college athlete. For the Johnny Football mark, the Trademark Office raised this concern in response to the application submitted by Kenneth R. Reynolds Family Investments, and refused registration until the applicant produced Manziel's written consent.¹³⁷

¶46 In conclusion, the unavailability of trademark registration may discourage third-party commercial use of marks associated with current college athletes. However, student-athletes can further prevent third parties from using their identities for commercial gain by filing for trademark registration based on their intent to use.¹³⁸ In

¹³⁰ Complaint ¶12, *JMAN2 Enters. v. Vaughan*, No. 6:13-cv-00158-MHS (E.D. Tex. Feb. 15, 2013).

¹³¹ 15 U.S.C. § 1125(a) (2012).

¹³² See NCAA MANUAL, *supra* note 24, § 12.5.2.2.

¹³³ See *supra* note 102.

¹³⁴ 15 U.S.C. § 1115(a) (2012).

¹³⁵ 15 U.S.C. § 1115(b).

¹³⁶ 15 U.S.C. § 1052(c) (2012); see *In re Sauer*, 27 U.S.P.Q. 2d (BNA) 1073 (T.T.A.B. 1993) (refusing registration of the mark "Bo Ball" under § 2(c) of the Lanham Act because it contained the name identifying Bo Jackson).

¹³⁷ See Letter of Protest Memorandum, *supra* note 104.

¹³⁸ See *supra* text accompanying notes 120–22.

addition to discouraging third parties like Eric Vaughan and Kevin Doolan from infringing, student-athletes can establish intellectual property rights *before* they pursue commercial opportunities available to them after their NCAA careers. Thus, trademark registration not only protects student-athletes from the unauthorized use of their marks and identities, but may also provide them with clear intellectual property rights to the valuable brands that they develop as student-athletes.¹³⁹

VI. IMPLICATIONS OF TRADEMARK RIGHTS IN COLLEGE SPORTS

¶47 Trademark registration is consistent with the NCAA's current bylaws requiring students and member colleges to be vigilant of unauthorized, third-party use of student-athlete likenesses. More importantly, it is also consistent with the NCAA's current position on amateurism in college athletics. Registration of a well-known college athlete's name, nickname, or symbol reflects a claim of ownership consistent with the NCAA's stance that a student-athlete ultimately owns the rights to his name.¹⁴⁰ It also serves as notice to sellers of unauthorized merchandise that such ownership claims exist and infringement thereof carries consequences. Regardless of how *O'Bannon* affects the NCAA's current model, trademark offers a well-defined level of protection for college athletes as well as a rare instance of consensus between students, schools, and the NCAA.

¶48 Even with the *O'Bannon* decision, trademark law can supplement any newfound rights and economic interests of college athletes. In fact, relaxing or abandoning the NCAA's amateurism rules—whether in the form of pay-for-play or the Olympic Model—would make trademarks more important for student-athletes asserting these rights through trademarks and licensing agreements. Student-athletes would no longer need to wait until after college to pursue commercial uses of nicknames, images, or marks. Ultimately, relaxed NCAA rules would make it even more critical for student-athletes to define and establish their intellectual property rights before pursuing branding and promotional opportunities.

¶49 Moreover, the *O'Bannon* case concerned a student-athlete's right of publicity. Trademark protection, however, may be preferable to the right of publicity in several ways. First, trademark offers federal protection, while the right of publicity varies from state to state.¹⁴¹ Under the Lanham Act, "Registration of a mark on the principal register . . . shall be constructive notice of the registrant's claim of ownership thereof."¹⁴² Given the national reach of the NCAA, it makes sense to have one uniform approach for protecting the rights of college athletes.

¹³⁹ John van der Lult-Drummond, *Lessons in Brand Protection from College Football's Biggest Name*, WORLD TRADEMARK REV. (Sept. 13, 2013), <http://www.worldtrademarkreview.com/daily/Detail.aspx?g=5f5e606b-ade8-4384-acbb-ac8ffcba394&c=5851351> ("The key for Manziel, then, is building and protecting the brand so it is in a strong position to capitalise once he joins the paid ranks.")

¹⁴⁰ See *supra* text accompanying notes 49–50, 64–65.

¹⁴¹ But "as the right of publicity has matured, it has been increasingly connected to trademark rights." Sheldon W. Halpern, *Trafficking in Trademarks: Setting Boundaries for the Uneasy Relationship Between "Property Rights" and Trademark and Publicity Rights*, 58 DEPAUL L. REV. 1013, 1034 (2009). Section 43(a) of the Lanham Act protects against false representation of sponsorship by a celebrity. See *id.* "To a fair extent, this use of section 43(a) creates a federal variant of the state law right of publicity." *Id.*

¹⁴² 15 U.S.C. § 1072 (2012).

¶50 Second, trademark law provides a more clearly established right than the right of publicity doctrine, which has expanded and contracted since its inception. The right of publicity emerged as “an outgrowth of the right of privacy.”¹⁴³ As the right expanded to the *exclusive* right to commercialize one’s likeness, courts have struggled to balance the interests of protecting one’s image from exploitation by others with the right’s rather humble origins meant to protect individual privacy.¹⁴⁴

¶51 Most importantly, modern rationales for the right of publicity do not fit into a college-sports context. Defenders of the right of publicity argue that it rightfully provides economic incentives for the celebrity to continue developing the economic benefits of fame.¹⁴⁵ However, college football and basketball stars future-income earning potential is often initially commensurate with their collegial accomplishments, thus incentivizing student-athletes to continually develop. Similarly, some argue that the right of publicity provides validation to the celebrity by allowing her to benefit from the fruit of her own labor.¹⁴⁶ However, the student-athlete benefits from his labor by receiving a scholarship, which is the extent of the benefits allowed by the NCAA.

¶52 Preventing unjust enrichment also has its place in this discussion.¹⁴⁷ Often, fans bestow nicknames on student-athletes, such as “Honey Badger” and “Johnny Football,” with little to no creative input from the athletes.¹⁴⁸ Moreover, a college athlete’s fame would not be possible without costly marketing efforts and media coverage, both of which universities invest in heavily to promote their respective institutions and student-athletes.¹⁴⁹

VII. CONCLUSION

¶53 Although the NCAA’s decision to allow Johnny Manziel to keep any financial gains from his trademark infringement suits caused many to label it a “loophole” in the NCAA’s amateurism rules, it also suggests a new solution for protecting the rights of college athletes that is compatible with the goals of amateurism. The advantages of trademark registration over the contentious and relatively unpredictable right of publicity doctrine make trademark a better form of protection for college athletes whose names or

¹⁴³ *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 928 (6th Cir. 2003).

¹⁴⁴ See Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1162 (2006) (“[Courts have] created a few ad hoc exceptions in cases where the sweeping logic of the right of publicity seems to lead to results they consider unfair.”).

¹⁴⁵ *But see id.* at 1187 (questioning whether celebrities would invest less energy and talent).

¹⁴⁶ See George P. Smith, II, *The Extent of Protection of the Individual’s Personality Against Commercial Use: Toward a New Property Right*, 54 S.C. L. REV. 1, 37 (2002).

¹⁴⁷ See Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 857–58 (1995) (noting the “economic reality” of “associative value” of a celebrity’s personality). *But see* Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 125, 180–81 (1993) (“[B]eing famous, by itself, does not make a person deserving of all the fruits of her fame.”).

¹⁴⁸ “Johnny Football” was a nickname created by fans at Texas A&M. Chris Huston, *Q&A with Johnny Manziel*, CBS SPORTS (Nov. 28, 2012, 5:22 PM), <http://www.cbssports.com/collegefootball/eye-on-college-football/21179344/q--a-with-johnny-manziel>. A viral YouTube video inspired fans on an LSU fan website to associate Tyrann Mathieu with “Honey Badger.” Glenn Gullbeau, *Honey Badger Phenomenon Going Wild for No. 2 LSU*, USA TODAY (Oct. 13, 2011), <http://usatoday30.usatoday.com/sports/college/football/sec/story/2011-10-11/lsu-honeybadger/50737088/1>.

¹⁴⁹ See Madow, *supra* note 147, 189–90.

nicknames carry immense marketing power. Furthermore, trademark registration on an intent-to-use basis, which allows student-athletes to register a mark but postpone any commercial activity related to the mark, is consistent with the NCAA's current policies regarding amateurism. Thus, trademark registration recognizes the intellectual property interests of collegiate athletes both as students subject to the amateurism rules of the NCAA and as future professional athletes with potentially tremendous name-brand value.

