

# TRADEMARK TALK

## Foul play?

There is increasing attention being focused on the names and logos of US sports teams that are seen as disparaging. **Antony J McShane** explains



Antony J McShane

**A “crowded field”, questionable historical references, and prior uses have often created difficulties to the continued use and commercialisation of the names of sports teams and the athletes who play them.** Prior investigation, sensitivity to cultural references and a degree of foresight is therefore required.

Basic trademark law establishes that frequent use of the same or similar marks with the same or similar services creates a “crowded field” in which consumers can be counted upon to distinguish between similar trademarks. Accordingly, there is often room for the same or similar trademarks to be placed on the Principal Trademark Register for similar services. That certainly holds true with professional and collegiate sports teams. Fans readily distinguish between the Arizona, St Louis and Stanford Cardinal(s), just as readily as they distinguish the New York National Football Giants from the San Francisco baseball Giants. Illustrating this point further, Wikipedia currently lists over 40 collegiate Eagles, 10 Chargers, nine Buccaneers, seven Broncos and six Bruins, all of which share a namesake with a professional sports team.

Nevertheless, based on individual circumstances and particular record evidence, the US Patent and Trademark Office (USPTO) has recently rejected an application for the METRO JETS for use with an amateur hockey team based upon a likelihood of confusion with JETS, used by the National Hockey League’s (NHL) Winnipeg franchise.<sup>1</sup> More recently, an application by the new NHL franchise in Las Vegas for the VEGAS GOLDEN KNIGHTS was rejected based on the prior registration of a mark comprising GOLDEN KNIGHTS registered by the College of Saint Rose, but not on the prior registration by the University of Central Florida (UCF) its UCF GOLDEN KNIGHT logo. The only way to understand these recent decisions is to appreciate that the right to use and register a name for a sports team depends

entirely on comparing how a particular name will be displayed, and used, and with what specific goods and services to specific previously registered marks and how they are displayed and used with specific goods and services. Achieving a different outcome will entirely depend upon the individual facts and circumstances.

In addition, there is increasing attention being focused on the names and logos of sports teams that are seen as disparaging to a group of people, for example, Native Americans. Over the years, Syracuse University dropped its Saltine Warrior mascot. The Marquette University Warriors became the Golden Eagles; whereas the St John University’s Redmen became the Red Storm; and the University of Illinois retired its Chief Illiniwek mascot.

Thus, in June 2014, the USPTO cancelled six trademark registrations for REDSKINS owned by the NFL’s Washington Redskins on the grounds that a substantial composite of Native Americans found the mark to be disparaging. In July 2015, that ruling was upheld in Federal District Court<sup>2</sup> and is now on appeal with the US Court of Appeals for the Fourth Circuit, and awaiting the outcome of the Supreme Court of the US’ review of the trademark office’s refusal to register THE SLANTS as a trademark for a musical group, on the grounds that it too is disparaging to a substantial group of people. At issue before SCOTUS is whether the Trademark (Lanham) Act’s prohibition against registering disparaging trademarks violates the free speech clause of the First Amendment.<sup>3</sup> Arguments in *Lee v Tam* were heard on 18 January 2017, and a ruling is expected shortly. Meanwhile, a similar challenge to the Major League Baseball’s Cleveland Indian’s registration for its “Chief Wahoo” logo is ongoing,<sup>4</sup> although it too has been suspended pending SCOTUS’ ruling in *Lee v Tam*. It is thus increasingly important for sports teams to consider whether to adopt or continue to use a mark that characterises a group of people.

It is also important to secure trademark protection as soon as possible, so that players and their teams are able to freely use their personas and nicknames when they become commercially valuable. Famously, Michael Jordan’s ability to use his name as a brand was limited for many years by a registration for the trademark MICHAEL JORDAN, which issued to a clothing designer for use with apparel when he was still in high school.<sup>5</sup> Learning from these history lessons, the National Football League’s top rusher in 2016 (and likely rookie of the year), Ezekiel Elliot, applied to register his nicknames ZEKE (Serial No 86717843) and EZE (Serial No 86717845) before he turned pro.

Similarly, to enhance its ability to stop the unauthorised use of his name and persona, Ohio State University registered the mark URBAN MEYER (Reg Nos 4,770,248 and 4,769,197), the name of its football coach which it is now enforcing in a lawsuit against Cafe Press in an attempt to stop it from selling various products bearing Urban Meyer’s name.

### Comment

Given the historical desire to adopt a colourful, impactful team name and mascot, often with a unique or well-known history, sports teams must pay particular attention to the crowded field on to which they step. They must conduct a careful analysis of trademarks under consideration, and take care to adopt a unique and fanciful name and a design that readily distinguishes its team and products and avoids any disparaging or derogatory connotations.

### Footnotes

1. (Serial No 86515334; *In re Jets Hockey Club, LLC* 216 BL 196125).
2. See *Pro-Football, Inc v Blackhorse*, 112F. Supp 3d 439 (EDVa 2015).
3. See *Lee v Tam Docket No 15-1293*.
4. Registration No 2,569,9766; Cancellation Proceeding No 92063171.
5. See Registration No 1,152,497; now expired.

*Antony J McShane co-chairs Neal Gerber Eisenberg’s intellectual property practice group. He focuses on the development, protection and enforcement of all forms of IP.*