

# **TRADEMARKS IN COLLEGE COACHING**

**by Martin J. Greenberg and Brian Nolasco**

## **I. INTRODUCTION**

Trademarking has become a major part of the sports industry, especially in the professional sports market. A number of professional athletes have trademarked sayings, names, or poses. The professional realm is not the only place trademarking is relevant. Recently, trademarking has entered the realm of college sports. College coaches, not the athletes, have begun using the benefits of trademark protection in regards to names, symbols, catchphrases, and likenesses. College coaches have realized that their names, symbols, catchphrases, and likenesses have substantial value in the market and are using trademark law to protect the value of such assets. This article first examines what a trademark is and how one obtains protection for a trademark. The article then provides some examples of professional athletes that have used trademark law to their advantage. Finally, the article will examine college coaches that have begun using trademark law to protect the value of certain assets and what they have used the trademarks in conjunction with. In today's sports market, trademarking is not something that is specifically reserved for the professional realm, but in fact has made its way into the college atmosphere of sports and impacts the way universities interact with coaches.

## **II. WHAT IS A TRADEMARK AND WHAT IS THE PROCESS FOR OBTAINING ONE?**

According to the Lanham Act ("Act"), a trademark includes:

any word, name, symbol, or device, or any combination thereof, used by a person, or which a person has a bona fide intention to use in commerce and applies to register on the principle register established by the Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.<sup>1</sup>

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<sup>1</sup> 15 U.S.C. § 1127 (2014).

The legal recognition and protection of a trademark derives from common law and federal law.<sup>2</sup> The actual use of a trademark in and of itself is enough to establish protection under common law.<sup>3</sup> If the owner of a trademark uses it in interstate commerce he may apply for federal trademark registration, however, federal registration itself does not create the basic trademark rights that are protectable.<sup>4</sup> The only rights created by federal registering a trademark are substantive rights of constructive notice and prima facie evidence of ownership and validity.<sup>5</sup> The trademark itself is derived from common law and the rights to a trademark exist independent of federal registration.<sup>6</sup>

As previously mentioned, the use of a trademark alone is sufficient to establish protection under the common law, but if the owner uses the trademark in interstate commerce he can apply for federal registration and get additional protection.<sup>7</sup> In order to receive federal recognition and protection, an applicant must register with the United States Patent and Trademark Office (USPTO).<sup>8</sup> When applying for a trademark, the owner must identify his mark with the goods and/or services the mark will apply to.<sup>9</sup> The owner then must search the database to determine whether the mark is already being used by someone else.<sup>10</sup> If the mark is not already in use, the owner must also identify the proper “basis” for filing the application.<sup>11</sup> The “basis” under which an owner can file a trademark application can either be for “use in commerce” or “intent to

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<sup>2</sup> 1–3 ANNE GILSON LALONDE, GILSON ON TRADEMARKS §3.02(2)(a) (2014).

<sup>3</sup> *Id.*

<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

<sup>8</sup> Brett H. Pavony & Jaia Thomas, *For the Love of the Name: Professional Athletes Seek Trademark Protection*, 2 PACE. I.P. SPORTS & ENT. L.F. 153, 154 (2012).

<sup>9</sup> *Trademark Process*, USPTO (last modified Sept. 6, 2012), <http://www.uspto.gov/trademarks/process/index.jsp>.

<sup>10</sup> *Id.*

<sup>11</sup> *Id.*

use.”<sup>12</sup> Whether the owner has started to use the mark on *all* the goods and services identified in the application determines which “basis” is identified on the application.<sup>13</sup> “Use in commerce” means a “bona fide use of a mark in the ordinary course of trade.”<sup>14</sup> “Intent to use” means that the owner has a “bona fide intent to use the mark in commerce; that is, [the owner] [has] more than just an idea but [is] less than market ready.”<sup>15</sup> After the owner of the mark properly identifies the “basis” for filing the application, the owner must file the application online through the Trademark Electronic Application System.<sup>16</sup>

After the application is filed, the USPTO reviews the application to ensure the application meets the minimum filing requirements and then is given a serial number so it can be forwarded to an attorney to be examined.<sup>17</sup> The attorney examines the application to ensure it complies with applicable rules and statutes.<sup>18</sup> If the attorney determines there are issues with the registration and it should not be registered, the attorney will send a letter explaining why the mark was refused. The attorney will contact the mark owner and allow the owner to correct the application, if the issues for refusal are minimal.<sup>19</sup> However, if the changes are not made in a timely manner, the attorney will issue a final letter of refusal.<sup>20</sup> If the examining attorney finds no objections with the mark, the attorney will approve the mark and publish it in the *Official Gazette*, which is a weekly publication of the UPSTO.<sup>21</sup> This process puts the public on notice of the publication of the mark and allows anyone with an objection to come forward within thirty

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<sup>12</sup> *Basis for Filing*, USPTO (last modified Dec. 15, 2011), <http://www.uspto.gov/trademarks/basics/Basis.jsp>.

<sup>13</sup> *Id.*

<sup>14</sup> LALONDE, *supra* note 2, at 6(b)(iii).

<sup>15</sup> *Basis for Filing*, USPTO (last modified Dec. 15, 2011), <http://www.uspto.gov/trademarks/basics/Basis.jsp>.

<sup>16</sup> *Trademark Process*, USPTO (last modified Sept. 6, 2012), <http://www.uspto.gov/trademarks/process/index.jsp>.

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> *Id.*

<sup>20</sup> *Id.*

<sup>21</sup> *Id.*

days.<sup>22</sup> If there are no objections to the mark, the USPTO will register the mark and issue a certificate.<sup>23</sup> After registration, the owner must file specific management documents to keep the registration alive.<sup>24</sup> Once the owner of a trademark is registered, it is his responsibility for enforcing and protecting the rights to the trademark.<sup>25</sup>

There are important benefits of registering a trademark on the federal registry. Once a trademark has been registered on the principle registry, the trademark registration serves as constructive notice and priority use over the trademark, establishes prima facie evidence of validity, ownership, and exclusive rights to use the mark, allows for the owner to sue in federal court and prevents importation of infringing foreign goods.<sup>26</sup> The owner of the trademark is also eligible for treble damages and attorney's fees, and, most importantly, after the trademark has been on the principle register for five years, the mark becomes incontestable.<sup>27</sup>

An individual must consider the costs required to obtain a trademark. The United States Patent and Trademark Office has a schedule that indicates the application fees for various trademarks.<sup>28</sup> The application fee for trademarks varies from \$225–\$375 per application depending on the classification of the trademark. In addition to the initial application fee, it will cost \$100 for filing an amendment, \$100 for filing a renewal of an application during the grace period, \$300–\$400 for filing a renewal application outside the grace period, \$300 to file for a petition of cancellation, and \$300 for filing a notice of opposition.<sup>29</sup> These are expenses an individual will incur just for filing documents with the USPTO, and does not take outside costs

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<sup>22</sup> *Id.*

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> 15 U.S.C. § 1115(b) (2002).

<sup>27</sup> 15 U.S.C. § 1065 (2010).

<sup>28</sup> *USTPO Fee Schedule*, USPTO (last revised Jan. 17, 2015), <http://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>.

<sup>29</sup> *Id.*

into consideration. Attorney costs will also be a factor. For instance, attorneys may charge for preparing a trademark application. A trademark owner will incur legal expenses when filing cease and desist orders to stop infringement and/or lawsuits if the infringement continues.

Trademark rights are indefinite as long as the mark is used directly or through a license,<sup>30</sup> but it is advantageous for the owner of the mark to continue, if not increase, its commercial use.<sup>31</sup> Federal regulations require a renewal every ten years, and a declaration of use must be filed during the sixth year after registration.<sup>32</sup> An owner can abandon a mark by discontinuing the mark with an intent not to resume using it.<sup>33</sup> “[The] intent not to resume can be inferred from nonuse for three consecutive years or when it has lost its trademark significance through any course of conduct.”<sup>34</sup>

### **III. PROFESSIONAL ATHLETE TRADEMARKS**

There are many differences between professional and collegiate athletes. College athletics are built upon an educational-athletic model in which academics are of first importance and athletics are secondary. Built upon this framework is the NCAA’s amateurism principle, which does not allow any athlete engaged in intercollegiate athletics to profit from their athletic image.<sup>35</sup> Recently, a California court ruled student-athletes could be compensated for their athletic ability, but it is limited in its ruling.<sup>36</sup> The case *O’Bannon v. NCAA* addressed the issue of whether student-athletes can be compensated for the use of their name, image, or likeness by the NCAA for its televised events.<sup>37</sup> The district court ruled student-athletes can receive

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<sup>30</sup> Pavony & Thomas, *supra* note 8, at 155.

<sup>31</sup> LALONDE, *supra* note 2, at 9.

<sup>32</sup> Pavony & Thomas, *supra* note 8, at 155.

<sup>33</sup> *Id.*

<sup>34</sup> *Id.*

<sup>35</sup> NCAA, 2012-2013 NCAA DIVISION 1 MANUAL, Rule 12 (2012).

<sup>36</sup> *O’Bannon* [In re NCAA Student-Athlete Name & Likeness Licensing Litigation, 990 F.Supp.2d 996 (N.D.Ca. 2013)]

<sup>37</sup> *Id.*

compensation in the amount of \$5,000–\$10,000.<sup>38</sup> However, the amount that the athletes could be “paid” would be held in a trust fund for the student-athlete until the student-athlete graduates or leaves the school.<sup>39</sup> This decision is limited in its ruling in the fact that it focused on the NCAA’s use of the athletes image (through publications and televised events), but did not address whether student-athletes can individually market themselves.<sup>40</sup> The district court’s ruling potentially opened the door for student-athletes to individually market themselves, but the decision was appealed to the 9<sup>th</sup> Circuit. In a decision issued by a three-judge panel, the 9<sup>th</sup> Circuit held that while the NCAA amateurism rules do in fact violate antitrust laws in the U.S., the court held that student-athletes may receive the full cost of attendance, but nothing more in the form of extra compensation from revenues generated through the use of the student-athletes’ likenesses.<sup>41</sup>

The professional model is vastly different. The professional model of athletics is viewed as a business, where personal gain and profit are bedrock principles. Professional athletes profit from their image by having multiple endorsement deals that take advantage of their popularity. As an athlete’s popularity increases, the public pays increasingly more attention to the athlete’s statements and actions. Many athletes trademark their signature, sayings, and actions because of this increasing popularity.

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<sup>38</sup> *Id.*

<sup>39</sup> Alicia Jessop, *Pay for Play: NCAA Schools Keep Eye on Legal Cases*, CNBC (Mar. 13, 2015), [http://www.cnbc.com/id/102503779?\\_\\_source=yahoo%7Cfinance%7Cinline%7Cstory%7Cstory&par=yahoo&doc=102532149](http://www.cnbc.com/id/102503779?__source=yahoo%7Cfinance%7Cinline%7Cstory%7Cstory&par=yahoo&doc=102532149). If the student athlete were given these funds during years in which he or she participated in athlete events, the student athlete would lose their amateurism status under Rule 12 of the NCAA bylaws and the school might have to vacate wins for that team. *See* NCAA, 2012-2013 NCAA DIVISION 1 MANUAL, Rule 12 (2013).

<sup>40</sup> *See generally* O’Bannon.

<sup>41</sup> Michael McCann, *What the Appeals Court Ruling Means for O’Bannon’s Ongoing NCAA Lawsuit*, SPORTS ILLUSTRATED (Oct. 2, 2015), <http://www.si.com/college-basketball/2015/09/30/ed-obannon-ncaa-lawsuit-appeals-court-ruling>.

## A. Examples of Professional Athlete Trademarks

As mentioned before, professional athletes are always in the spotlight and therefore have become their own individual brand and they use trademarks to protect their individual brands.<sup>42</sup> LeBron James is one example of a professional athlete that uses trademarks to protect his brand. LeBron is one of the most recognized basketball players in the world and in order to protect and leverage his brand in the market, with the assistance of Nike, he has filed numerous trademarks for the word “Lebron” in association with a number of products and services.<sup>43</sup> Specifically, Nike uses the “Lebron” trademark on footwear, shirts, pants, shorts, caps, hats, tank-tops, t-shirts, pullovers, sweatshirts (sweaters, vests, warm-up suits), jackets, socks, and wristbands.<sup>44</sup>

Lebron James also registered a number of trademarks associated with his non-profit corporation, The Lebron James Family Corporation, which include “The Lebron James Family Foundation,” “I Promise,” and “Wheels for Education.”<sup>45</sup> “The Lebron James Family Foundation” trademark is used in conjunction with numerous good and services. The mark applies to school supplies, namely notebooks, pen and pencil cases and boxes, drawing rulers, pens, pencils, folders, markers, glue sticks, shirts, socks, mittens, hats, wristbands, sweatshirts, jackets, shorts, pants, and shoes.<sup>46</sup> In addition to goods, this mark applies to a number of charitable services that include: providing bicycles to those in need, academic mentoring of school age children, providing school supplies and sporting goods to those in need, providing computers to children in need, and providing backpacks, clothing and school uniforms to

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<sup>42</sup> Brayndi Grassi, *Pro-Athletes Strike a Pose, Then Trademark It*, THE OFFICIAL REVIEW (last visited Jan. 12, 2015), <http://www.theofficialreview.com/pro-athletes-strike-a-pose-then-trademark-it/>.

<sup>43</sup> Leonard Glickman & Jonathon Sherman, *Trademarks in Sports: An Overview—Part 1 of 3*, LAW IN SPORT (Sept. 2, 2013), <http://www.lawinsport.com/articles/intellectual-property-law/item/trademarks-in-sports-an-overview>.

<sup>44</sup> *Lebron-Trademark Details*, JUSTIA TRADEMARKS, <https://trademarks.justia.com/785/78/lebron-78578837.html> (last visited Mar. 27, 2015).

<sup>45</sup> *Id.*

<sup>46</sup> *The Lebron James Family Foundation-Trademark Details*, JUSTIA TRADEMARKS, <https://trademarks.justia.com/857/10/the-lebron-james-family-foundation-85710368.html> (last visited Mar. 27, 2015).

children in need.<sup>47</sup> “I Promise” is used on wristbands for grade school children that are used to promote their self-improvement and life skills.<sup>48</sup> The last phrase James’ charitable foundation trademarked is “Wheels for Foundation.” This phrase applies to charitable services his foundation performs, such as providing educational services and support services to keep children in school (specifically school supplies).<sup>49</sup>

Another professional basketball player that used trademark law to capitalize on his popular image was Jeremy Lin. Jeremy Lin was able to capitalize on his insane story after a week into his professional career.<sup>50</sup> If you do not remember the story, Jeremy Lin was on the New York Knicks D-League team during the 2011–2012 season.<sup>51</sup> Lin was called up to the New York Knicks professional team in late February because of team needs.<sup>52</sup> During his first week of his professional career, Lin went from D-League call up to Eastern Conference Player of the Week.<sup>53</sup> This caused Twitter to go crazy where people started to use “Lin” and “insanity” together to create “Linsanity” to describe Jeremy Lin’s journey through the NBA.<sup>54</sup> After one week into his NBA career, Jeremy Lin filed “Linsanity” with the USPTO.<sup>55</sup> Some litigation ensued as to who owned the trademark because a fan tried to trademark “Linsanity” first.<sup>56</sup> The USPTO awarded the term to Lin because the fan had no ties to Jeremy Lin.<sup>57</sup> The “Linsanity”

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<sup>47</sup> *Id.*

<sup>48</sup> *I Promise-Trademark Details*, JUSTIA TRADEMARKS, <https://trademarks.justia.com/856/38/i-promise-85638713.html> (last visited Mar. 27, 2015).

<sup>49</sup> *Wheels for Education-Trademark Details*, JUSTIA TRADEMARKS, <https://trademarks.justia.com/854/07/wheels-for-education-85407375.html> (last visited Mar. 27, 2015).

<sup>50</sup> Glickman & Sherman, *supra* note 43.

<sup>51</sup> See Kelly Dwyer, *Jeremy Lin Awarded the Trademark to the Word “Linsanity,” but His Next Deal in New York Will Be Complicated*, YAHOO!SPORTS, (Mar. 30, 2012), <http://sports.yahoo.com/blogs/nba-ball-dont-lie/jeremy-lin-awarded-trademark-word-linsanity-next-deal-135054331.html>.

<sup>52</sup> *Id.*

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> Glickman & Sherman, *supra* note 43.

<sup>56</sup> Dwyer, *supra* note 51.

<sup>57</sup> *Id.*



mark applies to a number of goods that include clothing, toys, sports drinks and other beverages, book bags, and other novelty items (such as cups, mugs, water bottles, and insulating sleeves for water bottles).<sup>58</sup>

Colin Kaepernick is another example of a professional athlete that uses trademarks. Kaepernick trademarked his signature celebratory pose known as “Kaepernicking.”<sup>59</sup> Kaepernick got the idea to trademark his celebratory pose from former pro football player Tim Tebow.<sup>60</sup> Tim Tebow trademarked the use of the word “Tebowing” and the pose.<sup>61</sup> Tim Tebow’s trademark covered a variety of goods that included t-shirts, hats, plates, napkins, jewelry, holiday ornaments, educational materials, personal appearances, and CDs/DVDs.<sup>62</sup> However, Tebow is in jeopardy of losing his trademark. Tebow applied for a trademark to oversee how the mark would be used, but has yet to use the mark in commerce. If Tebow fails to use the trademark in commerce, the mark will be deemed abandoned and he will not be able to control how the mark is used.<sup>63</sup> Unlike Tebow, Kaepernick’s trademark only covers clothing, and he is not in danger of losing his trademark since he has already authorized companies to use his mark on shirts.<sup>64</sup>

In addition, professional athletes have also used the trademark process to trademark catchphrases. Some examples of professional athletes trademarking catchphrases include: Darrelle Revis’ “ Revis Island,” Marshawn Lynch’s “Beast Mode,” Brian Wilson’s “Fear the Beard,” Michael Strahan’s “Stomp You Out” and “Stomp Them Out,” Bart Scott’s “Can’t Wait,”

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<sup>58</sup> *Linsanity*, USTPO, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4801:2dmwxq.2.1> (last visited Mar. 27, 2015).

<sup>59</sup> Grassi, *supra* note 42; Josh Alper, *Colin Kaepernick Wants To Trademark “Kaepernicking,”* NBC SPORTS (Jan. 24, 2013, 7:46 AM), <http://profootballtalk.nbcsports.com/2013/01/24/colin-kaepernick-wants-to-trademark-kaepernicking/>.

<sup>60</sup> Grassi, *supra* note 42.

<sup>61</sup> *Id.*

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

<sup>64</sup> Grassi, *supra* note 42; Alper, *supra* note 59.

Lionel Messi's "LEO MESS1," the Williams sisters' "Lovee," Cristiano Ronaldo's "CR7," Terrell Owens' "I Love Me Some Me" and "Getcha Popcorn Ready," John McEnroe's "You Cannot Be Serious," Lance Armstrong Foundation's "LIVESTRONG," Derek Jeter's "Turn 2," and LeBron James' "King James."<sup>65</sup> In addition to athletes trademarking catch phrases, NBA head coach Pat Riley filed and received a trademark for the phrase "THREE-PEAT" when his Los Angeles Lakers won their third consecutive NBA title.<sup>66</sup> Athletes have also filed and received trademark protection for nicknames.<sup>67</sup> For instance, Shaquille O'Neal sued an Arizona company for selling "Shaqtus" t-shirts without his consent.<sup>68</sup> Other examples of athletes that trademarked nicknames include Vince Young's "VY" and "Invincible" and Robert Griffin III's "RGIII."<sup>69</sup>

Some samples of professional players' trademarks as documented on the Trademark Electric Search System (TESS) are attached hereto and made a part hereof as Addendum A.

## **B. Waiting Until They Turn Professional**

As mentioned earlier, college athletes are not allowed to exploit their athletic image for value and therefore find it difficult to protect their image. Some college athletes gain so much popularity while still in school that it is the university's job to protect the athlete until the athlete has the ability to protect his image with a trademark. Anthony Davis is one of those athletes that received a lot of publicity while he was a student-athlete. Davis was the first pick in the 2012 NBA Draft. Davis has a unique facial characteristic, a unibrow that gained a large amount of

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<sup>65</sup> Glickman & Sherman, *supra* note 43.

<sup>66</sup> *Id.*

<sup>67</sup> *Id.*

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

publicity.<sup>70</sup> While enrolled at the University of Kentucky, he could not profit from the value his unibrow created.<sup>71</sup> However, the University of Kentucky kept a tight leash on the merchandising of Davis' unibrow.<sup>72</sup> The athletic department at Kentucky sent half a dozen cease-and-desist letters to vendors and made twice as many phone calls to merchandisers that were close to infringing upon the University of Kentucky's trademark.<sup>73</sup> Once Davis left the University of Kentucky to pursue a professional career, he trademarked his unibrow and various catchphrases that are used in connection with it.<sup>74</sup>

Another athlete that had to wait until he turned professional to capitalize on his valuable trademark was Johnny Manziel, better known as Johnny Football. Johnny Manziel is the most popularized college athlete since Tim Tebow. In fact, Johnny Manziel may have gained more popularity as a college athlete than Tim Tebow. While attending Texas A&M University, he became more popularly known as Johnny Football. Johnny Manziel's family and Texas A&M University worked to protect the trademark while he was a collegiate athlete to ensure his eligibility.<sup>75</sup> However, once Johnny Manziel declared for the draft and became a professional athlete, he trademarked many nicknames he deemed valuable. Since entering the NFL, Johnny Manziel has filed ten trademarks. Those include: "Johnny Football," "JMAN2," "JMAN," "MANZIEL," "JIIM," "JFF," "The House That Johnny Built," "JIIM" (Roman numerals instead of the letter I's), "MANZIEL" (again, Roman numerals instead of letters), and "Johnny

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<sup>70</sup> Alon Harish, *NBA Top Draft Pick Anthony Davis Trademarks His Unibrow*, ABC NEWS (June 26, 2012), <http://abcnews.go.com/US/anthony-davis-trademarks-unibrow-phrases-ahead-nba-draft/story?id=16655206>.

<sup>71</sup> *Id.*

<sup>72</sup> *Id.*

<sup>73</sup> *Id.*

<sup>74</sup> *Id.*

<sup>75</sup> Scott Soshnick, *NCAA Handcuffs Family Use While Johnny Football Seeks Trademark*, BLOOMBERG (Nov. 14, 2012, 11:00 PM), <http://www.bloomberg.com/news/2012-11-14/johnny-football-seeks-trademark-while-ncaa-handcuffs-family-use.html>.

Cleveland.”<sup>76</sup> Manziel’s registration for “Johnny Football” on TESS is attached hereto and made a part hereof as Addendum B.

Jameis Winston also waited until he declared for the NFL draft to trademark his famous nickname. Winston’s agency, The Legacy Agency, filed for the trademark “Famous Jameis” on Winston’s behalf on February 5, 2015.<sup>77</sup> While Winston was in college, “Famous Jameis” started appearing on merchandise when an Alabama man attempted to trademark it.<sup>78</sup> The government office challenged this filing in 2013 on the grounds that it was likely to be connected to the football star, therefore protecting Winston’s image and allowing him to file once he turned pro.<sup>79</sup> When Winston filed a trademark for “Famous Jameis,” he filed it to be used in connection with t-shirts, shorts, coats, jackets, turtlenecks, sweatshirts, hooded sweatshirts, boxer shorts, pants, compression sleeves, headwear, footwear, infant wear, wristbands, uniforms, sports equipment, protective athletic wear and equipment, athletic equipment bags, Christmas tree ornaments, toys, stuffed toys, charitable fundraising, and sports camps.<sup>80</sup>

#### **IV. COLLEGE COACHES USING TRADEMARKS TO PROTECT THEIR IMAGE**

Although the NCAA has a rule prohibiting athletes from profiting from their athletic image, coaches are allowed to profit from the use of their name and image. This has led to an increasing market for college coaches. College coaches have cashed in by trademarking their own brand that distinguishes them in the spotlight of collegiate athletics. It is very common for

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<sup>76</sup> Darren Rovell, *Manziel Files for 10<sup>th</sup> Trademark*, ESPN (Sept. 4, 2014), [http://espn.go.com/nfl/story/\\_/id/11465461/johnny-manziel-cleveland-browns-files-10th-trademark-johnny-cleveland](http://espn.go.com/nfl/story/_/id/11465461/johnny-manziel-cleveland-browns-files-10th-trademark-johnny-cleveland); Eric Sandy, *Johnny Manziel Racks Up 10<sup>th</sup> Trademark With Filing ‘Johnny Cleveland,’* CLEVELAND SCENE (Sept. 5, 2014, 7:42 AM), <http://www.clevescene.com/scene-and-heard/archives/2014/09/05/johnny-manziel-racks-up-10th-trademark-filing-with-johnny-cleveland>.

<sup>77</sup> Darren Rovell, *Winston Files Trademark for ‘Famous Jameis,’* ESPN (Mar. 3, 2015), [http://espn.go.com/nfl/draft2015/story/\\_/id/12410779/jameis-winston-files-trademark-famous-jameis](http://espn.go.com/nfl/draft2015/story/_/id/12410779/jameis-winston-files-trademark-famous-jameis).

<sup>78</sup> *Id.*

<sup>79</sup> *See id.*

<sup>80</sup> *Famous Jameis*, USTPO, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4805:tp1n2y.2.1> (last updated May 31, 2015).

head coaches of major programs to trademark their names or unique brand that the public recognizes. Coaches use these trademarks on a number of goods and services to not only protect their image, but also to profit from the publicity they receive from being an icon in college athletics.

#### **A. Why College Coaches Are Trademarking Their Image**

College athletics, especially college football, receive a large amount of publicity in today's market. Since college football is such a high profile business, many coaches, and sometimes universities, have begun trademarking coaches' names and signature phrases.<sup>81</sup> One of the main reasons coaches trademarked their names and phrases are for business reasons.<sup>82</sup> By trademarking their names, college coaches want to profit from their names by licensing their trademarks to universities and companies to use their trademark.<sup>83</sup>

Another reason coaches are trademarking their name is for protection. When coaches sign their contracts with a university, the coaches may contractually grant to the universities the use of their name, image, and likeness.<sup>84</sup>

In reviewing the Trademark Electronic Search System (TESS), either the coach individually or through an entity created for his benefit or the university will be listed as the applicant/owner of the intellectual property that is being sought to be protected through a trademark.

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<sup>81</sup> Will Ashenmacher, *'Urban Meyer Knows' There's Money To Be Made in Trademarking NCAA Coaches' Names*, LEGAL SOLUTIONS BLOG (Nov. 8, 2013), <http://blog.legalsolutions.thomsonreuters.com/law-and-techology/urban-meyer-knows-theres-money-made-trademarking-ncaa-coaches-names/>.

<sup>82</sup> Debra Cassens Weiss, *College Football Coaches Seek To Cash in on Their Names*, ABA JOURNAL (Nov. 11, 2013, 7:15 AM), [http://www.abajournal.com/news/article/college\\_coaches\\_seek\\_to\\_cash\\_in\\_on\\_their\\_names/](http://www.abajournal.com/news/article/college_coaches_seek_to_cash_in_on_their_names/)

<sup>83</sup> *Id.*

<sup>84</sup> Steve Berkowitz, *Latest Trend For College Football Coaches: Trademarked Names*, USA TODAY (Nov. 6, 2013, 4:19 PM), <http://www.usatoday.com/story/sports/ncaaf/2013/11/06/college-football-coaches-pay-name-likeness-trademarks/3449829/>.

For instance Dabo Swinney, head football coach of Clemson University, has registered trademarks as listed by TESS, including “Dabo’s All In Team” and his name “Dabo Swinney,” William C. Swinney is listed as the owner. Swinney then licensed his trademark names and sells merchandise through Clemson University’s licensing program.

On the other hand, Urban Meyer, head football coach at Ohio State University, has entered into an Assignment Agreement with Ohio State University and who has trademarked his name and the phrase “Urban Knows.”<sup>85</sup> The owner as listed on TESS for both “Urban Meyer” and “Urban Meyer Knows” is Ohio State University.<sup>86</sup>

Examples of TESS registrations for various coaches are attached hereto and made a part hereof as Addendum C.

On or about May 31, 2012, when Meyer executed his original employment contract with Ohio State, he assigned to Ohio State the right to use his intellectual property, and agreed to permit Ohio State to use his persona and trademark “on or in connection with the license, manufacturing, sale, distribution, advertising, promotion of products, merchandise, goods and all other mutually agreed upon commercial purposes, including but not limited to clothing, novelty items, hats, t-shirts, ties, mugs, cups, bumper stickers, pennants, flags, and dolls,” collectively referred to as the “Goods.” A copy of said Assignment agreement is attached hereto and made a part hereof as Addendum D.

Bill Snyder, head football coach of Kansas State University entered into a License Agreement dated September 1, 2009 with Kansas State University. The License Agreement permits the use by Kansas State of names, nicknames, likeness, image, signatures, pictures,

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<sup>85</sup> Urban Meyer – the Ohio State University Employment Agreement, 5 (Nov. 28, 2011) last updated April 2015.

<sup>86</sup> Trademark Electronic Search System, Urban Meyer Knows (April 29, 2013), <http://tess2.uspto.gov/bin/showfield?f=doc&state=4802:vgpqag.4.1>; Trademark Electronic Search System, Urban Meyer (July 7, 2014), <http://tess2.uspto.gov/bin/showfield?f=doc&state=4802:vgpqag.5.1>.

quotes, phrases, interviews, and coaching records, philosophies and methods of or attributable to Bill Snyder, the term Bill Snyder family, and all derivations thereof. The agreement also denominates the license fee in the form of a royalty that Snyder is to receive for such use. A copy of the License Agreement is attached hereto and made a part hereof as Addendum E.

Finally, many coaches will grant to the university an exclusive or non-exclusive right to use the coach's personality rights. As an example the clause contained in Steve Sarkisian's Employment Contract with the University of Washington dated December 7, 2008, which states as follows:

5.c.(3) License to Use Personality Rights. Employee will grant to University the nonexclusive right to utilize Employee's personality rights, including Employee's name, voice, signature, photograph or likeness, in conjunction with promoting University events, activities, or interest. This right specifically includes the nonexclusive right to utilize Employee's personality rights in conjunction with the University's acknowledgment of third-party sponsors or vendors. notwithstanding the foregoing, all uses of Employee's personality rights shall be subject to written approval on a case-by-case basis by Employee, which approval shall not be unreasonably withheld. Prior to utilizing Employee's personality rights, University shall furnish to Employee, for the approval of Employee, University's intended use of Employee's name, voice, signature, photograph or likeness. Employee shall retain all title and interest in his personality rights except as permitted by this Agreement.

Other examples include:

John L. Fisher, Jr.'s 2015 Employment Agreement with Florida State University dated January, 2015

III.C. University's Right to Use or Authorize the Use of Coach's Name, Image, and Likeness. As consideration for the compensation provided herein and notwithstanding anything to the contrary contained in this Agreement, the parties covenant and agree that the University shall have the right to use the Coach's name, likeness, facsimile, and image for any reasonable purpose including to promote the Department of Intercollegiate Athletics and the University, for the production, promotion, and marketing of Shows, as well as with respect to any contracts or sponsorship agreements entered into between the University and any sponsor, manufacturer, media rights company, or vendor of athletic apparel, shoes, and other products or services. The University shall also have the right to

authorize, license, or to grant any such sponsor, manufacturer, media rights company, or vendor the right to use the Coach's name, likeness, or image for the purpose of promoting athletic apparel, shoes, or other products or services supplied to or on behalf of the University; provided, however, that any such use of the Coach's name, likeness, or image is in good taste and does not reflect negatively upon the Coach. The Coach covenants and agrees that he shall not have the right to enter into any endorsement or consulting agreements with any competitors of the University's exclusive sponsors, manufactures, media rights companies and/or vendors of athletic apparel, shoes or other products or services. Further, Coach covenants and agrees that the University owns and controls all rights to designate the apparel, shoes, and equipment to be used by the Department of Intercollegiate Athletics as well as all media rights to the institution's athletic programs.<sup>87</sup>

David Beaty's Employment Agreement with Kansas Athletics, Inc. dated December 8, 2014

9.E. Head Coach agrees acknowledges that Athletics and KU have agreements with apparel and/or footwear manufacturers and distributors, as well as merchandise and beverage agreements, to provide footwear, apparel, equipment, and other products to Athletics for use by the football team and staff. Head Coach agrees he shall not negotiate a separate contract with any footwear, apparel, equipment or beverage manufacturer while serving as head football coach, and that he further agrees that he will not endorse any athletic footwear, apparel, equipment and/or beverage products and will not participate in any messages or promotional appearances which contain a comparative or qualitative description of athletic footwear, apparel, equipment, or beverages. He further acknowledges that he shall comply with all terms of Athletics agreements with such apparel, footwear, equipment, merchandise, or beverage agreements that currently exist or that the University or Athletics may negotiate in the future. Athletics shall furnish the details of such agreements to Head Coach.<sup>88</sup>

Bret Bielema's Employment Agreement with the University of Arkansas dated December 4, 2012

10. University's Right to Use or Authorize the Use of Coach's Name, Image, and Likeness. Coach hereby grants, and the University accepts, a perpetual, royalty-free license anywhere in the universe to use Coach's name, likeness and image (the "License"). The scope of the License shall include, but not be limited to, the right (a) to promote and develop the Razorback brand, the Razorback Football Program, the Athletic Department, and the University; and (b) to comply with any contracts or sponsorship agreements entered into between the University and any sponsor, manufacturer, or vendor of athletic apparel, shoes, beverages or other products and services; and (c) to advance the best interests of the University,

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<sup>87</sup> John J. Fisher, Jr. – Florida State University, 2014 Employment Agreement 6 (Jan. 2014).

<sup>88</sup> David Beaty – Kansas Athletics, Inc., Employment Agreement 8 (Dec. 2014).



including, but not limited to, the right to authorize, sublicense, or grant any sponsor, manufacturer or vendor the right to use Coach's name, likeness or image for the purpose of promoting the athletic apparel, shoes, beverages or other products and services supplied to the University; provided, however that any such use of Coach's name, likeness or image is in good taste and does not reflect negatively upon Coach or the University. Coach agrees that he shall not have the right to enter into any endorsement or consulting agreements with any competitors of the University's exclusive sponsors, manufacturers, vendors, and/or suppliers of athletics apparel, shoes, beverages, or other products and services. Following the expiration or termination of this Employment Agreement, the University shall have the continued right to use the name, likeness, and image of Coach in connection with promoting and preserving the history of the Razorback Football Program and to comply with any legal obligations then existing upon the expiration or termination of the Agreement.

Additionally, the scope of the license granted to the University shall include the perpetual right to use Coach's name, likeness, and image in all Programming created, in any medium, at any time during the life of this Agreement, including, but not limited to, the right to sell game footage or videos containing images of Coach after the expiration or termination of the Agreement for any reason. Except as expressly permitted herein, however, the University shall not have the right to use Coach's name, likeness and image following the expiration or termination of this Agreement for purposes of marketing any new products or items (exclusive of any products or items in existence prior to the termination or expiration of this Agreement) without Coach's prior written approval. The parties agree to cooperate in good faith to resolve any issues of concern regarding the use of Coach's name, likeness or image following the termination or expiration of this Agreement.<sup>89</sup>

Bruce Pearl's Employment Agreement with Auburn University dated March 18, 2014

15. Assignment of Personal Endorsement Rights: Coach hereby assigns to the University any and all personal endorsement rights he possesses or might possess so long as this Agreement is in effect for use only during the Term. This assignment of personal endorsement rights by Coach to the University includes any and all endorsement rights of any nature that Coach possesses or might possess while he is the University Men's Basketball Head Coach, and the assignment includes, but is not limited to, any rights to enter shoe contracts and apparel contracts, as well as any other type of endorsement.

As part of this assignment of personal endorsement rights, Coach hereby assigns to the University any rights he has to author, co-author, publish, or contribute in any fashion to the creation of any book, magazine, program or other publication, videotape, internet website, or publication or radio/television broadcast. Said assignment will be effective at all times while Coach is Men's Basketball Head Coach at the University, and shall not extend beyond the Term.

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<sup>89</sup> Bret Bielema – Board of Trustees of the University of Arkansas, Employment Agreement 18-19 (Dec. 2012).

The assignment includes materials such as highlight videotapes or publications which feature a particular game, season, player, etc. but does not include instructional-type videos or publications by Coach unless Coach used footage or photographs of the University's basketball games or practices in such videos or publications. Coach may use video footage and photographs of the University's basketball games or practices in such manner only with the express written permission of the University, which shall not be unreasonably withheld or delayed. Coach further agrees that as part of this Agreement, he acquires no rights to use of the University logo, the University team nicknames, the University emblems, films or videotapes of any game or practice involving the University basketball team, or any trademark associated with the University or its athletic program. Coach acknowledges and agrees that such logos, nicknames, emblems, films, videotapes, or trademarks are the exclusive property of the University and that he has no right to use any of these but agrees to use or display the same in accordance with the wishes of the University in the performance of any activities pursuant to this Assignment of Personal Endorsement Rights or the Radio, Internet and Television Rights and Programs and Personal Appearances paragraph set forth below.

In exchange for the complete assignment of any and all personal endorsement rights by Coach pursuant to this Paragraph 15, and the other terms and conditions set forth in this Paragraph, the University will pay Coach a sum equal to Nine Hundred and Seventy Five Thousand Dollars (\$975,000.00) per each contract year during the Term of this Agreement, with the amount increased by Fifty Thousand (\$50,000.00) each year during the Term of this Agreement. Coach acknowledges and agrees that the University has the right to assign (and has, upon execution of the Agreement, automatically assigned) Coach's personal endorsement rights to a third party multimedia rights holder, which in turn will act as Coach's agent with respect to any and all endorsement opportunities. In exchange for the aforesaid payment, Coach shall cooperate fully with the reasonable requests of the University and the multimedia rights holder to which Coach's personal endorsement rights are assigned by the University. The amount stated above will be paid to Coach in twelve (12) equal installment payments each year of the term commencing April 1, 2014, less any withholdings required by local, state or federal law, to be paid at the end of each month.<sup>90</sup>

Once the Universities receive permission to use the rights of the trademarks, it is their duty to market and police the trademark. This is where IMG College plays a vital role. IMG College is the nation's largest sports marketing company and represents more than 200 universities in trademark licensing and marketing.<sup>91</sup> IMG College works with the College

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<sup>90</sup> Bruce Pearl – Auburn University, Employment Agreement 15-17 (Mar. 2014).

<sup>91</sup> *Services*, IMG COLLEGE, available at <http://www.imgcollege.com/services> (last visited Apr. 24, 2015).

Licensing Company to help protect, manage, and promote universities licensing programs.<sup>92</sup> Since IMG College represents the Universities licensing programs, IMG College has a responsibility to both the Universities and the coaches that have assigned their trademarks to their respective Universities to protect and market the Universities products and trademarks.

### **B. Coaches Trademark Examples and How the Trademark Is Used**

Many of the coaches at high profile programs have taken advantage of the trademark process to profit and ensure control of their brand image. One coach that has trademarked his image is Urban Meyer. Urban Meyer assigned the rights to his trademarks to Ohio State University, who now holds a trademark on his name, “Urban Meyer,” and “Urban Meyer Knows.”<sup>93</sup> Both of these trademarks are used in connection with clothing, mainly shirts, T-shirts, and hats.<sup>94</sup> Urban Meyer can also use the trademark “Urban Meyer” for charitable endeavors and any other opportunities that do not conflict with the University’s business interests.<sup>95</sup>

Gus Malzahn also applied for trademark protection for the phrases “Hurry Up No Huddle” and “Gus Bus.”<sup>96</sup> “Hurry Up No Huddle” was trademarked in connection with glassware and clothing.<sup>97</sup> “Gus Bus,” on the other hand, was trademarked for use on T-shirts.<sup>98</sup> Malzahn assigned all his endorsement rights in these two trademarks to the University of Auburn as long as he is still coaching there.<sup>99</sup> However, he retained the rights for the trademarks if he

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<sup>92</sup> *Licensing*, IMG COLLEGE, available at <http://www.imgcollege.com/licensing> (last visited Apr. 24, 2015).

<sup>93</sup> Jon Soloman, *Which College Coaches Have Tried To Trademark Their Name?*, CBS SPORTS (Aug. 21, 2014, 11:48 AM), <http://www.cbssports.com/collegefootball/eye-on-college-football/24671319/which-college-football-coaches-have-tried-to-trademark-their-name>.

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*

<sup>98</sup> *Id.*

<sup>99</sup> Jon Soloman, *Gus Malzahn Tries To Trademark ‘Hurry Up No Huddle’ Phrase*, AL.COM (last updated Nov. 22, 2013, 10:38 AM), [http://www.al.com/sports/index.ssf/2013/11/gus\\_malzahn\\_attempts\\_to\\_tradem.html](http://www.al.com/sports/index.ssf/2013/11/gus_malzahn_attempts_to_tradem.html).

uses them in any instructional-type videos or publications, as long as he does not use any footage of Auburn games or videos.<sup>100</sup>

Dabo Swinney from Clemson University also has profited from trademarking his name and numerous phrases. Swinney registered the mark “Dabo” to be used in conjunction with clothing.<sup>101</sup> He also registered “Dabo Swinney” for clothing, mainly T-shirts.<sup>102</sup> Even though coaches mainly use the trademarks in conjunction with clothing and other goods, trademarks can also be used for services. For instance, Dabo Swinney registered “Dabo’s All In Team” for the use in clothing and charitable fundraising services.<sup>103</sup>

Some of the more recent coaches to trademark their names and brands include Steve Sarkisian and Charlie Strong. Steve Sarkisian trademarked “Sark” and, as of August of 2014, has pending applications for “Coach Sark” and “Bark for Sark.”<sup>104</sup> Sarkisian is expected to abandon the “Bark for Sark” trademark because he filed the application while he was still the coach at the University of Washington.<sup>105</sup> “Sark” is used for clothing (“shirts, T-shirts, sweatshirts, sweaters, pants, shorts, skirts, dresses, wristbands, socks, hats, and shoes; headwear”) and a website “featuring information of interest to entertainment and sports enthusiasts, including information related to college football, coaching sports, fan club services, photographs, and videos.”<sup>106</sup> The other applications will be used for the similar purposes.

Charlie Strong and the University of Texas also applied for trademark protection using his name. The three trademarks the University and Charlie Strong want to protect include

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<sup>100</sup> *Id.*

<sup>101</sup> Cassens Weiss, *supra* note 82.

<sup>102</sup> *Id.*

<sup>103</sup> *Id.*

<sup>104</sup> *Id.*

<sup>105</sup> *Id.* Steve Sarkisian is now the head football coach for the University of Southern California.

<sup>106</sup> Trademark Electronic Search System, Sark (Nov. 12, 2013), <http://tess2.uspto.gov/bin/showfield?f=doc&state=4802:vgpqag.6.3>.

“Stronghorns,” “Texas Strong,” and “UT Strong.”<sup>107</sup> However, the University had to file numerous cease-and-desist letters to gain protection over these trademarks.<sup>108</sup> Right after the University of Texas announced the hiring of Strong, shirts and gear using the words that the University and Strong wished to trademark appeared online.<sup>109</sup> The items were taken down once the University contacted the merchants.<sup>110</sup> The University then moved to protect their coach and image by applying for the trademarks.<sup>111</sup>

Bo Pelini, the former Nebraska football coach, filed for three trademarks in connection with his charitable foundation.<sup>112</sup> Pelini’s charity owned the rights to all three marks.<sup>113</sup> His charity filed “Bo Pelini Foundation” to be used for charitable services to support medical research and disadvantaged children.<sup>114</sup> In addition, the charity filed for protection with “Football 101” to support cancer research, education, and procedures for those in need.<sup>115</sup> The third trademark the charity filed for was “Bo-Lieve in a Cure.”<sup>116</sup> This applied to support cancer research, education, and procedures for those in need; however, the charity abandoned this trademark in 2012.<sup>117</sup>

Frank Beamer is another college coach that filed for a trademark while coaching at Virginia Tech. Beamer filed “Beamerball” in 1999 and 2002 to be used with clothing, caps, and

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<sup>107</sup> Associated Press, *Recent Hiring of Longhorns Football Coach Strong Sets Off Licensing Fight Over Use of His Name*, FOX NEWS (Jan. 15, 2014), <http://www.foxnews.com/sports/2014/01/15/recent-hiring-longhorns-football-coach-strong-sets-off-licensing-fight-over-use/>.

<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> *Id.*

<sup>111</sup> *Id.*

<sup>112</sup> Solomon, *supra* note 93.

<sup>113</sup> *Id.*

<sup>114</sup> *Id.*

<sup>115</sup> *Id.*

<sup>116</sup> *Id.*

<sup>117</sup> *Id.*

personal coaching services in the field of football at the college level.<sup>118</sup> His employment contract, however, required that:

“The parties acknowledge that “Beamerball” and the internet and other electronic media rights to “Beamerball” are the sole property of Beamer and are not subject to the conditions of this paragraph.”<sup>119</sup>

Although Beamer filed for the trademark twice, he abandoned the efforts both times.<sup>120</sup>

Another famous college football coach that attempted to capitalize on his image was Steve Spurrier. While he was the football coach at Florida, Spurrier filed to trademark his name, “Steve Spurrier,” for the promotion of goods and services of others through the issuance of product endorsements.<sup>121</sup> Spurrier abandoned his efforts to trademark his name in 2002.<sup>122</sup> However, Spurrier attempted to file for a trademark again while coaching at the University of South Carolina. He filed “Spur’s Lid,” which covered head gear—namely hats, caps, visors, and headbands.<sup>123</sup> Spurrier also abandoned his efforts to trademark “Spur’s Lid.”<sup>124</sup> His employment Contract, however, required that:

Bill Snyder, head football coach at Kansas State University, has not trademarked his name, but he does have a licensing agreement with Kansas State University that allows the school to use his name and likeness.<sup>125</sup> This agreement also covers the use of his name on the stadium.<sup>126</sup> However, Bill Snyder is no longer owed compensation for the use of his name in connection with the stadium.<sup>127</sup>

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<sup>118</sup> *Id.*

<sup>119</sup> Employment Contract: Virginia Polytechnic Institute and State University and Frank Beamer, Article VI (effective Jan. 1, 2006), <http://www.coacheshotseat.com/CHSVirginiaTech.pdf>

<sup>120</sup> Solomon, *supra* note 93.

<sup>121</sup> *Id.*

<sup>122</sup> *Id.*

<sup>123</sup> *Id.*

<sup>124</sup> *Id.*

<sup>125</sup> Cassens Weiss, *supra* note 82.

<sup>126</sup> *Id.*

<sup>127</sup> *Id.*

College football coaches are not the only ones trademarking their names, nicknames, or phrases. Iconic basketball coaches are also using trademarks to capitalize on their popularity. John Calipari was one of the first coaches to utilize trademark law. In 1994, John Calipari filed “Refuse To Lose” with the USPTO to be used on T-shirts and sweatshirts.<sup>128</sup> Following Calipari’s lead, Mike Krzyzewski filed “Coach K” in 1997.<sup>129</sup> “Coach K” applied to printed matter, namely books and magazines regarding sports, and posters.<sup>130</sup> Copies of some of the images as trademarked are attached hereto and made a part hereof as Addendum F.

Although collegiate coaches can trademark and take advantage of their name, phrases, poses, sayings, etc., it is important for coaches to keep in mind that when taking advantage of these opportunities, the coach may not be able to use the trademarks in connection with the trademarks of the university where the coach is employed.<sup>131</sup> This is an important consideration because in all likelihood the coach has gained notoriety and recognition in association with the university where he is the head coach and many endorsements may be conditioned on the expectation that the coach will appear in university apparel.

Examples of universities who have limited the coach’s rights to use their trademarks include:

[Bruce Pearl’s Employment Agreement with Auburn University dated March 18, 2014](#)

15. Assignment of Personal Endorsement Rights: ...Coach further agrees that as part of this Agreement, he acquires no rights to use of the University logo, the University team nicknames, the University emblems, films or videotapes of any game or practice involving the University basketball team, or any trademark associated with the University or its athletic program. Coach acknowledges and

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<sup>128</sup> Refuse to Lose, USPTO, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4808:gkvapm.4.1> (last updated Apr. 27, 2015).

<sup>129</sup> Coach K, USPTO, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4808:gkvapm.2.7> (last updated Apr. 27, 2015).

<sup>130</sup> *Id.*

<sup>131</sup> The use of the university trademarks in connection with the coach’s trademarks will, in most cases, be discussed and put into the written employment contract. For example, Tom Crean’s employment agreement with Indiana University explicitly provides that Crean may not use the University trademark’s in connection with any personal endorsement activities. Tom Crean – Indiana University, Indiana University Employment Agreement 8 (2008).

agrees that such logos, nicknames, emblems, films, videotapes, or trademarks are the exclusive property of the University and that he has no right to use any of these but agrees to use or display the same in accordance with the wishes of the University in the performance of any activities pursuant to this Assignment of Personal Endorsement Rights or the Radio, Internet and Television Rights and Programs and Personal Appearances paragraph set forth below.<sup>132</sup>

Michael Curry's Head Coaching Agreement with Florida Atlantic University dated April 7, 2014:

6.B. Coach's Use of Marks. Coach has the right to use certain registered University logo(s) and mark(s) for the marketing, advertising or promotional materials for any camp activity or clinic in which he is the primary participant or with which he is affiliated. Such usage is provided without charge to the Coach and may not be transferred to any third party or entity. Use of any registered University logos or marks must be approved in writing by the Athletics Director or his designee. Upon approval Coach agrees that he will use only those registered University logos or marks that he has been granted written permission to use, and that all such use shall be in accordance with University policies and any licensing agreement between the University and its outside intercollegiate athletics licensing entity. Coach will be solely responsible for any obligations resulting from the use of the University's name, registered service marks and/or logos, and any University facility or field.<sup>133</sup>

Nick L. Saban's Head Coach Employment Contract with The University of Alabama dated January 4, 2007

4.05(c) Use of University Trademarks. Employee may neither utilize nor authorize third parties to utilize the University's trademarks or logos in connection with any outside activities permitted by this Contract without the express written permission of the Director of Athletics and the University's Licensing Director. A third party desiring to use the University's trademarks must obtain a license from the University's Licensing Program. In the event Employee, or any entity owned in whole or in part by Employee, receives permission to use the University's trademarks, such permission shall be non-exclusive and non-transferable, and such permission shall expire automatically upon Employee's resignation or termination of this Contract. Employee shall use the University's trademarks and logos only in a manner that will not cause ridicule or embarrassment to the University or be offensive to standards of good taste as reasonably determined by the University. Employee agrees that all logos, slogans, trademarks, service marks, copyrights, trade dress, color scheme, or other indicia, including all copyright and other intellectual property rights therein, which relate to the University, including any of its athletics programs, or which would compete

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<sup>132</sup> Bruce Pearl, *supra* note 90.

<sup>133</sup> Michael Curry – Florida Atlantic University Board of Trustees, Florida Atlantic University Head Coaching Agreement 7 (Apr. 2014).



with the University's registered trademarks that are developed or created by Employee or by others at Employee's direction shall be owned by the University. Employee agrees to execute and deliver to the University such instruments as the University may reasonably request in connection therewith. Employee shall be governed by the patent policy set forth in University regulation and policies.<sup>134</sup>

In many of the above mentioned contracts, the coach is prohibited from using the university trademarks in any personal endorsement activities. If the coach uses the university's trademark without prior approval from the university, this can constitute a breach of the contract and grounds for termination.

## V. CASES INVOLVING TRADEMARKS OF COACHES AND PLAYERS

One case involving a college coach occurred in 2010 when a Virginia Corporation called Know Play Apparel, Inc. filed an intent-to-use trademark application for the use of "In Tressel We Trust" to use in connection with clothing and athletic wear.<sup>135</sup> The corporation was approved for the trademark and Ohio State University ("Ohio State") subsequently filed an application opposing the grant of the trademark to Know Play Apparel, Inc.<sup>136</sup> Ohio State presented two arguments for opposing the application.<sup>137</sup> The first claim was based on priority and likelihood of confusion because Ohio State had an agreement with Coach Tressel to license and market products that portrayed him as its football coach.<sup>138</sup> Ohio State's second claim was based on a false suggestion of connection.<sup>139</sup> Ohio State would have to prove four elements to succeed in bringing this claim:

1) [the use] is a close approximation of the name or identity of a person or institution; 2) the public would recognize the mark as being a close approximation of the name or identity of the person or institution; 3) the person or institution in the trademark is not connected with the products/services offered in connection with the trademark; and 4) the fame or reputation of the named person or

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<sup>134</sup> Nick L. Saban – The University of Alabama, Head Coach Employment Contract 18 (Jan. 2007).

<sup>135</sup> Morris Turek, *Ohio State University Files Trademark Opposition Against Trademark Application for "IN TRESSEL WE TRUST,"* YOURTRADEMARKATTORNEY.COM (Apr. 17, 2011), <http://www.yourtrademarkattorney.com/ohio-state-trademark-opposition/>.

<sup>136</sup> *Id.*

<sup>137</sup> *Id.*

<sup>138</sup> *Id.*

<sup>139</sup> *Id.*

institution is of such nature that a connection with such person or institution would be presumed when [it] is used in connection with the products/services.<sup>140</sup>

There was no doubt Ohio State could have proved the first three elements. Know Play Apparel used Jim Tressel's, the public would have easily identified Jim Tressel as having a connection to it, and Jim Tressel had no connection to the products Know Play Apparel was selling.<sup>141</sup> The fourth element was the only hurdle Ohio State had to overcome. Ohio State would have had to show that Jim Tressel was so strongly associated with the University that referencing Coach Jim Tressel was the same as referencing Ohio State University.<sup>142</sup> The trademark was subsequently abandoned by Know Play Apparel, Inc. after an inter-parties decision.<sup>143</sup>

Another trademark lawsuit that involved a retired professional basketball player occurred when Jewel-Osco ran a congratulatory ad on Michael Jordan and his induction into the Hall of Fame in a special issue of Sports Illustrated.<sup>144</sup> The ad included text that recognized Jordan's accomplishments with a pair of "23" sneakers and a Jewel-Osco logo and slogan in the middle.<sup>145</sup> Jordan sued for misappropriation of his identity under the Lanham Act and for violations of his right of publicity.<sup>146</sup> Jewel claimed the ad was noncommercial speech and, therefore, protected by the First Amendment. Even though the district court agreed with Jewel, the Court of Appeals for the Seventh Circuit reversed and remanded the case holding the ad was commercial speech.<sup>147</sup> The court recognized that Jordan's achievements on the basketball court have made him a highly sought after endorser, which allowed him to reap economic benefits

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<sup>140</sup> *Id.*

<sup>141</sup> *Id.*

<sup>142</sup> *Id.*

<sup>143</sup> In *Tressel We Trust*, JUSTIA, <https://trademarks.justia.com/851/23/in-tressel-we-trust-85123176.html> (last visited Apr. 27, 2015).

<sup>144</sup> Frederick Lah, *United States: Michael Jordan Wins Appeal in Trademark and Publicity Case*, ADLAW BY REQUEST (MAR. 3, 2014), <http://www.adlawbyrequest.com/2014/02/articles/in-the-courts/michael-jordan-wins-appeal-in-trademark-and-publicity-case>.

<sup>145</sup> *Id.*

<sup>146</sup> *Id.*

<sup>147</sup> *Id.*

from his identity long-after his playing career was over allowing him to guard the use of his identity very closely.<sup>148</sup> The Court of Appeals dismissed Jewel’s argument that the ad was noncommercial speech.<sup>149</sup> The court reasoned “a gratuitous ad can only be understood as a promotional devise for the advertiser” because an athlete’s identity has commercial value and does not need gratuitous promotion.<sup>150</sup> The Court also noted the placement of the Jewel-Osco logo and slogan in the middle of the ad.<sup>151</sup> The Court held the ad was “a form of image advertising aimed at promoting goodwill for Jewel-Osco by exploiting public affection for a prominent athlete at an auspicious moment in his career.”<sup>152</sup>

The University of Texas has even faced numerous legal issues with trademarking some of their coaches’ names and identity, specifically their head football coach Charlie Strong and their head men’s basketball coach Shaka Smart.<sup>153</sup> When news broke that Texas was going to hire Smart as their head basketball coach a Louisiana Company filed for the trademark “Smart and Strong” while two Houston residents filed for the trademarks “Strong and Smart,” “Texas Strong,” and “Texas Smart.”<sup>154</sup> Most of the applicants are seeking money from the University since they attempt to sell the rights of the trademark to the University.<sup>155</sup> One thing the Athletic Director of the University of Texas learned from the hiring of Charlie Strong, was once the school hires a new coach, think of all the possible phrases you may use when marketing the coach and the University, and begin sending cease-and-desist letters to any person or company

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<sup>148</sup> *Id.*

<sup>149</sup> *Id.*

<sup>150</sup> *Id.*

<sup>151</sup> *Id.*

<sup>152</sup> *Id.*

<sup>153</sup> See Matthew Watkins, *UT Must Tussle With Outsiders for Strong and Smart Trademarks*, TEXAS TRIBUNE (Apr. 15, 2015), <http://www.texastribune.org/2015/04/15/ut-must-tussle-outsiders-strong-and-smart-trademar/>.

<sup>154</sup> *Id.*

<sup>155</sup> *Id.*

who has attempted to trademark those phrases.<sup>156</sup> Once these cease-and-desist letters are sent, some of the applicants drop their trademark applications, others settle with the University for a nominal fee.<sup>157</sup>

Although the University of Texas may not have a claim against the Louisiana Company and the Texas residents, Shaka Smart could have a § 1125 claim for false designation of origin if the phrases are used in connection with Texas Longhorn colors, phrases, symbols, etc. for commercial uses.<sup>158</sup> As described above, federal trademark registration provides for prima facie evidence of validity, meaning that another person can present rebuttal evidence as to the validity of the trademark. If Smart could prove that the phrases registered by the Louisiana Company and the Texas residents would cause a likelihood of confusion as to affiliation, association, sponsorship, or approval, the trademarks could be transferred to Smart and he could, therefore, assign or license his rights to the marks to the University of Texas.<sup>159</sup>

The University of Texas also encountered some legal issues with Virginia Commonwealth University (VCU), Smart's previous employer, when Texas attempted to trademark variations of "Havoc."<sup>160</sup> When Texas hired Smart, the University applied for the trademarks "Horns Havoc" and "House of Havoc" after the style of play Smart coined at VCU.<sup>161</sup> During Smart's time at VCU, the University filed for the trademark "Havoc" with the State office, but did not file it nationally, which possibly left the door open for Texas to

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<sup>156</sup> *Id.*

<sup>157</sup> *Id.*

<sup>158</sup> 15 U.S.C. § 1125 (2012).

<sup>159</sup> Shaka Smart could also potentially bring a right of publicity claim against the Louisiana Company and/or the Texas residents for an unauthorized commercial use of his name or likeness for commercial gain without Smart's consent.

<sup>160</sup> Michael Martz & Tim Pearrall, *Texas Seeks to Trademark Its Own Brand of 'Havoc,'* RICHMOND TIMES-DISPATCH (Apr. 9, 2015), [http://www.richmond.com/sports/college/schools/virginia-commonwealth-university/article\\_8acb765d-b81f-5998-96d4-e6f0c65abf57.html](http://www.richmond.com/sports/college/schools/virginia-commonwealth-university/article_8acb765d-b81f-5998-96d4-e6f0c65abf57.html).

<sup>161</sup> *Id.*

trademark their variations of “Havoc.”<sup>162</sup> The issue Texas faced was that VCU was the first to use “Havoc” in connection with its University and the new coach intends to continue using the “Havoc” style of play and use it to market his team across the country.<sup>163</sup> Ultimately, the University of Texas withdrew its applications on the “Havoc” variations, mainly because VCU had already registered “Havoc” at the state level.<sup>164</sup> This does not completely restrict the University of Texas from using “Havoc” to market Smart and its basketball team, but the use of the mark may ultimately depend on whether Smart actually decides to use the “Havoc” style of play.<sup>165</sup>

## VI. CONCLUSION

Trademark law offers protection to individuals who wish to protect their name and brand image. Sports create a large market that individuals can use their popularity to cash in on business ventures. For professional athletes, it is very common to trademark one’s image and brand name and reap the benefits from the popularity one receives from his or her public image. College athletics is very different when it comes to profiting from one’s image as an athlete. The NCAA has strict rules regarding amateurism that do not allow student-athletes to profit from their athletic image. However, there is no such limitation on coaches, which has allowed a new trend to emerge. Universities and coaches are now trademarking their names and iconic phrases. The trademarks allow the coaches and universities to profit and protect their name, image, and brand. These trademarks are used in a variety of ways, mainly in connection with clothing and coaching services. There is a large market when it comes to high profile coaches in college

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<sup>162</sup> *Id.*

<sup>163</sup> *Id.*

<sup>164</sup> Mike Rutherford, *Texas Suffers First Loss Under Shaka Smart, Gives Up ‘Havoc’ Trademark Pursuit*, SBATION.COM (May 4, 2015), <http://www.sbnation.com/college-basketball/2015/5/4/8546663/texas-basketball-shaka-smart-havoc-trademark>.

<sup>165</sup> *Id.*

athletics, and trademark law allows these high profile coaches to take advantage of this valuable market to become “stars.” Some say it is unfair to allow the coaches to reap all the benefits from their player’s accomplishments. Presently, there is litigation that may drastically change the landscape of college athletics, which in turn may allow another new trend regarding trademark law in college athletics to begin. For now, the major move in college athletics regarding trademark law is the use of high profile coaches trademarking their name, image, and brand.

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