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## Revoking Trademark Consent: Can It Be Done?

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# REVOKING TRADEMARK CONSENT: CAN IT BE DONE?

*Keegan Pearl\**

## ABSTRACT

In 2022, Dallas Mavericks guard, Luka Dončić, was engaged in a quiet, albeit significant legal dispute with his mother. The dispute centered around Dončić's attempt to register a new trademark to use for various goods and services. Dončić, however, previously gave his mother consent to use his name and likeness for a similar trademark, which was officially registered in 2018. Due to the likelihood of confusion, and his mother's unwillingness to cede her rights in the outdated mark, Dončić was prevented from registering his new mark. Thus, Dončić filed a cancellation petition with the USPTO, which argued he should be able to withdraw the consent he gave to his mother. By doing so, Dončić posed a novel question: can trademark consent be revoked? This Comment attempts to answer this question by analyzing the Lanham Act, surveying case law, and considering expert opinions. Alternatively, the other arguments contained in Dončić's cancellation petition are likewise evaluated to forge a way to cancel the existing trademark despite the issue of consent.

While Dončić ultimately dropped his claim against his mother, the question of revoking consent remains imperative because of its implications on college NIL deals. College athletes utilize trademarks to protect their brand and advance their NIL interests. However, whether due to minor status, business inexperience, or other time commitments, college athletes may give consent to others to register a trademark using their name and likeness. This Comment explores many practical safeguards that college athletes can take to prevent disputes such as Dončić's.

## INTRODUCTION

Earlier in 2022, the star of the Dallas Mavericks, Luka Dončić, was engaged in a trademark dispute with his mother. The dispute centered around a trademark—"Luka Dončić 7"—that Dončić's mother, Mirjam Poterbin, had officially registered in 2018.<sup>1</sup> This mark prevented Dončić from registering a new mark—"Luka Dončić 77"—and a corresponding logo because of the

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1. See Kyle Jahner, *Luka Dončić Bid to Get Trademark Back From Mom a Legal Jumpball*, BLOOMBERG L. (Sept. 19, 2022, 4:10 AM), <https://news.bloomberglaw.com/ip-law/luka-doncic-bid-to-get-trademark-back-from-mom-a-legal-jump-ball> [https://perma.cc/2EXV-6UZE].

likelihood of confusion.<sup>2</sup> However, Doncic's mother was able to register the mark in the United States because of the consent that Doncic gave her back in 2018, and she later refused to relinquish her rights in the mark.<sup>3</sup> Consequently, the only option for Doncic was to file a petition to cancel the previous trademark filed by his mother.<sup>4</sup> Among his arguments, Doncic sought to revoke his initial consent,<sup>5</sup> which is a novel question in the realm of trademarks with no case law that provides a clear answer.<sup>6</sup> Though Doncic's claim against his mother has been dropped,<sup>7</sup> this is a question that could potentially come up again because of the prevalence of college student athletes' name, image, and likeness deals (NIL). Student-athletes, who are often minors or young adults, may not have experience entering into business agreements. Thus, it can be expected that student-athletes will be guided by agents or parents when signing NIL deals.<sup>8</sup> Additionally, with the time commitment that comes with balancing schoolwork and athletics, they might be inclined to provide consent to someone else to handle the business side of their careers.

This Comment will be divided into five sections. The first section will provide a general background into trademark law. Next, the facts of Doncic's case will be given in greater detail. Moreover, this section will discuss Doncic's arguments by exploring the applicable Lanham Act on which the arguments are built. The third section will outline the likelihood of success for each of Doncic's arguments by diving deeper into the language of the Lanham Act, analyzing case law, and considering expert opinions. Subsequently, the Comment will transition to clarify, despite the dismissal of the claim, why discussing this case is important and why there is a potential for similar cases to arise. Specifically, this section will discuss the important link between this case and the emergence of NIL deals. Finally, the final section will be a conclusion that will recap the most important highlights from the discussion.

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2. *Id.*

3. *Id.*

4. *Id.*

5. *Id.*

6. *See id.*

7. Brad Townsend, *Mavericks Star Luka Doncic, mom have quietly settled trademark dispute*, THE DALLAS MORNING NEWS (Jan. 5, 2023, 3:30 PM), <https://www.dallasnews.com/sports/mavericks/2023/01/05/mavericks-star-luka-doncic-and-his-mother-have-quietly-settled-trademark-dispute/>[<https://perma.cc/ZK4T-R8XU>] ("According to public records of the case on the United States Patent and Trademark Office's website, Doncic on Dec. 5 terminated a petition that he filed on Sept. 6, in which he sought to cancel the registration of the trademark.").

8. Jahner, *supra* note 1.

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## I. TRADEMARK LAW BACKGROUND

### A. What is a Trademark?

To better understand the issues at hand in this Comment, it is helpful to explain some of the guiding principles of trademark law. First and foremost, the Lanham Act governs the law of trademarks, which is codified in Title 15 Chapter 22 of the U.S. Code.<sup>9</sup> The various sections of the Lanham Act will be identified in their coded forms. In its simplest form, a trademark “can be any word, phrase, symbol, design, or a combination of these things that identifies your goods or services.”<sup>10</sup> A product’s trade dress (i.e., product packaging and labeling) may also be trademarked.<sup>11</sup> Trademarks for trade dress hinge on whether it is functional, but this is not relevant to this inquiry.<sup>12</sup> The purpose of a trademark is to distinguish one’s goods or services from competitors and to give consumers a way to identify your goods or services in the marketplace.<sup>13</sup> Further, a trademark protects against fraud and confusion from competitors that develop similar marks.<sup>14</sup> It is imperative to understand there are limits to what can be trademarked.<sup>15</sup> Most importantly, a mark must be *distinctive* to obtain trademark rights.<sup>16</sup>

The first way a trademark can be considered distinctive is by being inherently distinctive. To determine inherent distinctiveness, it must be established whether a mark is: (1) generic, (2) descriptive, (3) suggestive, or (4) fanciful or arbitrary.<sup>17</sup> A generic mark uses an extremely common term, and such use would deprive other producers of having the right to refer to their product using common terms.<sup>18</sup> Essentially, a generic mark describes what the good or service is and can never be trademarked.<sup>19</sup> Next, a descriptive mark

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9. See 15 U.S.C. §§ 1051–1127 (2018).

10. *What is a Trademark?*, UNITED STATES PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks/basics/what-trademark> [https://perma.cc/9S73-4BZ7] (last visited Mar. 9, 2023).

11. *Trade Dress*, JUSTIA, <https://www.justia.com/intellectual-property/trademarks/trade-dress/> [https://perma.cc/M782-8KBS] (last reviewed October 2022).

12. *Id.*

13. *What is a Trademark?*, *supra* note 10.

14. *Id.*

15. *See id.*

16. See 15 U.S.C. § 1052(f) (2018).

17. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

18. *Id.*

19. *See id.*

immediately conveys the “idea of the ingredients, qualities, or characteristics of the goods.”<sup>20</sup> A descriptive mark is not inherently distinctive, but it can acquire distinctiveness, or a secondary meaning.<sup>21</sup> Finding that a mark has a secondary meaning means that the mark denotes to the consumer “a single thing coming from a single source.”<sup>22</sup> Consequently, the main inquiry in assessing secondary meaning is consumers’ attitudes toward the mark.<sup>23</sup> Finally, suggestive and fanciful or arbitrary marks are always inherently distinctive and do not require a secondary meaning.<sup>24</sup> A suggestive mark requires some imagination to reach a conclusion as to the nature of the good and services, and a fanciful or arbitrary mark “bears no relationship to the product or service to which they are applied.”<sup>25</sup>

## B. Registration Process

A trademark can acquire federal or state registration.<sup>26</sup> However, a state registration would limit enforcement of the trademark within the state that granted the registration.<sup>27</sup> Consequently, if a business that owns a state registration wants to expand outside of its state lines, it will need to apply for federal registration.<sup>28</sup> Since state registrations are rare and the *Doncic* situation deals with a federally registered trademark, only the federal registration process will be described in this section.<sup>29</sup>

The United States Patent and Trademark Office (USPTO) is the entity responsible for reviewing trademark applications.<sup>30</sup> Section 1051 states that a trademark may be registered based on the use of the mark in commerce (section 1051(a)(3)(c))<sup>31</sup> or a *bona fide* intent-to-use the mark in commerce

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20. *Id.* at 11.

21. *See id.* at 9–11; *see also* 15 U.S.C. § 1052(f) (2018).

22. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (citing *Coca-Cola Co. v. Koke Co. of Am.*, 254 U.S. 143, 146 (1920)).

23. *Id.* (citing *Coca-Cola Co.*, 254 U.S. at 146).

24. *Id.* at 791.

25. *Id.*

26. *Why Register your Trademark?*, UNITED PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks/basics/why-register-your-trademark> [https://perma.cc/5JR9-SG9Z] (last visited Mar. 9, 2023).

27. *Id.*

28. *Id.*

29. *Jahner*, *supra* note 1.

30. 15 U.S.C. § 1051(a) (2018).

31. *Id.* § 1051(a)(3)(c).

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(section 1051(b)).<sup>32</sup> Simply put, under section 1051(a), assuming a mark has acquired distinctiveness or is inherently distinctive, it can be registered if it has been used in commerce.<sup>33</sup> The phrase “used in commerce” is defined in section 1127 as “the bona fide use of a mark in the ordinary course of trade, and not merely to reserve a right in a mark.”<sup>34</sup> Despite this definition, there is an important distinction with what constitutes “used in commerce” means in relation to goods and services. A good is deemed to have been used in commerce when:

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce.<sup>35</sup>

In terms of services, “use in commerce” means that the mark is:

used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.<sup>36</sup>

On the other hand, Section 1051(b) does not require the mark to have been used in commerce.<sup>37</sup> Rather, the applicant can acquire an intent-to-use application, which gives the applicant six months, or up to an additional 36 months if multiple extensions are obtained,<sup>38</sup> to use the mark in commerce to later acquire a registration.<sup>39</sup> The intent-to-use application does not give the applicant rights per se, but as long as the six-month grace period has not ended, “a court may not enjoin it from making the use necessary for registration on

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32. *Id.* § 1051(b)(1).

33. *Id.*

34. *Id.* § 1127.

35. *Id.*

36. 15 U.S.C. § 1127 (2018).

37. *See id.* § 1051(b)(1).

38. *Trademark applications – intent-to-use (ITU) basis*, UNITED S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks/apply/intent-use-itu-applications> [<https://perma.cc/DPA3-PKUV>] (last visited Mar. 9, 2023).

39. *Id.*

the grounds that another party has used the mark after the filing of the ITU application.”<sup>40</sup>

In the event of a dispute between two holders of similar unregistered trademarks, whoever has used the mark first in commerce can establish priority and gain common law use-based rights.<sup>41</sup> However, the enforcement of the trademark would only extend to the geographical location in which the mark was used.<sup>42</sup> Also, the “use in commerce” standard may be satisfied by looking at the “totality of the circumstances” to determine priority, which examines a multitude of factors including promotional efforts.<sup>43</sup> Moreover, this standard may be satisfied even if the party does not have any sales.<sup>44</sup>

Finally, a trademark may also be registered in the United States based on an existing foreign registration.<sup>45</sup> A foreign registered trademark does not need to demonstrate use of its trademark to obtain a United States registration.<sup>46</sup>

### C. Trademark Infringement

The final piece of background information on trademarks that should be understood is trademark infringement. The Trademark Trial and Appeal Board (TTAB) is the administrative tribunal within the USPTO that handles cases dealing with registration.<sup>47</sup> However, those cases typically take the form of an examiner’s refusal to register a trademark or cancellation petitions.<sup>48</sup> The federal courts deal with cases involving infringement of a federally registered mark.<sup>49</sup> Sections 1114 and 1125(a) are the applicable sections regarding trademark infringement. The former section relates to the infringement of registered

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40. WarnerVision Ent., Inc. v. Empire of Carolina, Inc., 101 F.3d 259, 262 (2d Cir. 1996).

41. *See Why Register your Trademark?*, *supra* note 26.

42. *Id.*

43. Planetary Motion, Inc. v. Techsplosion, Inc., 261 F.3d 1188, 1195 (11th Cir. 2001).

44. *Id.*

45. Morris E. Turek, *What is the Section 44(e) Trademark Filing Basis?*, YOURTRADEMARKATTORNEY.COM, <https://yourtrademarkattorney.com/section-44e-trademark-filing/> [<https://perma.cc/DCY3-CFSD>] (last visited Aug. 26, 2023).

46. *Id.*

47. *About TTAB*, S. UNITED STATES PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks/trademark-trial-and-appeal-board/about-ttab> [<https://perma.cc/V53K-DYJD>] (last visited Mar. 10, 2023).

48. *Id.*

49. *See id.*

trademarks.<sup>50</sup> The latter relates to the infringement of unregistered trademarks<sup>51</sup> but also creates a cause of action for registered trademarks as well in the form of “false designation of origin”.<sup>52</sup> A plaintiff may plead both of these causes of actions along with infringement of their common-law, use-based rights and their state registration.<sup>53</sup> Infringement cases typically arise when the defendant applies for trademark registration and the plaintiff opposes the registration because the defendant’s mark is too similar to their own mark.<sup>54</sup>

To succeed on sections 1114 and 1125(a), a plaintiff must show that “(1) that it has a valid mark that is entitled to protection under the Act, and (2) the use of the defendant’s mark infringes, or is likely to infringe, the mark of the plaintiff.”<sup>55</sup> The party asserting infringement bears the burden of proving that the defendant’s mark will make consumers confused as to the source of a product.<sup>56</sup> The test that a court uses to determine the likelihood of confusion depends on the jurisdiction.<sup>57</sup> The TTAB uses the *DuPont* factors, which examines aspects of both marks such as the similarity between them and the strength of the marks.<sup>58</sup>

There is an important aspect of registered trademarks that must be mentioned when discussing infringement. After a trademark has been registered and used continuously for five years, the mark becomes incontestable.<sup>59</sup> This means that “a descriptive mark that has become incontestable is presumed to

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50. *See generally* 15 U.S.C. § 1114 (2018).

51. *See id.* § 1125(a)(1).

52. *Id.*

53. *See Brookfield Commc’ns., Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1046 n.8 (9th Cir. 1999).

54. *See generally* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 7 (2d Cir. 1976).

55. *Lexington Mgmt. Corp. v. Lexington Cap. Partners*, 10 F. Supp. 2d 271, 277 (S.D.N.Y. 1998) (citing *Estee Lauder, Inc. v. Gap, Inc.*, 108 F.3d 1503, 1508 (2d Cir. 1997)).

56. *Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass’n*, 651 F.2d 311, 315 (5th Cir. 1981).

57. *See, e.g., Sun Banks of Fla., Inc.*, 651 F.2d at 314; *Estee Lauder, Inc.*, 108 F.3d at 1510.

58. *See generally* *N.Y. Mercantile Exch., Inc. v. N. Am. Monetary Exch. Corp.*, Opposition No. 91225279 (T.T.A.B. Sept. 10, 2021) (analyzing several DuPont factors for NYMEX and NAMX including similarity and strength of the marks).

59. 15 U.S.C. § 1065 (2018).



have acquired secondary meaning.”<sup>60</sup> However, even if a plaintiff has an incontestable trademark, they must still prove confusion to succeed on an infringement claim.<sup>61</sup>

The ramifications of an incontestable trademark largely affect the defendant. Prior to the fifth anniversary of a plaintiff’s trademark registration, a defendant can assert the plaintiff’s mark: is generic, conflicts with earlier trademark rights, is descriptive with no secondary meaning, has been abandoned from non-use, and/or the registration was obtained by fraud.<sup>62</sup> However, after a plaintiff’s mark has been registered for five years, a defendant can only assert the plaintiff’s mark is generic, has been abandoned from non-use, and/or was obtained by fraud.<sup>63</sup> Perhaps the most common defense for defendants in trademark infringement cases is the nominative fair use defense.<sup>64</sup> This defense, which is available at any time, requires a defendant to prove that they are using the plaintiff’s mark merely to describe the plaintiff’s goods or services.<sup>65</sup>

#### D. Cancellation Petitions

In addition to infringement, one may attempt to terminate rights in another’s trademark by filing a cancellation petition.<sup>66</sup> Section 1064 allows anyone who believes they may be damaged by another’s trademark may file a petition to cancel the trademark.<sup>67</sup> Section 1064(1) states that a cancellation petition may be filed within five years after a trademark has been registered.<sup>68</sup> Additionally, like infringement defenses, section 1064(3) states that an opposer to a trademark may file a cancellation petition at any time if the registered trade-

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60. KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 408 F.3d 596, 606 (9th Cir. 2005).
  61. KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 112 (2004). (“Although § 1115(b) makes an incontestable registration “conclusive evidence . . . of the registrant’s exclusive right to use the . . . mark,” it also subjects a plaintiff’s success to “proof of infringement as defined in section 1114”).
  62. See 15 U.S.C. § 1064(3) (2018).
  63. See 15 U.S.C. § 1065 (2018); see also 15 U.S.C. § 1064 (2018).
  64. *What is Trademark Fair Use*, TRADEMARK LAWYER FIRM (Feb. 1, 2022), <https://www.trademarklawyerfirm.com/what-is-trademark-fair-use/#:~:text=%E2%80%9CFair%20use%E2%80%9D%20is%20a%20term,rather%2C%20for%20its%20descriptive%20meaning> [https://perma.cc/7RYK-BY9Y].
  65. *Id.*
  66. See generally 15 U.S.C. § 1064 (2018).
  67. *Id.* § 1064.
  68. *Id.* § 1064(1).

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mark becomes generic, has been abandoned from non-use, and/or was obtained by fraud.<sup>69</sup> Importantly, it also allows opposers to file a cancellation petition at any time if the registration was obtained contrary to section 1052(a), (b), or (c).<sup>70</sup> Relevant to Dončić's situation are section 1052(a), dealing with false association<sup>71</sup>, and 1052(c), which deals with the required consent for another to use one's likeness in a trademark.<sup>72</sup>

## II. DONČIĆ'S BASIS FOR CANCELLATION

### A. Facts

This first sub-section will begin by expanding on the facts of Dončić's predicament that were explained in the introduction to paint a more complete picture. As stated, Dončić and his multimedia company Luka99 petitioned the USPTO to cancel his mother's previously registered trademark – Luka Dončić 7.<sup>73</sup> His mother applied for registration of this mark in 2018 before being granted registration in 2020.<sup>74</sup> This mark is listed as a service mark on the United States Patent and Trademark Office and is used for services such as educational services.<sup>75</sup> It also is used for goods such as clothing and playing cards.<sup>76</sup> Dončić sought to have this trademark canceled because it is outdated as it refers to the number, seven, that Dončić wore while playing for Real Madrid in Spain before playing in the NBA.<sup>77</sup> Dončić wanted to replace the number seven with seventy-seven, which is the number he currently wears for the Dallas Mavericks.<sup>78</sup> However, the USPTO preliminarily refused to register the trademark citing the likelihood of confusion it would cause with the "Luka Dončić 7" mark.<sup>79</sup> Thus, unless his mother's trademark is canceled, Dončić will most likely not be able to register any new trademarks that include his name.

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69. *Id.* § 1064(3).

70. *See generally id.* § 1052.

71. *Id.* § 1052(a).

72. *Id.* § 1052(c).

73. Jahner, *supra* note 1.

74. LUKA DONČIĆ 7, Registration No. 5953034.

75. *Id.*

76. *Id.*

77. *See* Jahner, *supra* note 1.

78. *See id.*

79. *Id.*

It must be clarified how Doncic's mother was able to register a trademark referring to Doncic himself. Doncic's mother first registered the trademark in Slovenia, which allowed her to register the mark in the United States without any prior use in the United States.<sup>80</sup> However, section 1052(c) prevents registration of trademarks that include "name, portrait or signature identifying a particular living individual except by his written consent..."<sup>81</sup> Thus, Doncic had to give his mother consent to use his likeness for the mark in the United States, despite its registration in Slovenia. Doncic gave his mother consent to use his likeness in the trademark in 2018 at the age of 19.<sup>82</sup> Since Doncic wanted to register new and updated trademarks, he needed to find ways to cancel this trademark through either revoking this consent or other related arguments.

## B. Doncic's Arguments

The petition to cancel his mother's trademark is governed by section 1064.<sup>83</sup> This section lists the claims that one may use in a cancellation petition of a registered trademark. Like the defenses to trademark infringement, the claims available for a cancellation petition are limited after the trademark has been registered for five years.<sup>84</sup> However, section 1064(3) states that a cancellation petition can be filed at any time if a trademark has been abandoned or has been obtained contrary to subsection (a), (b), or (c) of section 1052.<sup>85</sup> As explained previously, subsection (a) covers false association<sup>86</sup>, and subsection (c) covers consent.<sup>87</sup>

In his petition, Doncic claimed that he had no affiliation with his mother or any of her goods or services.<sup>88</sup> In addition, Doncic raised the aforementioned three defenses in the petition: (1) non-use abandonment, (2) false association, and (3) withdrawing consent.<sup>89</sup> Each of these three arguments will be explained more thoroughly by looking at the law and how Doncic applied it to

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80. See LUKA DONCIC 7, Registration No. 5953034 (showing that the trademark was classified with a 44(e)-filing basis on the USPTO).

81. 15 U.S.C. § 1052(c) (2018).

82. Jahner, *supra* note 1.

83. See generally 15 U.S.C. § 1064 (2018).

84. See *id.* § 1064(1).

85. *Id.* § 1064(3).

86. *Id.* § 1052(a).

87. *Id.* § 1052(c).

88. Jahner, *supra* note 1.

89. *Id.*

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his situation. The merit and potential success of these claims will be discussed in the subsequent section.

Instances that constitute abandonment of a trademark are described in section 1127.<sup>90</sup> The first instance this section describes is one in which a trademark “has been discontinued with an intent not to resume such use.”<sup>91</sup> This intent can be inferred from the circumstances of the given situation. In other words, the section states that the non-use of a trademark for three years serves as prima facie evidence of abandonment, which means the intent to not resume use is inferred from such non-use.<sup>92</sup> The second instance that will constitute abandonment is any act or omission by the owner that causes the trademark to become generic.<sup>93</sup> In his situation, Doncic’s argument aligned more with the first instance. Doncic claims that his mother, who still lives in Slovenia, has not been using the mark anywhere in the United States.<sup>94</sup> Whether or not this abandonment claim will succeed depends on whether his mother did in fact stop using the trademark in the United States and whether she has the intent to not resume use.<sup>95</sup>

The next argument of false association is laid out in section 1052(a). This section states that a trademark may not be registered if it “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons....”<sup>96</sup> Claims of false association typically revolve around one’s fear that the trademark would lead the public to believe that they endorsed the goods or services attached to it when they did not provide such endorsement. Succeeding on a false association claim hinges largely on whether the court believes that the way in which the person’s likeness was used on the trademark would actually suggest an endorsement.<sup>97</sup> For example, as will be seen in a case later, there is no false association when a trademark references a government official, without their consent, in a derogatory way.<sup>98</sup> This is because the public would have the intuition to assume that a government official would not endorse a product that is critical of themselves.<sup>99</sup>

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90. See 15 U.S.C. § 1127 (2018).

91. *Id.*

92. *Id.*

93. *Id.*

94. Jahner, *supra* note 1.

95. See 15 U.S.C. § 1127 (2018).

96. *Id.* § 1052(a).

97. See *In re Elster*, 26 F.4th 1328, 1336 (Fed. Cir. R. 2022).

98. *Id.* at 1337.

99. See *id.* at 1336.

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For Doncic, his argument seemed to be two-fold. First, he argued that he has no affiliation with his mother's goods or services and that the trademark would suggest he does.<sup>100</sup> Second, and somewhat unique, Doncic did previously endorse the goods and services of the trademark through his prior consent.<sup>101</sup> However, he stated a false association all these years after due to his move from playing basketball in Spain to the NBA.<sup>102</sup> The trademark references his number seven which he wore in Spain, but the number seventy-seven, which he uses in the NBA, is what he stated is his current association.<sup>103</sup> Since the trademark references his name and his past number, the public would not be wrong to believe he has endorsed the products attached to the trademark. What makes this argument murky is the fact that he gave his mother consent to produce the trademark,<sup>104</sup> but this issue will be discussed later.

Doncic's final argument, revoking consent, is the most novel and contentious one.<sup>105</sup> As explained previously, section 1052(c) prevents registration of a trademark that references a living person unless that person gave another consent to use their likeness in the trademark.<sup>106</sup> The ability to withdraw this consent is something that has never been discussed previously.<sup>107</sup> This claim is connected to the previous one of false association. Doncic claimed that since he is no longer associated with his mother's trademark, he should have the ability to revoke the consent he previously gave to his mother to register an updated trademark.<sup>108</sup>

### III. LIKELIHOOD OF SUCCESS

The uniqueness of Doncic's situation and his claims make determining likely outcomes a complicated task. This section will try to formulate predictions based on what can be inferred from the language of the Lanham Act and relevant case law. Additionally, the opinions of legal experts will be discussed. Keep in mind that Doncic has dropped the claims against his mother, but as will be explained later, analyzing how the case would have turned out is vital for similar cases that will inevitably arise in the future.

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100. Jahner, *supra* note 1

101. *Id.*

102. *Id.*

103. *Id.*

104. *See id.*

105. *Id.*

106. 15 U.S.C. § 1052(a) (2018).

107. *See Jahner, supra* note 1.

108. *See id.*

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**A. Abandonment****1. § 15 U.S.C. 1127**

Doncic's claim is more in line with the abandonment of his mother's trademark by non-use rather than by her trademark becoming generic. Doncic asserted in his claim that his mother abandoned the trademark by not using it in the United States.<sup>109</sup> His mother lives in Slovenia, but in researching this case, there was no mention of whether his mother was currently using the trademark in Slovenia. For argumentative purposes, it will be assumed she was. At the time the cancellation petition was filed, three years had not passed.<sup>110</sup> However, three years passed on January 7, 2023.<sup>111</sup> This is significant because Doncic could have presented prima facie evidence of abandonment if his mother had not used the trademark for three years. If she has used the mark in Slovenia then it must be understood what the law says about a trademark registered in the United States, but only being used in a foreign country.

Despite selling services and goods under the trademark, the "Luka Doncic 7" trademark is listed as a service mark.<sup>112</sup> This could be significant because "use" has a different meaning in relation to services. However, it would seem likely that as long as his mother is using the mark in accordance with what it means for goods or services, there would be no discontinued use, thus no abandonment. No matter, it is worth looking at both definitions more closely. Use in terms of goods, as previously stated, requires the trademark to be placed on the goods and for those goods to be sold or transported in commerce.<sup>113</sup> This definition makes no mention of use outside the United States, so it is unclear whether using the trademark in Slovenia would suffice as use. However, the word "commerce" is defined in section 1127 as "all commerce which may lawfully be regulated by Congress."<sup>114</sup> Based on that definition, Doncic's mother's use of the trademark in Slovenia would not constitute use because Congress does not regulate commerce in foreign countries. This coupled with not using it in the United States would suggest the use of the mark has been discounted.

Next, to satisfy use under services, section 1127 states that the trademark is used when it is "displayed in the sale or advertising of services and the services are rendered in commerce."<sup>115</sup> Doncic claims that his mother did use the

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109. *Id.*

110. *See* LUKA DONCIC 7, Registration No. 5953034.

111. *See id.*

112. *Id.*

113. 5 U.S.C. § 1127 (2006).

114. *Id.*

115. *Id.*

trademark in the United States, meaning it was not used in commerce.<sup>116</sup> Use would also be satisfied if the services are offered “in more than one State or in the United States and a foreign country.”<sup>117</sup> Even if Doncic’s mother used the trademark in Slovenia, she would also have to use it in the United States to satisfy use.

Based on the facts of the situation, Doncic’s mother is likely to have discounted the use of the mark under the Lanham Act, no matter its designation as a goods or service mark. This would be prima facie evidence of abandonment.

## 2. *Imperial Tobacco v. Phillip Morris, Inc.*

The Lanham Act provides a potential basis for the trademark to be considered abandonment.<sup>118</sup> Therefore, it is worthwhile looking at case law for specific instances of a trademark obtained on the basis of an existing foreign registration being abandoned based on non-use in the United States. Before discussing *Imperial Tobacco v. Phillip Morris, Inc.*, remember that Doncic’s mother obtained federal registration based on an existing registration in Slovenia, which is indicated by its 44(e) filing basis.<sup>119</sup> *Imperial Tobacco* involved an abandonment claim based on the non-use of a foreign trademark.<sup>120</sup> The trademark holder acquired a federal registration based on prior registration in a foreign country.<sup>121</sup> Thus, the question in the case was whether a trademark that is federally registered in the United States based on foreign registration is abandoned when there has been no use in the United States from the date of registration.<sup>122</sup>

The court held that “such mark is not entitled to either initial or continued registration where the statutory requirements for registration cannot be met.”<sup>123</sup> The court also clarified that a trademark filed under the basis of 44(e) can be abandoned just as any other registration.<sup>124</sup> Finally, the court made an important note that if there is prima facie evidence of abandonment then there is a presumption that the trademark holder intends to continue to not use the

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116. Jahner, *supra* note 1.

117. *See* 15 U.S.C. § 1127 (2006).

118. *See id.*

119. *See Trademark Electronic Search System, supra* note 74.

120. *Imperial Tobacco Ltd., Assignee of Imperial Grp. PLC v. Philip Morris, Inc.*, 899 F.2d 1575, 1577 (Fed. Cir. R. 1990).

121. *Id.* at 1578.

122. *Id.*

123. *Id.* at 1580.

124. *Id.* at 1579.

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trademark.<sup>125</sup> This presumption can be overcome by showing sufficient excuse for the prior non-use and an intent to resume.<sup>126</sup> This means there is prima facie evidence of abandonment that if Doncic's mother had not used the trademark in the United States even though the mark is registered in Slovenia and is currently being used there. Doncic's mother would have to excuse her non-use and show that she has the intent to resume to overcome the presumption.

### 3. *Expert Opinions*

The analysis of the Lanham Act and case law would suggest that assuming Doncic is correct about his mother not using the trademark in the United States, the trademark has been abandoned. If the trademark has not been used in the United States for three years (in this case since registration) then Doncic has prima facie evidence of abandonment.<sup>127</sup>

Trademark attorney Virginia Wolk Marino of Crowell & Moring LLP conveyed a similar sentiment on the likelihood of success on the abandonment claim.<sup>128</sup> She stated that Doncic's only way to get trademark rights back in his name would be through the abandonment claim.<sup>129</sup> Her reasoning dealt more with the unlikelihood of success of his other two arguments to be discussed next.<sup>130</sup>

## B. False Association

### 1. *15 U.S.C. § 1052(a)*

Section 1052(a) is the source of the claim of false association. The language used in this section does not exactly provide any hint as to what the outcome would be. This is mainly due to the fact there was at least a prior association between the trademark and Doncic stemming from his consent. Therefore, the most helpful information will most likely come from case law. A claim under section 1052(a) for false association is brought by someone who may not hold rights in a trademark, like Doncic but is seeking to prohibit or cancel another's trademark registration.<sup>131</sup>

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125. *Id.* at 1581.

126. *Imperial Tobacco Ltd.*, 899 F.2d at 1581.

127. *See* 15 U.S.C. § 1127 (2006) ("Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.").

128. *See generally* Jahner, *supra* note 1.

129. *Id.*

130. *Id.*

131. *See* Piano Factory Grp., Inc. v. Schiedmayer Celesta GmbH, 11 F.4th 1363, 1377 (Fed. Cir. 2021) ("Unlike section 2(d), the false association component of section 2(a) is not directed to the likelihood of confusion regarding the source of goods. Instead, it is directed to the false suggestion that there is a connection between a particular person and another's goods or services.").



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## 2. *Piano Factory Group, Inc. v. Sciuedmayer Celesta GmbH*

To better understand the merits of Doncic's claim of false association, case law can serve as a resource to understand what Doncic must prove to prevail on the claim. The case of *Piano Factory Group, Inc. v. Schiedmayer Celesta GmbH* provides a clear four-factor test to apply when assessing false association claims.<sup>132</sup> The facts of the case are not relevant to this analysis. In this case, the court applied the four-factor test as related to goods.<sup>133</sup> To succeed on a claim of false association, the plaintiff needed to prove:

- (1) The mark is the same as, or a close approximation of, the name or identity previously used by another person;
- (2) the mark would be recognized as pointing uniquely and unmistakably to that person;
- (3) the person named by the mark or using the mark is not connected with the activities performed by the applicant under the mark; and
- (4) the prior user's name or identity is of sufficient fame or reputation that a connection with the person would be presumed when the applicant's mark is used to identify the applicant's goods.<sup>134</sup>

Based on these elements, Doncic may be able to prove all of the requirements. The first two elements are satisfied because the trademark explicitly uses his name.<sup>135</sup> The third factor is met if it is assumed that Doncic is truthful in his assertion that he is not connected to his mother's use of the trademark.<sup>136</sup> The fourth factor is also met because Doncic is a high-profile basketball player who is known around the entire world.<sup>137</sup>

These factors suggest that the trademark, despite the use of Doncic's old number, would almost certainly suggest a connection to Doncic. However, his claim of false association becomes complicated by the prior consent that he gave to his mother.<sup>138</sup> For example, the court also stated in *Piano Factory Group, Inc.* that a false association claim requires that the defendant use the plaintiff's name to cause a false connection between the plaintiff and the

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132. *Id.*

133. *Id.*

134. *Id.*

135. *See* LUKA DONCIC 7, Registration No. 5953034.

136. Jahner, *supra* note 1 (“The cancellation petition says Doncic is not affiliated with his mother or any goods and services his mother—who still lives in Ljubljana, Slovenia—provides.”).

137. E.g., Shlomo Sprung, *The Most Popular NBA Players on Instagram*, BOARDROOM (June 16, 2003), <https://boardroom.tv/the-most-popular-nba-players-on-instagram/> [<https://perma.cc/N96A-MQ83>] (listing Luka Doncic as the 16th most popular NBA player on Instagram with 8.3 million followers).

138. Jahner, *supra* note 1 (“If you consent, how could it be a false association?”).

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defendant's goods.<sup>139</sup> In Doncic's case, it is highly unlikely that his mother did so because Doncic gave her permission to use his name.<sup>140</sup>

### 3. *Expert Opinion*

As evident from the prior analysis, Doncic's false association claim was complex and would have been met with several questions. Mary LaFrance is an intellectual property professor at the University of Nevada at Las Vegas.<sup>141</sup> She also stated that the false association claim is complicated by Doncic's prior consent.<sup>142</sup> She noted that although section 1052(a) does not mention consent, "the mark wouldn't constitute false association even if Doncic disapproved, because the mark 'truthfully conveys' he consented in the past."<sup>143</sup> Due to his prior consent, his claim of false association would have likely failed. Doncic's claim to withdraw consent will be examined next but at this point, it does not seem possible that Doncic would have prevailed on either a false association or consent claim. For instance, if there is a false association then he would have seemingly never consented to the trademark. On the other hand, finding that he is allowed to withdraw his consent would have suggested that there was a false association.

## C. **Withdrawing Consent**

### 1. *15 U.S.C. § 1052(c)*

A claim under section 1052(c) typically occurs when the holder of a trademark uses another person's name, image, or likeness without their consent.<sup>144</sup> In those cases, the trademark holder's failure to obtain the required consent is a straightforward basis to cancel the trademark.<sup>145</sup> On the contrary, Doncic's situation was unique for two reasons. First, Doncic's claim under this section was not based on the fact that he never gave consent.<sup>146</sup> Rather, he did not concede that he gave prior consent to his mother to use his name in likeness in the trademark.<sup>147</sup> Second, Doncic requested his prior consent be

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139. *See Piano Factory Grp., Inc.*, 11 F.4th at 1380.

140. Jahner, *supra* note 1.

141. Jahner, *supra* note 1.

142. *See id.*

143. *Id.*

144. *See* 15 U.S.C. § 1052(c) (2006).

145. *See id.*

146. *See* Jahner, *supra* note 1.

147. *See id.*

withdrawn.<sup>148</sup> Withdrawing or revoking this consent is something that section 1052(c) does not address.<sup>149</sup> For instance, section 1052(c) states that registration of a trademark will be refused if consent is not given.<sup>150</sup> This suggests that the law is only concerning itself with the initial consent prior to registration. For Doncic, he gave this initial consent, which by the plain language of the statute, would not give him any basis for a claim under this section. It is his request to withdraw this prior consent that makes his claim unique and one that has never been litigated before. Any potential answer to his claim is difficult to conjure through a reading of section 1052(c).

## 2. *I.M. Wilson, Inc. v. Otvetstvennostyou “Grichko”*

Since Doncic’s claim to withdraw his consent is a novel question, there is very limited case law pertaining to the subject.<sup>151</sup> The case of *I.M. Wilson, Inc. v. Otvetstvennostyou “Grichko”* does offer relevant discussion on revoking consent. The defendant, in this case, is a Russian company that manufactures and sells dancewear products such as ballet shoes.<sup>152</sup> In 1992, the defendant granted a license to the plaintiff.<sup>153</sup> This license granted the plaintiff exclusive rights to use the defendant’s trademark in connection with the sale of its goods in the United States.<sup>154</sup> Later in 1993, the defendant’s owner signed a document that gave consent to the plaintiff to register his trademark in the United States.<sup>155</sup> This was in addition to an earlier document in which the defendant gave consent for the plaintiff to use his name in the trademark.<sup>156</sup> The two documents, presented in English, prevented the defendant from later registering the trademark with USPTO,<sup>157</sup> the defendant did not understand what was in the documents he signed, and he was under the impression that the relationship was still of a licensor/licensee nature.<sup>158</sup> Instead, the plaintiff obtained its first trademark — GRISHKO – in

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148. *Id.*

149. *See id.*

150. 15 U.S.C. § 1052(c) (2006).

151. Jahner, *supra* note 1.

152. *I.M. Wilson, Inc. v. Otvetstvennostyou “Grichko”*, 500 F. Supp. 3d 380, 394 (E.D. Pa. 2020).

153. *Id.* at 395.

154. *Id.*

155. *Id.* at 396.

156. *Id.*

157. *Id.* at 396.

158. *I.M. Wilson, Inc.*, 500 F. Supp. 3d at 396.

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reliance on the agreement signed by the defendant.<sup>159</sup> In the years following, the defendant was denied registration of that same mark due to the plaintiff's registration and, thereafter, withdrew the prior consent to no avail,<sup>160</sup> to be explained next.

In 2004, the plaintiff's registration was canceled for failure to file a renewal application, yet they were able to register the same mark again in 2007 despite the defendant's continued assertion that the consent had been withdrawn and the 1992 agreement being terminated.<sup>161</sup> Like *Doncic*, the defendant filed a cancellation petition. However, the one striking difference in this case is that the petition was based on fraud.<sup>162</sup> Nonetheless, this case presents one scenario where a consenting person may effectively withdraw their consent. Trademarks must be renewed every 10 years.<sup>163</sup> This is done by submitting a renewal application and declaration of use. The renewal application is a formal request to keep the trademark alive, and the declaration of use provides evidence that the trademark is actually being used in commerce.<sup>164</sup> However, as in *I.M. Wilson, Inc.*, when one does not submit a renewal application, the trademark is subsequently canceled.<sup>165</sup> Thus, one's rights in a trademark are taken away no matter the prior consent that was granted and consent does not have to be given again. In this case, the court found that the defendant sufficiently stated a claim against the plaintiff because they had knowledge of the defendant's previous withdrawal of consent.<sup>166</sup>

This avenue of withdrawing consent does not immediately pertain to *Doncic's* situation because it has only been about three years since registration. Nevertheless, it does provide insight into another potential option for *Doncic*. Like the ten-year requirement, a trademark owner must submit a declaration of use between the fifth and sixth year after registration.<sup>167</sup> This is a point at which *Doncic* can try to persuade his mother to not file the document if she does not do so on her own volition.

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159. *Id.*

160. *Id.*

161. *Id.*

162. *Id.* at 405.

163. *Definitions for Maintaining a Trademark Registration*, UNITED STATES PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks/maintain/forms-file/definitions-maintaining-trademark> [<https://perma.cc/SH22-VGGBL>] (last visited Apr. 3, 2023).

164. *Id.*

165. *I.M. Wilson, Inc.*, 500 F. Supp at 396.

166. *Id.* at 412.

167. *Definitions for Maintaining a Trademark Registration*, *supra* note 148.

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### 3. *In re Elster*

Since the issue of revoking consent is such a novel issue, it is worthwhile to delve into any discussion surrounding it or section 1052(c) itself. This next case, *In re Lester*, concerned a trademark applicant's appeal to the TTAB.<sup>168</sup> The plaintiff was denied registration of his trademark because it referenced Donald Trump without his consent, which violates section 1052(c).<sup>169</sup> The mark also included criticism of Trump.<sup>170</sup> The difference between this case and *Doncic's* case is that withdrawing consent was not what was in issue. The plaintiff argued that section 1052(c) unconstitutionally restricted his free speech by prohibiting him from registering his trademark.<sup>171</sup>

Somewhat surprisingly, the court agreed with the plaintiff that section 1052(c) impermissibly restricted free speech.<sup>172</sup> In supporting its decision, the court made several important determinations. First, the court consolidated this decision with another board decision in which the plaintiff was denied registration based on a false association claim.<sup>173</sup> On this issue, the court stated that since the trademark included criticism of Trump, there could be no plausible assertion that the public believed Trump endorsed the applicant's product.<sup>174</sup> Second, the court stated that "[t]he right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent."<sup>175</sup> To clarify, the right of publicity refers to an individual's ability to control the commercial use of their name and likeness.<sup>176</sup> With this comment, the court conveyed that prohibiting registration of this trademark by applying section 1052(c) would then prohibit similar trademarks from being registered because the government does not agree with the message that is being expressed.<sup>177</sup>

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168. *In re Elster*, 26 F.4th 1328, 1329 (Fed. Cir. 2022).

169. *Id.* at 1330.

170. *Id.*

171. *Id.*

172. *Id.* at 1339.

173. *See id.* at 1330.

174. *In re Elster*, 26 F.4th at 1336.

175. *Id.* at 1337.

176. *Id.* at 1336-37 (citing *Titan Sports, Inc v. Comics World Corp.*, 870 F.2d 85, 88 (2d Cir. 1989)) ("[A] court must be ever mindful of the inherent tension between the protection of an individual's right to control the use of his likeness and the constitutional guarantee of free dissemination of ideas, images, and newsworthy matter in whatever form it takes.").

177. *See In re Elster*, 26 F.4th at 1334 (citing *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 273 (1964)) ("Such criticism "does not lose its constitutional protection

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Much of this case is not applicable for the purposes of Doncic's case, but it did eliminate any First Amendment or right to publicity defenses available to Doncic. Without getting into a deep discussion on those topics, the fact that Doncic gave prior consent is the primary reason. For instance, it does not seem logical for Doncic to assert a violation of his right of publicity when he gave his mother written consent to use the trademark in the way she used it. This goes in line with the common theme of Doncic's case, which is that his prior consent is limiting his ability to effectively make an argument.

#### 4. *Expert Opinions*

In the eyes of some attorneys, whether Doncic can withdraw his prior consent focuses on two basic premises: (1) the five-year continued use requirement and (2) contract law principles.<sup>178</sup> First, trademark attorney Eric T. Fingerhut of Dykema Gossett PLLC noted that the declaration of continued use, after five years, for a trademark registered on 1052(c) grounds requires nothing more than it does for a trademark registered on more typical grounds.<sup>179</sup> In other words, the declaration of continued use for a trademark registered under 1052(c) requires evidence of commercial use, like any other trademark, and it does not require consent to be reaffirmed. This suggests that the initial consent was intended to be final and irrevocable. Although Fingerhut does believe it is possible to revoke consent because nothing in the law states that it cannot be, not requiring renewed consent seems to diminish that argument's likelihood of success.<sup>180</sup>

Second, Mary LaFrance stated that withdrawing consent would be fundamentally unfair from a contract point of view.<sup>181</sup> Contract law is implicated in this case on two grounds. First, LaFrance noted that the outcome of this case could have drastically changed if Doncic and his mother had a supplemental contract that established details such as revocability rights.<sup>182</sup> However, Doncic filing a cancellation petition would suggest there was not. Second, the written consent that was required by Doncic is, in effect, a contract, and there needs to be consideration, meaning that both sides need to promise each other something of value.<sup>183</sup> Unlike Doncic giving consent to a brand, for instance, Nike, giving consent to his mother makes it harder to find consideration.<sup>184</sup>

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merely because it is effective criticism and hence diminishes [public figures'] official reputations.”).

178. *See* Jahner, *supra* note 1.

179. *See id.*

180. *Id.*

181. *Id.*

182. *Id.*

183. *Id.*

184. *See* Jahner, *supra* note 1.

To explain, Doncic would assuredly receive some sort of compensation in return from Nike to use his name and likeness in a trademark.<sup>185</sup> In contrast, it is unknown whether Doncic has received any sort of compensation, or anything of value, in return from his mother.<sup>186</sup> Note that the consent to use his name and likeness is Doncic's consideration.

Despite this potential flaw in the agreement, LaFrance pointed out that Doncic's mother may prevail even if there was no consideration.<sup>187</sup> This would be done by his mother invoking the principles of promissory estoppel and detrimental reliance.<sup>188</sup> These principles would help her establish that even though the contract was invalid, she relied on Doncic's promise—his consent—to register the mark and sell products under it.<sup>189</sup> Additionally, she would have to prove that she would suffer some sort of loss as a result of relying on Doncic's consent.<sup>190</sup>

#### IV. IMPLICATIONS

##### A. NIL Background

Until recent developments, college athletes had historically been restricted by the NCAA from pursuing any sort of compensation regarding the use of their NIL. Severe penalties were imposed on those student-athletes that ignored this prohibition.<sup>191</sup> Those penalties included suspensions from games or, in the event the violation was discovered after their college careers were over, vacating athletic accolades.<sup>192</sup> As time wore on, student-athletes pushed for legislation that allowed them the opportunity to profit off their NIL.<sup>193</sup> This all changed with the Supreme Court's ruling in *NCAA v. Alston*.<sup>194</sup>

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185. *See id.*

186. *Id.*

187. *Id.*

188. *Id.*

189. *Id.*

190. Jahner, *supra* note 1.

191. *See* Pete Nakos, *What is NIL? Everything You Need to Know About This Major Change in College Sports*, ON3NIL (June 8, 2022), <https://www.on3.com/nil/news/what-is-nil-everything-you-need-to-know-about-this-major-change-in-college-athletics/> [<https://perma.cc/T3JY-LQDF>].

192. *E.g.*, Patrizia Rizzo, *What Happened to Reggie Bush and his Heisman Trophy*, The U.S. Sun (July 28, 2021), <https://www.the-sun.com/sport/3203489/why-reggie-bush-lose-heisman-trophy/> [<https://perma.cc/XL5Z-EET8>].

193. *E.g.*, *O'Bannon v. Nat'l Collegiate Athletic Ass'n.*, 802 F.3d 1049 (9th Cir. 2014).

194. *See* Dan Murphy, *Supreme Court unanimously sides with former college players in dispute with NCAA about compensation*, ESPN (June 21, 2021, 10:29 am),

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## B. NIL Legal History

Before the landmark decision in *NCAA v. Alston*, there were several important cases and state legislation regarding NIL deals.<sup>195</sup> First, in 2014, two plaintiffs, Ed O'Bannon (along with 19 other plaintiffs) and Sam Keller, brought suit against the NCAA, Collegiate Licensing Company (CLC), and Electronic Arts (EA) for using their NIL in an EA video game.<sup>196</sup> O'Bannon was a former basketball player at UCLA and Keller was a former football player at Arizona State University and Nebraska University.<sup>197</sup> The two had their cases consolidated<sup>198</sup> before the plaintiffs reached a settlement with EA and CLC.<sup>199</sup> After the settlement, the cases were consolidated and O'Bannon's claims against the NCAA moved to a bench trial.<sup>200</sup>

O'Bannon's main argument was that the NCAA violated U.S. anti-trust laws, specifically Sherman Act § 1, by not allowing student-athletes to receive a share of the revenues generated from the use of their NIL in broadcasts and video games.<sup>201</sup> The court analyzed this case under a Rule of Reason analysis.<sup>202</sup> Much of this analysis is outside the scope of this paper, but it should be noted that the court opted to use this analysis rather than finding the NCAA's compensation rules presumptively valid.<sup>203</sup> The court found that much of the NCAA's compensation rules were more restrictive than necessary to maintain its tradition of amateurism.<sup>204</sup> However, the court did credit the NCAA's devotion to amateurism.<sup>205</sup> Ultimately, the court called offering student-athletes compensation tied to education, the grants-in-aid, and offering them cash for

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[https://www.espn.com/college-sports/story/\\_/id/31679946/supreme-court-sides-former-players-dispute-ncaa-compensation](https://www.espn.com/college-sports/story/_/id/31679946/supreme-court-sides-former-players-dispute-ncaa-compensation) [https://perma.cc/4GG2-4AVA].

195. Nakos, *supra* note 191.

196. *O'Bannon*, 802 F.3d at 1055.

197. *Id.*

198. *Id.*

199. *Id.* at 1056; *see also* Tom Farrey, *Players, Game Makers Settle for \$40M*, ESPN (May 30, 2014, 11:18 PM), [https://www.espn.com/espn/otl/story/\\_/id/11010455/college-athletes-reach-40-million-settlement-ea-sports-ncaa-licensing-arm](https://www.espn.com/espn/otl/story/_/id/11010455/college-athletes-reach-40-million-settlement-ea-sports-ncaa-licensing-arm) [https://perma.cc/7BML-4DCJ].

200. *O'Bannon*, 802 F.3d at 1056.

201. *Id.*

202. *Id.* at 1050.

203. *See id.*

204. *Id.* at 1063.

205. *Id.* at 1072.



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NIL a “quantum leap.”<sup>206</sup> Therefore, the court found that the Rule of Reason only requires the NCAA to permit its schools to provide student-athletes up to the cost of attendance.<sup>207</sup>

### C. NCAA v. Alston

After *O’Bannon*, states began to pressure the NCAA into changing their compensation rules by introducing their own NIL bills. The first of these bills was introduced by California in 2019; the SB-206 (“Fair Pay to Play Act”).<sup>208</sup> As of July 8, 2022, twenty-nine states have passed legislation that allows student-athletes to profit from their NIL.<sup>209</sup> Ten other states have proposed NIL legislation.<sup>210</sup> This legislation not only put pressure on the NCAA, but it also became extremely important after the *NCAA v. Alston* ruling.<sup>211</sup>

While states had been introducing legislation, the landmark case of *NCAA v. Alston* was decided in 2021 by the U.S. Supreme Court. This case was similar to *O’Bannon* in that it centered mostly on Sherman Act § 1.<sup>212</sup> Under the same Rule of Reason analysis, the Court concluded that the NCAA’s compensation rules violated § 1 of the Sherman Act.<sup>213</sup> The violation was tied to the NCAA limiting the education-related benefits that schools could offer to student-athletes, such as limited graduate school scholarships, payments for academic tutoring, or paid post-eligibility internships.<sup>214</sup> However, the Court did not explicitly mention NIL.<sup>215</sup> In his concurring opinion, Justice Kavanaugh noted this omission.<sup>216</sup> He provided his concurrence to highlight the remaining NCAA compensation rules, namely those that prohibit student-athletes from

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206. *O’Bannon*, 802 F.3d at 1078.

207. *Id.*

208. *State of California NIL Laws: What College Athletes and Sponsors Need to Know*, ICON SOURCE, <https://iconsource.com/california-nil-laws/> [<https://perma.cc/6HAY-75A5>] (last visited Nov. 1, 2022).

209. Ezzat Nsouli and Andrew King, *How US Federal and State Legislatures Have Addressed NIL*, SQUIRE PATTON BOGGS (July 13, 2022), <https://www.sports.legal/2022/07/how-us-federal-and-state-legislatures-have-addressed-nil/> [<https://perma.cc/5CXS-WK37>].

210. *Id.*

211. *Id.*

212. *Nat’l Collegiate Athletic Ass’n v. Alston*, 141 S. Ct. 2141 (2021).

213. *Id.*

214. *Id.* at 2153.

215. *Id.*

216. *Id.* at 2166-67 (Kavanaugh, J., concurring).

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profiting off their NIL, that were not included in this case and nonetheless remain questionable under the Sherman Act.<sup>217</sup>

Despite not explicitly ruling on the NCAA's prohibition on student athletes benefitting from their NIL, the Court's ruling, as well as Justice Kavanaugh's concurrence, signaled to the NCAA that if it continues to restrict student-athlete's ability to benefit from their NIL then it will face severe legal ramifications.<sup>218</sup> Subsequently, the NCAA adopted an interim policy regarding NIL that went into effect on August 5, 2021.<sup>219</sup> While the world still awaits concrete federal regulation, this interim policy places the burden of regulating NIL on the states.<sup>220</sup> Thus, as it currently sits, student-athletes must abide by state laws when pursuing NIL.<sup>221</sup>

#### D. Implications of Doncic

Although Doncic dropped his claim, the importance of searching for an answer to the question of consent is not hindered because NIL is still a relatively new aspect of college athletics. In other words, it is challenging for student-athletes to be aware that a situation like Doncic's is possible when similar situations have yet to occur in the short time NIL has been around.<sup>222</sup> Likewise, federal regulation is difficult to put in place without more extensive activity highlighting the faults of the system. This makes it pivotal to ensure student-athletes are made aware of the possible consequences of certain NIL decisions before they are adversely affected.

First and foremost, student-athletes may choose to register for a trademark—themselves, or by giving consent to a third party—to protect their brand and advance their business interests.<sup>223</sup> Subsequently, the athlete, or the individual to whom they gave consent, has several options for how to monetize

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217. *Id.*

218. Marc Edelman, *What Happens Now That the Supreme Court Has Decided Alston v. NCAA?*, FORBES (June 22, 2021), <https://www.forbes.com/sites/marcedelman/2021/06/22/what-happens-now-that-the-supreme-court-has-decided-alston-v-ncaa/?sh=77182a1b7393> [https://perma.cc/3U59-5CX5].

219. Michelle Brutlag Hosick, *NCAA Adopts Interim Name, Image and Likeness Policy*, NCAA (June 30, 2021), <https://www.ncaa.org/news/2021/6/30/ncaa-adopts-interim-name-image-and-likeness-policy.aspx> [https://perma.cc/2TED-T5BE].

220. *See id.*

221. *Id.*

222. *See id.*

223. *See, e.g., Boardroom's Favorite College Athlete NIL Trademarks of 2021*, BOARDROOM, <https://boardroom.tv/best-college-sports-nil-trademarks/> [https://perma.cc/WEA5-2BT6] (Dec. 25, 2021).

the trademark, and by virtue, their brand.<sup>224</sup> They can sell goods or services under the mark as their own brand and sign NIL deals to license out the trademark to sponsors, or, on the other hand, they could initially give consent to a sponsor to register a trademark using their name, image, and likeness.<sup>225</sup>

The similarity between Dončić's case and NIL activity centers mainly around the young age of the athletes entering into these deals. The young age of the student-athletes may warrant assistance from parents or others based on two potential factors: (1) minor status and (2) inexperience. First, although a college freshman is typically eighteen or nineteen, there are times when student-athletes may be as young as seventeen when entering as freshmen.<sup>226</sup> For example, a basketball player who is a junior in high school may finish their graduation requirements earlier to reclassify as a senior and get to college a year earlier.<sup>227</sup> Likewise, high school football players routinely leave high school a semester early to enroll in college for the spring semester so that they can participate in spring football practices.<sup>228</sup> In most states, with the exception of California<sup>229</sup>, NIL laws prevent these minor athletes from entering into legally binding endorsement deals. Although minors may sign contracts, they are not mutually binding, which means that a minor can void the contract without any legal repercussion.<sup>230</sup>

Since deals with minors can be risky, sponsors would be wise to avoid contracting with them until they reach eighteen. However, if they choose to do so, sponsors could seek the consent of a parent or guardian. Likewise, there

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224. See *NIL Trademarks*, GABRIS LAW, <https://niltrademarks.com/> [<https://perma.cc/M9VX-PYQZ>] (last visited July 31, 2023).

225. *Id.*

226. *E.g.*, Jeff Borzello, *Cooper Flagg reclassifies, could be top 2025 NBA pick*, ESPN (Aug. 11, 2023, 03:39 PM), [https://www.espn.com/mens-college-basketball/story/\\_id/38173878/top-prospect-cooper-flagg-reclassifies-top-2025-nba-pick](https://www.espn.com/mens-college-basketball/story/_id/38173878/top-prospect-cooper-flagg-reclassifies-top-2025-nba-pick) [<https://perma.cc/3KBU-G3BX>] (“He will turn 18 in late December of his freshman year of college, putting him just inside the cutoff date to declare for the draft.”).

227. *E.g., id.*

228. *E.g.*, Taylor Estes, *Arch Manning Officially Makes the Move to Texas as an Early Enrollee*, HORNS247 (Jan. 5, 2023), <https://247sports.com/college/texas/Article/Texas-Longhorns-football-Arch-Manning-early-enrollee-Longhorns-2023-recruiting-class-202213367/> [<https://perma.cc/X6N8-WL3N>].

229. *E.g.*, Tamera Bennett, *Can a Minor Sign a Binding NIL Agreement in Texas?*, LINKEDIN (Oct. 13, 2021), [https://www.linkedin.com/pulse/can-minor-sign-binding-nil-agreement-texas-tamera-bennett/?trk=articles\\_directory](https://www.linkedin.com/pulse/can-minor-sign-binding-nil-agreement-texas-tamera-bennett/?trk=articles_directory) [<https://perma.cc/GY8V-XBNK>] (“In fact, the only state that allows high school student athletes to profit from their name, image, and likeness is California. California has this carve out because of the number of child actors in the state.”).

230. *Id.*

is no age restriction for registering a trademark, but a minor will not be able to enforce a trademark.<sup>231</sup> For example, in federal court, a minor would need a parent or guardian to sue for infringement unless the state law which is the minor's domicile allows minors to enter into legal contracts.<sup>232</sup> All of this would result in the likelihood that a parent, guardian, or sponsor would register a trademark of a minor through the use of consent. As a result, when minor student-athletes reach the age of eighteen, they may not be able to control the use of their trademark nor, like Doncic, register new, similar trademarks. Thus, it seems as though minor student-athletes should either wait until they reach the age of eighteen to pursue NIL deals or include in their consent that they will obtain the rights in the trademark upon turning eighteen.

Despite the reality that most college athletes are not minors, many of them may still register trademarks by granting consent to parents, guardians, or sponsors. The reason for this is due to many factors. First, college athletes are typically inexperienced when it comes to pursuing business deals. Most student-athletes may feel more comfortable if this aspect of their lives is controlled by third parties who may be more accustomed to such business opportunities.<sup>233</sup> Second, and in a similar vein, student-athletes have many obligations during their time in college.<sup>234</sup> Most notably, student-athletes, especially Division 1 athletes, must balance significant course loads with their athletic obligations. This is likely to result in some student-athletes delegating the responsibility of their NIL opportunities to others to lessen the stress that comes with these more important obligations.

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231. Jessica Suotmaa, *How Can a Minor Register a Trademark or Copyright?*, LUM LAW GROUP (Jan. 18, 2019), <https://www.lumlawgroup.com/category/intellectual-property/copyright/> [<https://perma.cc/K7KE-KAJE>] (“There is no age restriction for registering a trademark or copyright. However, a minor may not be able to enforce a trademark or copyright. In federal court, a minor needs a guardian to sue for infringement. In most state courts, a minor would also need a guardian to be in charge of the business proceedings involving a trademark or copyright owned by a minor.”).

232. *Id.*

233. See Brandon LaRose and Matthew W. Sawchak, *Not So Alike: Current Impact of NIL Administration on the Regulation of Sports Agents*, ROBINSON BRADSHAW (Aug. 2, 2021), <https://www.robinsonbradshaw.com/newsroom-publications-Not-So-Alike-Current-Impact-of-NIL-Administration-on-the-Regulation-of-Sports-Agents.html> [<https://perma.cc/9NSC-TAJE>] (“As of Aug. 2, 28 states have passed NIL statutes, and many other states have NIL-related bills pending. Most of the enacted statutes, as well as the 2021 NCAA policy on NIL, allow college athletes to hire sports agents to represent the athletes on NIL issues. However, most of these state statutes, as well as the 2021 NCAA policy, regulate student-athletes and colleges, not sports agents themselves.”).

234. Emily Dush, *Balancing Life as a Student Athlete*, THE DAILY UTAH CHRONICLE (Oct. 2, 2021), <https://dailyutahchronicle.com/2021/10/03/life-student-athlete/> [<https://perma.cc/AP8H-W2HP>].

Aside from just NIL deals, the question in Doncic's case could have, and may already have, become an issue for minors and young adults pursuing other business opportunities. For instance, recall that California was one state that made an exception for minors to enter into mutually binding legal contracts.<sup>235</sup> California made this exception because of the large number of child actors that are located within the state.<sup>236</sup> Since this is true in California, it follows that minors would be able to register and perhaps enforce a trademark in California. Outside of California, minors would need to give consent to a third party to register and enforce a trademark.<sup>237</sup> Young adults pursuing business opportunities, like college athletes above the age of eighteen, are similarly inexperienced and flooded with other obligations.<sup>238</sup> Therefore, on a broader scale, all minors and young adults who endeavor into any type of business deal may have to or may want to delegate these responsibilities to third parties. As a result, this implicates the possibility of ending up in a dispute similar to Doncic.

If a student-athlete does decide to take a similar route to Doncic, there are some practical considerations they should keep in mind. First, student-athletes should also seek out the help of attorneys to ensure they understand the legal implications of the action they are taking. Second, the granting of consent should be documented in a contract. Within this contract should be a provision stating that upon the student-athlete's discretion or age of maturity, transfer of the rights in the trademark will transfer from the parent to the student-athlete. This one provision will directly protect against issues like the one Doncic faced. Furthermore, if consent is given to someone other than a parent, the student-athlete must ensure it is someone they can trust. Doncic's situation is unique because most children would trust their mother. However, this case heightens the importance of granting consent to someone that student-athletes trust. Even when relevant transfer provisions are included, this should still be a priority to avoid any type of conflict.

To end this inquiry, one alternative solution to allowing the withdrawal of consent will be addressed. This solution should not be construed as something that will happen. Rather this solution is merely suggesting what eventual federal regulation may provide for NIL deals, or how courts might interpret such deals. Specifically focusing on the roles of parents, United States courts have routinely suggested that parents are fiduciaries to their minor children in a range of legal contexts.<sup>239</sup> A fiduciary relationship is one in which one

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235. Bennett, *supra* note 229.

236. *Id.*

237. Suotmaa, *supra* note 231.

238. See Eddie Ramos, *A Daily Routine for Actors*, THE MODERN ACTOR (Dec. 25, 2021), <https://www.the-modern-actor.com/blog/2/1/a-daily-routine-for-actors> [<https://perma.cc/X34H-7MKJ>].

239. Lionel Smith, *Parenthood is a Fiduciary Relationship*, 70 U. TORONTO L.J., 395, (2020) ("In a range of contexts, Canadian and US courts have held that parents stand in a fiduciary relationship with their minor children.").

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party acts in the best interest of another.<sup>240</sup> A common example of a fiduciary relationship is a member on the board of directors for a corporation.<sup>241</sup> These members have a duty to make decisions that are in the best interest of the corporation's shareholders.<sup>242</sup> Most fiduciary relationships are created without including explicit provisions in a contract.<sup>243</sup>

The fiduciary relationship in this case would require that the parents act in the best interest of their children.<sup>244</sup> This interpretation makes it seem logical to assert that a fiduciary relationship is created when a parent registers a trademark with the consent of their children regardless of if they are a minor. A fiduciary relationship comes with duties such as loyalty and care.<sup>245</sup> Under this framework, in the case of Doncic, his mother's refusal to cancel his trademark for her own benefit would be seen as a breach of her fiduciary duties because her actions are preventing Doncic from profiting through new trademarks.

While all parents have a non-contractual duty to act in the best interest of their children, deeming these specific relationships as fiduciary makes sense for several reasons. For example, Doncic's mother was essentially acting as a business advisor for Doncic. Doncic's consent to his mother represented him placing trust in his mother. Specifically, this represented Doncic's trust that his mother would use his trademark to further Doncic's reputation and financial wealth. As stated above, this trust was broken at the time his mother refused to give control.

## V. CONCLUSION

As the legal aspects of NIL activity continue to develop, getting out in front of these potential issues is vital. While awaiting federal regulation and potential case law, student-athletes pursuing NIL deals should seek the help of attorneys and be extremely diligent in negotiating these deals specifically when registering trademarks. Even before federal regulations regarding NIL activity are enacted, student-athletes should continually be aware of potential cases that parallel Doncic's case to understand how courts are interpreting such business relationships between parents, other third parties, and other student-athletes.

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240. Julia Kagan, *Fiduciary Definition: Examples and Why They Are Important*, INVESTOPIA (Sept. 15, 2022), <https://www.investopedia.com/terms/f/fiduciary.asp> [<https://perma.cc/5E57-874P>].

241. *Id.*

242. *Id.*

243. Robert D. Mitchell, *Informal Fiduciary Relationships*, ROBERT D. MITCHELL: EFFECTIVE SOLUTIONS FOR COMPLEX FINANCIAL, <https://www.robertdmitchell.com/informal-fiduciary-relationships> [<https://perma.cc/7BF9-LE6D>] (last visited Apr. 6, 2023).

244. *See id.*

245. Kagan, *supra* note 240.

