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Trademarks: Registering an Existing Sports Trademark in the US

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Manchester United already owns a number of trademarks in the US and is hoping to capitalise from its opening of an office on the East Coast. Ryan S. Hilbert, a Special Counsel with Sheppard Mullin Richter and Hampton LLP, offers some important considerations to take into account when registering a sports trademark in the US.

In October 2012, it was reported that Manchester United, the well-known football club and one of the world's most popular sports teams, was hoping to expand its reach into the US market by opening an office on the East Coast1. At the time, Manchester United's Vice-Chairman, Ed Woodward, told the Guardian: "There is real value there we believe from media deals, merchandising and sponsorship deals". Woodward also said that the US office would be the first such offices overseas to be opened by a football club.

According to the United States Patent & Trademark Office (USPTO), which is the governmental office in the US responsible for registering and overseeing federal trademarks, Manchester United already owns a number of federally-registered trademarks in the US2. But as more and more football clubs (and athletes) follow Manchester United's lead into the US - including some who may not be as savvy in trademark matters as Manchester United - they would be well-advised to learn about how to obtain trademark protection in the US. The following is a summary of the finer points.

Examples of sports-related trademarks in the US

The US has a long history of granting trademark protection to sports leagues and teams, including those located overseas. For example, as explained above, Manchester United owns a number of federally-registered trademarks in the United States for the MANCHESTER UNITED word mark as well for its popular crest. Similarly, the Union des Associations Européennes de Football - also known as UEFA - owns a number of federally-registered trademarks in the United States for the word marks UEFA CHAMPIONS LEAGUE, UEFA EUROPA LEAGUE, UEFA EURO 2012 and UEFA EURO 2016.

The US also has a history of granting trademark protection to athletes for those novel words or phrases an athlete has coined or with which an athlete is associated. Indeed, numerous professional athletes from a variety of sports have already obtained - or are seeking - trademark registrations from the USPTO, including well-known footballer David Beckham, who owns a registration for BECKHAM; New York Jet cornerback Darelle Revis, who owns a pending application for REVIS ISLAND; Baltimore Ravens linebacker Terrell Suggs, who owns a number of pending applications for BALL SO HARD UNIVERSITY; and former NBA great Shaquille O'Neal, who owns a pending application for SHAQTACULAR, among others.

Determining how to file a trademark application in the US

When considering whether to file a federal trademark application in the US, there are several things a non-US entity should keep in mind. First, it always good to think creatively when trying to obtain trademark rights. As an example, in 2012, Anthony Davis - a former US college basketball player and the top pick of the 2012 NBA Draft - made headlines for a number of

trademark applications he had filed for words based on his connected eyebrows, or 'unibrow'. Davis told CNBC sports business reporter Darren Rovell at the time that he filed the applications - which included marks like RAISE THE BROW, FEAR THE BROW and BROW DOWN - because he did not want anyone "to try to grow a unibrow because of [Davis] and then try to make money off of it"3. Other unique marks owned by athletes include THE BIG UNIT, which was the nickname of former MLB pitcher Randy Johnson; THAT'S A CLOWN QUESTION, BRO, a phrase made popular just last year by then-rookie Bryce Harper of the Washington Nationals MLB team; and I LOVE ME SOME ME, which is owned by former NFL player Terrell Owens. Often times, a distinctive graphical element could be very helpful as well.

Second, it is also important to think expansively. Unlike many non-US jurisdictions, the USPTO will only issue a trademark registration for those goods and services with which the mark is actually used in commerce (i.e., between two States in the US or between the US and another country). One way to avoid this limitation is by obtaining a registration outside of the US and then trying to extend that registration to the US. Indeed, this is the way in which David Beckham obtained his registration for BECKHAM, and in which Manchester United obtained at least some of its registrations for MANCHESTER UNITED. Assuming this option is unavailble, however, a non-US applicant who chooses to file in the US, but who has yet to commence use there, can also buy some time by filing an 'intent to use' (ITU) application. Section 1(b) of the Lanham Act, which is the federal statute that governs trademarks in the US, allows an applicant to file for those goods and services with which one intends to use the mark in the future so long as one has a 'bona fide' intent to do so. The benefit to filing an ITU application is that it effectively holds one's place in line until he or she can demonstrate use. Once one is able to demonstrate use of the mark in commerce, the USPTO will issue a registration with an effective date of the filing date, regardless of when such use actually commenced.

As an example of this from the sports world, former college basketball star Harrison Barnes filed an ITU application for the mark THE BLACK FALCON - his nickname in college - on 19 August 2011, almost a year before he was chosen by the Golden State Warriors as the seventh pick in the 2012 NBA Draft. At the time of filing, Barnes could not have claimed use of the mark because doing so arguably could have jeopardised his college eligibility under US amateurism rules. Now that Barnes is playing professionally and that prohibition no longer exists, however, Barnes can demonstrate use of the mark THE BLACK FALCON and obtain a federal registration. Because Barnes originally filed under Section 1(b), the effective date of his registration will date back to the date of filing - i.e. 19 August 2011.

Determining when to file a trademark application in the US

Equally, if not more, important than determining how to file in the US is determining when to file in the US. Unlike many non-US jurisdictions, one can create fully enforceable trademark rights in the US simply by using a mark there, regardless of whether one ever files an application with the USPTO. Often times, this can put pressure on a non-US applicant to file in the US as soon as possible, especially if he or she does not have any other non-US filings on which to rely. Even though there are ways around this for those marks with which US consumers are already accustomed, most of the headaches that accompany priority contests can usually be avoided altogether if a non-US entity files before anybody else does. Even an ITU application under Section 1(b) of the Lanham Act will suffice. This is especially the case for those non-US entities that do not anticipate actually using their marks in the US for several months or years.

As an example of why it is important to file early, consider the case of NBA phenomenon Jeremy Lin. In February 2012, Lin - the first American-born player of Chinese or Taiwanese

descent in National Basketball Association history - rose to national stardom when he led the New York Knicks to an unexpected winning streak. Lin's run created a global following called 'Linsanity'. By the time Lin tried to file a trademark application with the USPTO for the mark LINSANITY, however, he was shocked to learn that he was third in line. Even though it appears Lin may be able to get around those earlier-filed marks using sophisticated legal arguments, the best route would have been to merely file sooner, even if only an ITU application. In fact, it appears that at least some professional athletes are learning from Lin's mistake. On 14 January 2013, quarterback Colin Kaepernick of the San Francisco 49ers National Football League team filed an application to register the mark KAEPERNICKING with the USPTO. At present, Kaepernick is the only one with a pending application for that mark on file.

Conclusion

It is no secret that the business of sports is, and will continue to be, global in nature. As more and more non-US sports organisations and athletes seek to follow Manchester United and extend their reach into the US market, they would be wise to at least consider the points made above. Doing so could make all the difference in the world when trying to obtain trademark rights in the US.

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1. AP, 'Manchester United will open US East Coast office to grow global appeal', 23 October 2012 at www.guardian.co.uk/football/2012/oct/23/manchester-united-us-east-coast-office; see also Owen Gibson, 'It's the Manchester United States as money men look west for new riches', The Observer, 27 October 2012 at www.guardian.co.uk/football/2012/oct/27/manchester-united-states-money

2. See, e.g., US Trademark Reg. No. 4,214,045 for the Manchester United Crest for leather bags, umbrellas, and other goods in Class 18; US Trademark Reg. No. 4,266,322 for the Manchester United Crest for soaps, cosmetics, colognes and other goods in Class 3; and US Trademark Reg. No. 3,297,200 for the word mark MANCHESTER UNITED for various financial services in Class 36 and various broadcasting services in Class 38, among others.

3. Darren Rovell, Anthony Davis Trademarks His Brow, CNBC.COM, 30 June 2012, www.cnbc.com/id/47951613