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A Slam Dunk For Trademarking Sports Catchphrases

Law360, New York (July 03, 2012, 12:34 PM ET) -- Following on the heels of New York Jets quarterback Tim Tebow's attempt to register the trademark "Tebowing," Baltimore Ravens linebacker Terrell Suggs' attempt to register the trademark "Ball So Hard University," and New York Knicks phenom Jeremy Lin's attempt to register the trademark "Linsanity," it appears that another high-profile athlete, former University of Kentucky basketball standout and consensus No. 1 NBA draft pick Anthony Davis, is now getting into the trademark business.

In early June 2012, Davis filed applications with the U.S. Patent and Trademark Office to register the marks "Raise the Brow," "Fear the Brow," and "Brow Down." Davis, who is known for his connected eyebrows, or "unibrow", filed the applications in an attempt to capitalize on this unique physical attribute. In an article published by CNBC on June 25, Davis told CNBC sports business reporter Darren Rovell: "I don't want anyone to try to grow a unibrow because of me and then try to make money off of it. Me and my family decided to trademark it because it's very unique."

From a trademark perspective, Davis' decision to be proactive in protecting those phrases and slogans with which he may be associated is a sound business move and one athletes everywhere would be wise to follow. As explained in my April 25, 2012, Law360 article, "Losing the Race to Trademark Sports Catchphrases," there are essentially two ways in which to establish priority rights in a trademark.

The first is to actually commence use of the mark in commerce with certain goods and services. This is done by using the mark as a source indicator — i.e., to denote the origin of the goods or services with which the mark is used, even if that origin is unknown. The second way, which is what Davis followed, is to file an "intent-to-use" application with the USPTO under Section 1(b) of the Lanham Act.

Even though Davis must eventually use his mark in commerce in connection with the goods and services in his application, once he does so and the application matures to registration, he will own constructive nationwide rights to the mark dating back to the date of the application, regardless of when his use began.

Importantly, by being proactive, Davis is now able to effectively hold his place at the front of the line for those marks for which he is seeking protection. Had Davis waited too long, it is quite possible opportunistic fans or others would have sought to capitalize on his celebrity through the filing of their own applications. This is what happened to Tim Tebow, Terrell Suggs and Jeremy Lin, as explained in the April 25 article referenced above. It is also what happened to well-known San Francisco Giants relief pitcher Brian Wilson.

At the start of the 2010 Major League Baseball season, Wilson decided to grow a beard and then announced that he would not shave it until the Giants' season was over. Fortunately for Giants fans everywhere (but unfortunately for Wilson's face), the Giants had one of their best seasons in a long time, eventually winning the World Series. During the Giants' incredible extended run, Wilson's beard grew longer and oddly darker. The more games the Giants won, the more Wilson's beard became a focal point for the Giants' season. Soon fans began showing up to games wearing fake beards. It was out of this whole spectacle that the phrase "fear the beard" was born.

In an attempt to capitalize on his relatively newfound fame, Wilson filed an application with the USPTO on Dec. 1, 2010, for the mark "Fear the Beard" (not to be confused with Davis' "Fear the Brow" mark). Unfortunately for Wilson, a Louisiana company called Duck Commander Inc. beat him to the punch, having filed its own application for "Fear the Beard" one week earlier on Nov. 24, 2010. On April 10, 2012, the USPTO issued an office action refusing registration of Wilson's application on the ground that it is likely to be confused with Duck Commander's now-registered mark "Fear the Beard."

Thankfully, all is not lost for Wilson. It is well known that a mark that falsely suggests a connection with a person, living or dead, is not entitled to registration under Section 2(a) of the Lanham Act. Over the years, celebrities and athletes have been able to use this provision in order to successfully challenge others' attempts to register words or phrases with which those celebrities or athletes have become associated.

As an example, in Buffett v. Chi-Chi's Inc., 226 U.S.P.Q. 428 (TTAB 1985), singer Jimmy Buffet successfully contested a restaurant's application to register the mark "Margaritaville" based on evidence that the public associated that term, which was the title of Buffett's most famous song, with Buffett. Similarly, earlier this year, Tim Tebow successfully contested a pair of applications for the mark "Tebowing" on the ground that they falsely suggested a connection to Tebow.

It is unknown whether or how Wilson will respond to the pending office action for his mark "Fear the Beard." However, one thing is certain. By being proactive and filing applications for marks like "Raise the Brow" now, Davis has been able to, for the most part, successfully preempt those who would try to capitalize on his fame before him. In doing so, Davis also has smoothed his path to registration in the USPTO, thereby saving himself considerable time and legal fees. Thus, one can say it is better to "Raise the Brow" than "Fear the Beard."

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