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Game On: Navigating the Trademark Arena - Risks, Registrations, and Statutory Interpretations

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GAME ON: NAVIGATING THE TRADEMARK ARENA – RISKS, REGISTRATIONS, AND STATUTORY INTERPRETATIONS

By Angelika Avagian

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I. INTRODUCTION

With the rise of Name, Image, and Likeness (“NIL”), athletes are increasingly becoming aware of their intellectual property rights, including rights in their own names. From icons like Michael Jordan to up and coming enterprisers like Bronny James, athletes are registering their names as federal trademarks to capitalize on their fame, maximize their earnings beyond their playing career, and restrict infringers from doing the same. However, obtaining federal trademark¹ protection is a meticulous process that can result in legal and commercial consequences, especially when it comes to the trademark registration of a person’s name.

The most recent case highlighting the technicalities of name trademarking is that of NBA star Luka Dončić (“Dončić”). Shortly after Dončić’s star debut with the Dallas Mavericks in June 2018, Dončić, then 19 years old, consented to his mother, Mirjam Poterbin (“Poterbin”), registering his full name as a federal trademark. Dončić wore the number seven on his jersey. In November of the same year, Poterbin registered Dončić’s full name in the stylized mark “LUKA DONCIC 7,” listing herself as the owner of the mark in the application, while Dončić was excluded from a status as an owner. The United States Patent and Trademark Office (“USPTO”) approved the registration in 2020, and Poterbin has been the rightful owner of “LUKA DONCIC 7” since then. A year later, in an attempt to take control of the federal trademark rights to his name, Dončić revoked his initial consent and sued Poterbin by filing a petition to cancel the “LUKA DONCIC 7” mark at the Trademark Trials and Appeals Board (“TTAB”). The petition set forth the following claims: (1) that Dončić was no longer affiliated with the mark, (2) the mark remained registered without Dončić’s consent, and (3) Poterbin had abandoned the mark. The dispute was unprecedented in trademark law territory, as no court had ruled on the revocation of consent for a granted name registration before.² Ultimately, Dončić and Poterbin privately settled the matter. Although the litigation came to an end, the question remains:

1. References to trademark registration made throughout this paper should be understood as references to federal trademark registration.

2. See Michael McCann, *Luka Dončić Embroiled in Unusual Trademark Dispute with His Mother*, YAHOO SPORTS (Sept. 13, 2022, 9:00 AM), https://sports.yahoo.com/luka-don-embroiled-unusual-trademark-130000080.html?guce_referrer=aHR0cHM6Ly93d3cuZ29vZ2xiLmNvbS8&guce_referrer_sig=AQAAAH4TTSy-W8miFne9TmdY5btEZ5vPFgxvW2R7Gu_3B5jX2RU7DycxQKCSv9mQcXpqS5hwYam5GHPqBZEfh1yOzWk9Msuk6ujeYSRdMqXdC_w6qxL6Xg68P4fbRjkRE6VMHIVvDQEphvi_7yC7xyfhvtjppaafNxNeZJ0TagBAGodw [https://perma.cc/FDB3-5QRQ].

under what legal principles can athletes revoke their consent to trademark registrations of their names filed and owned by third parties such as parents, guardians, agents, or corporations?

Fundamental contract principles include the right to revoke consent; however, revocation of consent remains unclear for trademark registrations due to sparse case law and the lack of legal framework under Lanham Act Section 1052(c) (“Section 1052(c)”) ³ Nonetheless, preventing athletes from controlling and managing trademarks in their own names goes against the very essence of trademark law and will undoubtedly be a critical issue for NIL negotiations. Now that athletes of all ages and levels are increasingly generating income from their NIL, a Doncic-like case is likely to be filed again in the near future.

This paper examines the risks athletes may encounter when consenting for third parties to register their names as trademarks and aims to shed light as to why consent revocation is a crucial legal tool courts should consider when interpreting Section 1052(c). To aid in understanding the significance of trademark law in sports, Part I will briefly introduce the current state of trademark law and illustrate the relationship between athletes and trademarks over the years. Part II will identify the issue of consent revocation under Section 1052(c) and evaluate the risks athletes may face, including disputes similar to Doncic’s, when allowing third parties to register their names as trademarks. Part III will refer to common law and statutory principles from differing areas of the law to provide interpretational guidelines for analyzing the effect of consent under Section 1052(c). It will also address other shortcomings of name registrations in the context of underage talent. Finally, Part IV will provide existing legal challenges in the Lanham Act that athletes may use if they are left with no option other than to litigate a registered mark that references them.

II. THE SIGNIFICANCE OF TRADEMARK LAW IN SPORTS

Before social media, athletes were limited in the ways they could connect with and build their fanbase.⁴ The concept of personal branding was not as widely recognized or emphasized in earlier decades, with athletes often

3. 15 U.S.C. § 1052(c).

4. Owyn Tong-Jones, *How Has Social Media Changed the Athlete-Fan Relationship*, SPORTS DIGITAL TRANSFORMATION (Mar. 17, 2021), <https://sportdigitaltransformation.media/2021/03/17/how-has-social-media-changed-the-athlete-fan-relationship/> [https://perma.cc/AUW6-Y4HE].

relying on their respective team endorsements and sponsorships as opposed to taking control of their personal image and narratives.⁵ Communicative engagement between athletes and fans was relatively non-existent, notwithstanding brief post-game interviews that were exclusive to top players. Even in such interviews, it was uncommon for athletes to market themselves or their identities. With the rise of social media, various platforms have provided athletes with the chance to showcase their personalities, connect and communicate with fans, and pursue commercial opportunities outside of their sport.⁶ As a result, the value of athletes' personal brands started to drastically increase and athletes began to unlock new ways to influence society and capitalize on their fame.⁷ As social media, athlete-fan relationships, and influencer marketing transformed, so did the length of an athlete's career and personal brand.⁸ Today, the success of athletes is no longer determined solely by athleticism and skill but also by their distinctive brand and image.⁹ Players' identities, achievements, and affiliations are encapsulated within their brands and trademarks play an indispensable role in the process.¹⁰

A. *Fundamentals of the Lanham Act*

The Lanham Act, enacted in 1946, provides the legal framework and standards for federal trademark registration.¹¹ It outlines the application requirements, rights, and responsibilities of trademark applicants and

5. See Thilo Kunkel, *How Michael Jordan Revolutionized the Sneaker Industry—and Our Relationship to Shoes*, TEMPLE U.:TEMPLE NOW (Apr. 3, 2023), <https://news.temple.edu/news/2023-04-03/how-michael-jordan-revolutionized-sneaker-industry-and-our-relationship-shoes> [<https://perma.cc/8A2V-3RZA>].

6. Tong-Jones, *supra* note 4.

7. *How Social Media Has Changed Personal Branding in Sports*, JMP, <https://www.jmpuk.com/insights/how-social-media-has-changed-personal-branding-in-sport> [<https://perma.cc/7NJP-2P2N>].

8. See generally *id.*

9. See Igor Demcak, *The Role of Trademarks in Sports: How Athletes and Teams Protect Their Brands*, TRAMATM (Aug. 2023), <https://www.tramatm.com/blog/category/media/the-role-of-trademarks-in-sports-how-athletes-and-teams-protect-their-brands> [<https://perma.cc/TH5H-LJER>].

10. *Id.*

11. Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051–1127).

owners.¹² Section 1127 of the Act defines a trademark as “any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods”¹³ A trademark must be “distinctive of a person’s goods or services and . . . used in a manner that identifies those goods or services and distinguishes them from the goods or services [manufactured or sold by] others.”¹⁴ At its very core, a trademark is a source identifier. Traditionally, a trademark’s source-identifying function provided consumer protection, fostered efficient communication in the market economy, and motivated product differentiation.¹⁵ Today, trademark law has broadened to protect brand identities by expanding the scope, revenues, and value of brands in addition to the traditional protections.¹⁶

B. Trademarks & Athletes Over the Years

The significance of trademarks in the sports industry is multifaceted. First, trademarks play a pivotal role in enhancing brand recognition, recollection, engagement, and allegiance among fans.¹⁷ This is because “[a]thlete trademarks are easily distinctive . . . based on their conceptual strength, or more likely, based on commercial power.”¹⁸ Sports fans can effortlessly link an athlete’s mark with the athlete to whom it belongs.¹⁹ Moreover, trademarks hold substantial commercial value for athletes by generating revenue through sponsorship and endorsement deals, merchandise sales, and

12. 15 U.S.C. §§ 1051–1127.

13. 15 U.S.C. § 1127.

14. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (AM. L. INST. 1995); *see generally* 15 U.S.C. § 1127.

15. *See* JANE C. GINSBURG ET AL., TRADEMARK AND UNFAIR COMPETITION LAW: CASES AND MATERIALS 58–60 (6th ed. 1991).

16. ROSS DAVID PETTY, BRANDING LAW: A GUIDE TO THE LEGAL ISSUES IN BRAND MANAGEMENT 29 (2016).

17. Demcak, *supra* note 9.

18. Abby R. Glaus, *The Intersection of Trademark Law, Athletes, and Money: A “Three-Peat,”* 32 MARQ. SPORTS L. REV. 583, 592 (2022).

19. *Id.*

domestic and global licensing opportunities.²⁰ These opportunities allow athletes to earn from their names, images, and likenesses in perpetuity.²¹ Professor J. Gordon Hylton of Marquette University Law School noted that “[A]thletes like Michael Jordan and Tiger Woods have earned millions of dollars above and beyond their income from competing in sports by successfully exploiting their own names”²² In fact, according to Forbes, trademarks linked to Tiger Woods’ name and likeness are valued at \$38 million, David Beckham’s at \$26 million, and Kobe Bryant’s at \$18 million.²³ By leveraging trademarks, athletes can also establish and protect their distinctive brand identities and enhance their marketability.²⁴ Lastly, trademarks serve as shields against counterfeiting by providing legal protections for mark holders to protect their fans and revenue streams.²⁵ In 2016, Michael Jordan won a trademark infringement battle, in the China Supreme People’s Court, against Qiaodan Sports Company Limited over the use of his name.²⁶ Last year, David Beckham filed a lawsuit against multiple counterfeiters for trademark infringement demanding 1.58 million euros in damages.²⁷ Athletes of the current era are capable of safeguarding a broad range of their

20. Demcak, *supra* note 9.

21. Daniel Foster, *Who Owns Your Name? The Trend and Economic Impact of Personal Trademarks in the NCAA NIL Aftermath*, 16 J. BUS. ENTREPRENEURSHIP & L. 139, 146 (2023).

22. J. Gordon Hylton, *The Over-Protection of Intellectual Property Rights in Sport in the United States and Elsewhere*, 21 J. LEGAL ASPECTS SPORT 43, 44 (2011).

23. Alexandra J. Roberts, *Athlete Trademarks: Names, Nicknames, and Catchphrases*, in THE OXFORD HANDBOOK OF AMERICAN SPORTS LAW 471, 471–472 (Michael A. McCann ed., 2017).

24. Demcak, *supra* note 9.

25. *Id.*

26. *Michael Jordan’s Trademark Victory in China: A Lesson Learned for International Companies*, ARMSTRONG TEASDALE LLP (Dec. 9, 2016), <https://www.armstrongteasdale.com/thought-leadership/michael-jordans-trademark-victory-in-china-a-lesson-learned-for-international-companies/> [https://perma.cc/PF4W-5RST].

27. Ellie Henman, *Defend it Like Beckham: David Beckham Locked in Secret Multi-Million Legal Battle Over Fake Products Including Clothes and Fragrances*, THE SUN (Jan. 18, 2024, 6:47 PM), <https://www.the-sun.com/sport/10131894/david-beckham-legal-battle-counterfeiters/> [https://perma.cc/E9MG-DVPB].

brands through these trademark benefits and “have the ability to enforce [and defend] their trademarks, more than the average person.”²⁸

However, trademarking within sports was not widespread from the outset. The relationship between trademarks and athletes transformed in 1988 when prominent NBA coach Pat Riley registered the phrase “Three-Peat”²⁹ as his Los Angeles Lakers were chasing a third consecutive NBA championship title.³⁰ Although the Lakers were unsuccessful in securing their “three-peat,” Riley’s successful trademark registration secured him a sweet spot for monetary success in the coming years.³¹ By maintaining the mark, each time a sports team achieves a “Three-Peat,” Riley receives royalty payments for the use of his trademark.³² Riley’s success paved the way for athletes, teams, and organizations alike to approach intellectual property rights in unprecedented ways.

Since 1989, several athletes have registered and received trademark protections over slogans, logos, and their given names. In 2014, the International Licensing Industry Merchandisers’ Association reported that the number of registered trademarks in the sports industry steadily increased, with “\$907 million in royalty revenue on retail sales of \$16.6 billion.”³³ Throughout the athlete trademarking frenzy, one type of mark particularly stood out: name registrations.³⁴ Notable examples include Usain Bolt’s name for sports

28. Glaus, *supra* note 18, at 584.

29. THREE-PEAT, Registration No. 1552980.

30. Virgil Villanueva, *There Were 4 Occasions When Pat Riley Cashed in for the Use of “Three Peat” Trademark*, BASKETBALL NETWORK (Mar. 25, 2023, 11:53 PM), <https://www.basketballnetwork.net/off-the-court/four-occasions-pat-riley-cashed-in-for-the-use-of-three-peat-trademark> [https://perma.cc/CLQ5-5XHV].

31. *Id.*

32. See Chris Jones, *Heat Stroke*, ESPN (June 12, 2013, 3:00 AM), https://www.espn.com/nba/story/_/id/9360787/miami-heat-owner-pat-riley-had-foresight-patent-three-peat-not-three-heat-espn-magazine [https://perma.cc/E578-TYYF].

33. Christopher Psihoules & Jennette Wiser, *Highlights from Today’s Game: Trademark Coverage on the Offensive*, 88 N.Y. St. B.A. J. 11, 11 (July/Aug. 2016).

34. *Trademark Registration Of Names, Nicknames And Slogans By Athletes And Celebrities Continues*, GRIMES LLC INTELLECTUAL PROPERTY ATTORNEYS (Nov. 22, 2013, 3:46 PM), <https://www.gandb.com/2013/11/trademark-registration-of-names-nicknames-and-slogans-by-athletes-and-celebrities-continues/> [https://perma.cc/M9GH-YSVP].

equipment, clothing, and bags³⁵ and Tim Tebow's name for jewelry.³⁶ David Beckham registered his name for clothing, toys, toiletries, entertainment services, and more.³⁷ Meanwhile Ronda Rousey has registrations covering action figures and boxing gloves.³⁸ The trend continued to grow over the years, but it was not until after a 2021 Supreme Court case concerning collegiate athlete compensation that it truly surged.

C. Along Comes Alston

The landmark decision in *NCAA v. Alston*³⁹ amplified the wave of athletes seeking trademark registrations by dismantling certain National Collegiate Athletic Association ("NCAA") restrictions and creating a more permissive environment for collegiate athletes to commercialize their NIL rights and seek trademark protection for their personal brands.⁴⁰ The Alston ruling prompted the NCAA to suspend NIL rules for all collegiate athletes and adopt an interim policy that allowed collegiate athletes to receive compensation in exchange for the use of their NIL, deferring to the states to set their own rules and regulations. Once the policy was set in place on July 1, 2021, thousands of collegiate athletes started to take advantage of the NIL opportunities available at their fingertips.⁴¹ Some were quick to recognize and avail their intellectual property rights by filing trademark applications for logos related to their names.⁴²

35. USAIN BOLT, Registration No. 4200790.

36. TIM TEBOW, Registration No. 6608800.

37. See Preston Heard, *Soccer Star David Beckham Comes to Atlanta (but Only to File Suit)*, WOMBLE BOND DICKINSON (Aug. 22, 2023), <https://georgiaiplit.com/2023/08/22/soccer-star-david-beckham-comes-to-atlanta-but-only-to-file-suit/#page=1> [<https://perma.cc/9S25-QWFX>].

38. RONDA ROUSEY, Registration No. 5959754.

39. *NCAA v. Alston*, 141 S. Ct. 2141 (2021).

40. See Foster, *supra* note 21, at 139–41.

41. See *Hagens Berman: Expanded Class-Action Lawsuit Against the NCAA Seeks Broader Damages for College Athletes Denied Name, Image and Likeness Rights*, ACROFAN (July 28, 2021, 9:23 AM), <https://us.acrofan.com/detail.php?number=507277> [<https://perma.cc/F4MB-F37A>].

42. Foster, *supra* note 21, at 157.

With subsequent changes in NIL regulations, heightened awareness of trademark rights amongst athletes, and increased commercial opportunities, name registrations have become strategic tools with the power to create early personal branding platforms that can carry into future careers and dealmaking opportunities.⁴³ Name registrations are further strategic because athletes have a much greater chance of obtaining federal trademark rights when seeking protection of their names, which are inherently associated with and unique to them.⁴⁴ Nevertheless, “in light of [the] newfound freedom” to build, develop, and monetize their personal brands, athletes are at an increased risk of losing the rights to their names as their “[NIL] increases in commercial value and competes with its familial value.”⁴⁵ Even though athletes are typically guided in the process by agents, parents, or other entities,⁴⁶ there are still several legal risks they can face – especially when consenting for others to register and receive federal trademark rights to their names.

III. THE PURPOSE AND LIMITATIONS OF SECTION 1052(C)’S CONSENT REQUIREMENT

Section 1052(c) of the Lanham Act provides that no trademark can be registered which “[c]onsists of or comprises a name [...] identifying a particular living individual except by his written consent.”⁴⁷ Its purpose is to “protect living individuals from the commercial exploitation of their names, except where those living individuals agree to such exploitation as evidenced by the written consent by the individual to the applicant’s use and registration of his name as a mark.”⁴⁸ Yet, the provision fails to specify anything about the consent beyond that the referenced individual must provide the

43. *Id.* at 158.

44. Roberts, *supra* note 23, at 476.

45. Claire Lenz-Dean, *That’s Your Name, Don’t Wear it Out: How NCAA Athletes Can Avoid Crossing the Invisible Line Between Name and Brand*, 58 TULSA L. REV. 295, 296 (2023).

46. Kyle Jahner, *Luca Doncic Bid to Get Trademark Back From Mom a Legal Jump Ball*, BLOOMBERG LAW (Sept. 19, 2022, 2:10 AM), https://www.bloomberglaw.com/bloomberglawnews/ip-law/XDN1GIDO00000?bna_news_filter=ip-law#jcite [<https://perma.cc/H4HL-D88U>].

47. 15 U.S.C. § 1052(c).

48. *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.P.A.*, 32 U.S.P.Q. 2d 1192, *3 (T.T.A.B. 1994); *In re D.B. Kaplan’s Delicatessen*, 225 U.S.P.Q. 342, 344 (T.T.A.B. 1985).

consent in written form. As the statute stands, it is unclear for how long the written consent is valid, whether it can be revoked, and if so, on what grounds. One scholar, Michael D. Hobbs Jr. of the law firm Troutman Pepper Hamilton Sanders LLP, noted that it is “one of those statutory areas where they didn’t seem to contemplate whether consent could be revoked.”⁴⁹ Any formalities or contractual considerations that the written consent should adhere to are also uncertain, and the Trademark Manual of Examining Procedure (“TMEP”) provides no specific guidance.⁵⁰

These ambiguities are incredibly alarming because providing consent under Section 1052(c) means relinquishing “all ownership rights in one’s name and agree[ing] to allow another to register one’s name as a mark.”⁵¹ Moreover, the Federal Circuit, a federal appeals court with exclusive appellate jurisdiction over certain legal areas such as trademark law⁵² does not take consents to register lightly. On several occasions,⁵³ the Federal Circuit has advised the TTAB that although consent alone is not enough to determine decisions by the USPTO, when a person provides consent to register a mark, the consent will nonetheless receive significant weight.⁵⁴

However, the procurement of consent is not always as simple or lawful as it seems, particularly when the consenting party is relatively young and inexperienced, there is clear unequal bargaining power, or terms are manipulated to prevent one side from understanding the full scope of the agreement. For example, what happens if a company obtains consent from a fifteen-year-old athlete to register their name as a trademark and does not apply for the registration until ten years later? What about when an agent misreads convoluted deal terms which results in an athlete inadvertently consenting to

49. Kyle Jahner, *Luca Doncic Bid to Get Trademark Back From Mom a Legal Jump Ball*, BLOOMBERG LAW (Sept. 19, 2022, 2:10 AM), https://www.bloomberglaw.com/bloomberglawnews/ip-law/XDN1GIDO000000?bna_news_filter=ip-law#jcite [<https://perma.cc/H4HL-D88U>].

50. TMEP § 813 (May 2024).

51. *In re D.B. Kaplan’s Delicatessen*, 225 U.S.P.Q. at 344.

52. *Court Jurisdiction*, U.S. CT. OF APPEALS FOR THE FED. CIR., <https://cafc.uscourts.gov/home/the-court/about-the-court/court-jurisdiction/> [<https://perma.cc/4TMZ-LY2V>].

53. *In re N.A.D. Inc.*, 754 F.2d 996, 998–99 (Fed. Cir. 1985); *Bongrain Intern. (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1484–85 (Fed. Cir. 1987).

54. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:85 (5th ed. 2024).

another party registering their name? What if a parent or manager misrepresents the implications of such consent, obtains it, and reaps the revenue from the athlete's trademarked name perpetually? These are just a few of the many grave scenarios that athletes are susceptible to when third parties seek to obtain their consent for trademark registrations under Section 1052(c). And as the statute currently reads, no preventative or restorative protections are afforded under it.

A. When Athlete Names Become Someone Else's Game

Third-party actors obtaining trademark rights to athletes' names can compromise these athletes' ability to dictate the narrative of their personal brand. The potential consequences can extend beyond the realms of intellectual property, influencing endorsement deals, marketing opportunities, and the overall trajectory of an athlete's career.⁵⁵ When the USPTO grants a trademark registration, the registered trademark owner gains several rights and protections. These include exclusive use of the mark in commerce (with respect to the goods and services it was registered for) and a legal presumption of the mark's ownership and validity⁵⁶ that under certain circumstances may be irrebuttable.⁵⁷ Additionally, mark holders receive nationwide priority of the mark over other users even without nationwide use⁵⁸ and are eligible for assistance from the U.S. Customs Service in deterring imports of infringing goods.⁵⁹ Other benefits include the ability to use the U.S. registration as

55. Igor Demcak, *The Role of Trademarks in Sports: How Athletes and Teams Protect Their Brands*, TRAMATM (Aug. 2023), <https://www.tramatm.com/blog/category/media/the-role-of-trademarks-in-sports-how-athletes-and-teams-protect-their-brands> [<https://perma.cc/TH5H-LJER>].

56. 15 U.S.C. § 1115 (registration of a mark "shall be prima facie evidence of the validity of the registered mark. . .and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the [certificate]"); *Equine Techs, Inc. v. Equitechology, Inc.*, 68 F.3d 542, 544–45 (1st Cir. 1995).

57. 15 U.S.C. § 1065 (eventual eligibility for incontestable status, completely preventing challenge on the grounds that registrant's mark is merely descriptive).

58. *Dawn Donut Co., Inc. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 362 (2d Cir. 1959) (holding that "§1072 affords nationwide protection to registered marks, regardless of the areas in which the registrant actually uses the mark").

59. 15 U.S.C. § 1125(b) (disallowing the entry at customs of improperly marked or labeled goods).

the basis for extending protection in other countries⁶⁰ and authority to take legal action against trademark infringers to defend their marks.⁶¹ The latter is especially important for athletes since “[o]ne of the most common trademark violations in sports is the unauthorized use of distinctive team logos and signs.”⁶² Another common violation is the production and sales of counterfeit merchandise.⁶³ In 2022, the National Intellectual Property Rights Coordination Center seized nearly \$100 million in counterfeit sports merchandise.⁶⁴ Through the protections that come with being a registered trademark owner, athletes can prevent infringers from using and distributing products or making false associations with their NIL without their permission. A registered trademark also receives protection for ten years and may be renewed indefinitely to retain these protections as long as the mark is in use directly or through a licensee.⁶⁵

Moreover, trademark ownership rights unlock a myriad of opportunities for commercialization and profit generation. Mark holders can leverage their registered marks through licensing, franchising, and merchandising prospects.⁶⁶ They can also engage in sponsorship and endorsement deals or

60. 15 U.S.C. § 1141(b) (simplified process for extending trademark rights to countries that have signed the Paris Convention for the Protection of Industrial Property art. 6quinquies, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305).

61. “Trademark infringement occurs in the sports industry when someone uses, adapts, distributes, reproduces, or sells logos, labels, merchandise, and phrases without the permission of the trademark owner and this activity causes consumers to be confused as to the source of the products, items or images that carry the trademark.” See Ben Bailey, *The Impact of Trademark Infringement in the Sports Industry*, RED POINTS (Nov. 8, 2023), <https://www.redpoints.com/blog/trademark-infringement-in-sports/> [<https://perma.cc/9NEE-QQK6>].

62. *Id.*

63. *Id.*

64. *IPR Center Seizes \$97.8M in Counterfeit Sports Merchandise During Annual Operation Team Player*, U.S. IMMIGR. & CUSTOMS ENF’T (Aug. 4, 2022),

<https://www.ice.gov/news/releases/ipr-center-seizes-978m-counterfeit-sports-merchandise-during-annual-operation-team> [<https://perma.cc/T54T-YSE8>].

65. 15 U.S.C. § 1058(a).

66. See generally *Discovering Business Potential: The Dynamics of Trademark Franchising*, AUMIRAH, <https://aumirah.com/discovering-business-potential-the-dynamics-of-trademark-franchising/> [<https://perma.cc/Z2T7-BFU5>].

co-brand with other companies.⁶⁷ Not only do these measures contribute to the profitability of the trademark but also help build and strengthen the brand over time, whether it is “through social media, merchandise sales, advertising campaigns, or [even] signing autographs.”⁶⁸

Therefore, if a third party owns the federal trademark rights to an athlete’s name, such third party also owns such rights and revenue streams which may continue in perpetuity. As such, the athlete is unable to leverage the benefits of nationwide trademark protection to control the commercialization of his or her personal brand, and worse, potentially prohibited from exploiting his or her namesake as a trademark in various verticals. This is particularly harmful to young talent in sports and entertainment because the potential for exploitation in those industries tends to be vastly greater compared to more traditional occupations.⁶⁹ Prior to entering such agreements, athletes would need to be aware of and undoubtedly understand that any time a third party seeks their consent to register a trademark that references them, providing such consent could “permanently jeopardize their ability to use their name . . . as a mark if it creates a likelihood of confusion with [the] mark[] that references them.”⁷⁰ Whether the third party is a parent, agent, or corporate entity, consenting to a third party’s registration of one’s name as a trademark can ultimately lead to long-term consequences including profit losses, harm to one’s reputation and image, and legal disputes. Regardless of how prominent or amateur an athlete may be, the risks are very real—just ask Luka Doncic.

67. See generally Amrisha Chati, *5 Ways to Make Money From Your Trademark*, TRADEMARKIA (Aug. 3, 2023), <https://www.trademarkia.com/blogs/how-to-guides/5-ways-to-make-money-from-your-trademark> [<https://perma.cc/5944-3V76>].

68. Devin Ricci & Randy Cangelosi, *The Ball’s In Their Court Now: NCAA’s NIL Policy Provides Trademark Opportunities For College Athletes*, LA. L. BLOG (Jul. 2, 2021), <https://www.louisianalawblog.com/business-and-corporate/the-balls-in-their-court-now-ncaas-nil-policy-provides-trademark-opportunities-for-college-athletes/> [<https://perma.cc/9KPH-CSFT>].

69. *Prinze v. Jonas*, 345 N.E.2d 295, 301 (N.Y. 1976) (Fuchsberg, J., dissenting).

70. Michael McCann, *Luka Doncic Embroiled in Unusual Trademark Dispute with His Mother*, YAHOO SPORTS (Sept. 13, 2022, 9:00 AM), https://sports.yahoo.com/luka-don-embroiled-unusual-trademark-13000080.html?guce_referrer=aHR0cHM6Ly93d3cuZ29vZ2xiLmNvbS8&guce_referrer_sig=AQAAAH4TTSy-W8miFne9TmdY5btEZ5vPFgxvW2R7Gu_3B5jX2RU7DycxQKCSv9mQcXpqS5hwYam5GHPqBZEfh1yOzWk9Msuk6ujeYSRdMqXdC_w6qxL6Xg68P4fbRjkRE6VMHIVvDQEphvi_7yC7xyfhvtjppaafNxEZJ0TagBAGodw [<https://perma.cc/FDB3-5QRQ>].

B. Dončić's Dispute

Similar to his basketball career, Dončić's trademark portfolio started quite early. In 2018, Dončić signed a rookie contract with the Dallas Mavericks.⁷¹ In November of the same year, when Dončić was 19 years old, Poterbin filed a trademark application for "LUKA DONCIC 7" with his consent.⁷² According to Dončić, he relied on Poterbin at the time "to provide assistance and guidance for his off-court business opportunities."⁷³ The mark was officially registered by the USPTO on January 7, 2020, and the categories protected, included computer game software, books, bags and backpacks, game accessories, notecases, coin holders, exercising equipment, and more.⁷⁴

Dončić's legal team stated that his "maturation," "strong interest in pursuing philanthropic endeavors," and "personal team of athletic and business professionals" ultimately fostered his "desire to consolidate his business interests and take control of his name and identity."⁷⁵ In June 2021, Dončić's company, Luka 99 Inc., filed two applications for trademark registrations with the USPTO. The first application, filed on June 11, 2021, was to register the mark "LUKA DONCIC" for use in various goods and services categories.⁷⁶ The second application, filed on June 23, 2021, was to register "ORIGINAL HOOPS OF LUKA DONCIC" for basketball hoop sets.⁷⁷ Both applications were denied by the USPTO under Lanham Act Section

71. *Luka Dončić Officially Signs Rookie Contract with Dallas Mavericks*, NBA NEWS (Jul. 10, 2018, 3:53 AM), <https://www.nba.com/news/dallas-mavericks-luka-doncic-signs-rookie-contract> [<https://perma.cc/XLV6-KQXB>].

72. LUKA DONCIC 7, Registration No. 5,953,034.

73. Petition to Cancel at 2, *Luka99, Inc. v. Poterbin*, (T.T.A.B. 2022) (No. 92080484).

74. LUKA DONCIC 7, Registration No. 5,953,034.

75. Petition to Cancel, *supra* note 73, at 2; *see also* Marc Stein, *Dončić Petitions For Trademark Control*, THE STEIN LINE (Sept. 6, 2022), <https://marcstein.substack.com/p/doncic-petitions-for-trademark-control> [<https://perma.cc/C28A-QMJM>].

76. U.S. Trademark Application Serial No. 90/768,512 (filed Jun. 11, 2021).

77. U.S. Trademark Application Serial No. 90/790,987 (filed Jun. 23, 2021).

§1052(d) because the marks were too similar to Poterbin’s registered trademark, “LUKA DONCIC 7,” and would likely cause consumer confusion.⁷⁸

Despite numerous attempts to negotiate a transfer of ownership for Poterbin’s registration, Poterbin did not relinquish her ownership rights to the mark.⁷⁹ On July 23, 2021, Doncic provided Poterbin with a written revocation of his initial consent to the “use and registration of any trademarks or service marks that contained any indicia of or related to him, including the mark at issue.”⁸⁰ As a last resort to gain control over his name, Doncic challenged the already-existing mark through legal proceedings at the TTAB. On September 6, 2022, Doncic’s company filed a petition for cancellation of the “LUKA DONCIC 7” mark.⁸¹

The petition asserted three claims as a basis for cancellation. The first claim alleged a false suggestion of a connection to Doncic pursuant to Lanham Act Section 1052(a).⁸² The second alleged that after Doncic’s written revocation, the mark remained registered without consent under Section 1052(c).⁸³ The third claim alleged that Poterbin had abandoned her rights to the mark since she had not been using the mark on any goods and services identified in its registration.⁸⁴ Poterbin moved to dismiss the claims, arguing that regardless of Doncic’s revocation, his initial consent fully complied with Section 1052(c), and Doncic failed to demonstrate that any legal authority exists for contesting the registration in accordance with Lanham Act §§ 14(1) and 2(c).⁸⁵

78. Petition to Cancel, *supra* note 73, at 6–7.

79. Stein, *supra* note 75; Jesus Enriquez, *Luka Doncic In Trademark Conflict With Mom*, THE DALLAS EXPRESS (Sept. 10, 2022), <https://dallasexpress.com/sports/luka-doncic-in-trademark-conflict-with-mom/#:~:text=Doncic%27s%20company%2C%20Luka99%20Inc.%2C,a%20year%20after%20Doncic%27s%20first> [https://perma.cc/X6Z3-LTNG].

80. Petition to Cancel, *supra* note 73, at 2.

81. *Id.*

82. *Id.* at 7–8.

83. *Id.* at 8–9.

84. *Id.* at 9.

85. Respondent’s Motion to Dismiss for Failure to State a Claim at 3–4, *Luka99, Inc. v. Poterbin*, No. 36746/50 (T.T.A.B. Oct. 13, 2022), ESTTA1241473.

In his opposition to Poterbin's motion to dismiss, Doncic urged the TTAB to address and determine the issue of revocation as a matter of equity, stressing that there is "no legal, rational support for the proposition that a person, once having granted consent to the use of his or her name, cannot revoke it if their circumstances change"⁸⁶ and that "a 19-year-old individual cannot be forever precluded from retaking ownership of his own name as a trademark, as [Poterbin] suggests."⁸⁷

Legal experts anticipated that the case would not only create a precedent with ramifications on trademark law but also impact how NIL deals are drafted to address the possibility of unilateral future revocations,⁸⁸ and contractual rights of minors whose parents register their names as marks.⁸⁹ However, Doncic and Poterbin privately settled the case, and Doncic withdrew his petition for cancellation on December 5, 2022.⁹⁰ The question of consent revocation under Section 1052(c) remained unresolved. On May 7, 2023, Doncic's company, LUKA99, Inc. was added as an owner of the registered "LUKA DONCIC 7" mark.⁹¹ Whether Doncic would have prevailed, had he not settled with Poterbin, remains uncertain because the statute does not stipulate either a withdrawal of consent⁹² or a reaffirmation of consent during the five-year renewal of a Section 1052(c) mark.⁹³ Further, had the case moved forward, the TTAB would likely have considered that Doncic was

86. Petitioner's Opposition to Respondent's Motion to Dismiss for Failure to State a Claim at 6, *Luka99, Inc. v. Poterbin*, No. 36746/50 (T.T.A.B. Nov. 2, 2022), ESTTA1245584.

87. *Id.*

88. David Barker & Zachary Schroeder, *TTAB Mulls Whether Mavericks Star Luca Doncic Can Revoke Trademark Consent After Issuance of a Mark*, JD SUPRA (Oct. 31, 2022), <https://www.jdsupra.com/legalnews/ttab-mulls-whether-mavericks-star-luka-2426716/> [<https://perma.cc/JY5E-536J>].

89. McCann, *supra* note 70.

90. Withdrawal of Pet. to Cancel, *Luka99, Inc. v. Poterbin*, No. 36746/50 (T.T.A.B. Dec. 5, 2022), ESTTA1252060.

91. Change Address or Representation Form, LUKA DONCIC 7, Registration No. 5,953,034 (May 7, 2023).

92. Jahner, *supra* note 49.

93. *Id.*

relatively young and inexperienced, bringing the question of child celebrities and their parents into play.⁹⁴

IV. THE NEED FOR JUDICIAL GUIDANCE

Despite the results of the Doncic case, the concern for consent still lingers. Virginia Wolk Marino of the law firm Crowell & Moring LLP noted that “there are going to be issues over whether [athletes] are consenting, for someone else to be able to register their name”⁹⁵ and “[i]f that’s forever, that’s a big deal for a 19 [or] 20-year-old.”⁹⁶ Athletes, especially those in the early stages of their careers, are often pressured into entering agreements that are heavily skewed in favor of managers, sports organizations, schools, or other entities.⁹⁷ Some of these agreements are offered on a take-it-or-leave-it basis, providing no room for negotiations, and include releases to commercial NIL rights buried within the dense text of the documents.⁹⁸ Considering the legal and commercial advantages that come with obtaining trademark ownership rights to an athlete’s name, it should be no surprise that third parties will likely pursue consent from athletes in an illegitimate manner that places the ownership rights in the hands of the third party rather than under the control of the athlete. As a matter of public policy, athletes, like any individual, should be treated fairly and ethically in commercial dealings. Allowing them to revoke consent to a trademark registration is a viable option that ensures they are not taken advantage of or bound to agreements that were entered into under misleading circumstances. Consequently, courts should be prepared to address and resolve disputes arising out of such questionable contracts.

94. McCann, *supra* note 70.

95. Kyle Jahner, *Luca Doncic Bid to Get Trademark Back From Mom a Legal Jump Ball*, BLOOMBERG LAW (Sept. 19, 2022, 2:10 AM), https://www.bloomberglaw.com/bloomberglawnews/ip-law/XDN1GIDO00000?bna_news_filter=ip-law#jcite [<https://perma.cc/H4HL-D88U>].

96. *Id.*

97. See Leah Vann, *One Week into NIL, Lawyers Caution Athletes on Barstool, YOKE Gaming and Misinformation that Could Affect Iowa Athletes*, THE GAZETTE (Aug. 27, 2021, 1:24 PM), <https://www.thegazette.com/iowa-hawkeyes/one-week-into-nil-lawyers-caution-athletes-on-barstool-yoke-gaming-and-misinformation-that-could-a/> [<https://perma.cc/7VD5-75WN>].

98. Thomas A. Baker III et. al., *Consent Theory as a Possible Cure for Unconscionable Terms in Student-Athlete Contracts*, 22 MARQ. SPORTS L. REV. 619, 619 (2012).

A. *Interpreting the Effect of Consent Under Section 1052(c)*

The issue of consent revocation under Section 1052(c) provides a unique opportunity for the TTAB or any court presented with the issue (collectively, “the courts”) to establish an important precedent that recognizes and safeguards athletes in situations where an initial agreement between the athletes and third parties was disingenuous, uninformed, or without a basis of fair understanding between the parties.

Given Section 1052(c)’s lack of statutory framework, the courts should provide additional support that supplements the statute with established legal principles allowing athletes to revoke their consent to a Section 1052(c) trademark registration in exploitative circumstances. As Justice John Paul Stevens asserted in his opinion in *Southland Corp. v. Keating*, in the absence of a statutory definition specifying the grounds in which revocation may be permissible, the judiciary “must fashion the limitations.”⁹⁹ By doing so, the courts will infuse a protective measure into 1052(c) that aligns with the broader principles of fairness and equity evident in other areas of the law.

Additionally, where a statute is silent on the issue of consent revocation, as is Section 1052(c), a court may still find that the right to revocation exists. In *Gager v. Dell Financial Services, LLC*, the Third Circuit held that the absence of an express statutory provision in the Telephone Consumer Protection Act (“TCPA”) for the revocation of prior consent does not mean that the right to revoke does not exist.¹⁰⁰ The court noted that the silence should be interpreted as evidence that the right to revoke does exist.¹⁰¹ Considering these principles, it would not be unusual for a court to interpret Section 1052(c) to allow for the withdrawal of prior consent. To understand the philosophy behind consent revocation, we must discuss its prevalence in different legal systems.

1. Revocation of Consent in American and European Jurisprudence

Consent is a fundamental principle in law and essential for the validity of many legal transactions. Its significance lies in upholding fairness, individual rights, autonomy, and the integrity of legal relationships. Nonetheless,

99. *Southland Corp. v. Keating*, 465 U.S. 1, 19 (1983) (Stevens, J.P., concurring).

100. *Gager v. Dell Fin. Servs., LLC.*, 727 F.3d 265, 270 (3d Cir. 2013).

101. *Id.* at 271–72.

consent is revocable under common law.¹⁰² Although there is no universal construction standard regarding the revocation of consent, it is clear that in various areas of the law, consent is not an absolute and unchanging concept. In fact, the concept of irrevocable consent is relatively rare, as the default principle in many legal systems, such as in contract and privacy law, is that a person can withdraw their consent in many circumstances.

2. Consent Revocation Doctrines in Contract Law

The ability to revoke consent is a concept generally recognized in contract law. Various courts have acknowledged that parties should have the freedom to reassess their decisions, particularly when faced with changing or unforeseen circumstances.¹⁰³ There are several contract doctrines that permit revocation of consent where there are significant doubts about the legitimacy of a party's consent. These doctrines include "lack of capacity, mistake, misrepresentation, duress, undue influence [and] abuse of a fiduciary relation."¹⁰⁴

The doctrine of capacity recognizes that certain individuals, such as minors, may be vulnerable to exploitation or manipulation¹⁰⁵ while the doctrine of undue influence protects individuals whose consent was induced by another person in a way that is considered unfair, oppressive, or abusive.¹⁰⁶ Further, the doctrine of misrepresentation allows for revocation where the

102. RESTATEMENT (SECOND) OF TORTS § 892A cmt. i (AM. L. INST. 1979) ("[C]onsent is terminated when the actor knows or has reason to know that the other is no longer willing for him to continue the particular conduct."); *see also Gager*, 727 F.3d at 270–71.

103. *United Eng'rs. & Constructors, Inc. v. Babcock & Wilcox Co.*, No. 12,540, 1993 Del. Ch. LEXIS 26, at *8–9 (Del. Ch. Feb. 11, 1993); *Reader v. Dennis*, 2021 Cal. Super. LEXIS 14111, at *5 (Cal. Super. Nov. 1, 2021) ("The grounds for rescission under California law include mistake, lack of capacity, undue influence, material failure of consideration, duress, illegality . . . and, of course, fraud. See Civ. C. §§ 1689, 1566."); *Robinson v. Title Lenders, Inc.*, 364 S.W.3d 505, 515 (Mo. 2012) (contract defense, such as fraud, duress, or unconscionability, applied to concerns raised about the agreement).

104. Brian H. Bix, *Contracts in THE ETHICS OF CONSENT: THEORY AND PRACTICE* 251, 255 (Franklin G. Miller & Alan Wertheimer eds., 2009); RESTATEMENT (SECOND) OF CONTS. § 376 (AM. L. INST. 1981).

105. RESTATEMENT (SECOND) OF CONTS. § 12 (AM. L. INST. 1981).

106. *Id.* § 177.

consent was obtained through fraudulent or material misrepresentations.¹⁰⁷ The doctrine of abuse of fiduciary relation ensures that individuals consent with a complete understanding of their legal rights and relevant facts when entering into an agreement with a fiduciary.¹⁰⁸ By historically and customarily enforcing these doctrines, the courts have regularly indicated to the legal field that consent in an agreement is not immutable. Rather, consent will be scrutinized for legitimacy, deception, coercion, and so forth, depending on the circumstances.

When examining Section 1052(c)'s consent requirement, courts should consider these doctrines as practical tools that further the statute's goal of protecting individuals from commercial exploitation. This is of special importance when there is a substantial chance that the consent was obtained illegitimately. The California Civil Code provides a comprehensive outline of these doctrines under Section 1689.¹⁰⁹

3. Consent Revocation in Privacy Laws

Unlike contract law, in which the legal measures to revoke consent are limited to individuals in vulnerable circumstances, modern privacy laws allow individuals to revoke their consent freely and as easily as they granted it. In the context of privacy and data protection, written consent is required by an individual whose personal data is being collected and potentially used.¹¹⁰ U.S. data privacy statutes, such as the Montana Consumer Data Privacy Act and Connecticut Data Privacy Act, provide a broad statutorily conferred right for individuals to withdraw their consent to data processing.¹¹¹

The European Union's General Data Protection Regulation (GDPR), which governs the collection and processing of an individual's personal

107. *Id.* § 164.

108. *Id.* § 173.

109. CAL. CIV. CODE § 1689.

110. ROBERT WALTERS, *Controller, Consent, Processing*, in CYBERSECURITY AND DATA LAWS OF THE COMMONWEALTH 124–25 (2023).

111. S.B. 0384, 2023 Leg., 68th Sess. (Mont. 2023); S.B. 6, 2022 Gen. Assemb., Reg. Sess. (Conn. 2022).

data,¹¹² also provides data subjects with a statutorily conferred right to withdraw consent.¹¹³ Where the processing of personal data is based on consent, the provision states that the “data subject shall have the right to withdraw his or her consent at any time” (emphasis added).¹¹⁴ The purpose of granting such broad authority is to empower individuals to manage and control how their information is used, fostering transparency and accountability among organizations handling personal data.¹¹⁵ Although these approaches to consent withdrawal are too lenient to bring to bear with trademark law, the procedural guidelines supplementing the statutes should be a point of reference for the courts when considering similar procedures under Section 1052(c)’s consent requirement.

Similar to how intellectual property scholars acknowledged and conferred the absence of direction under Section 1052(c)’s consent requirement, the supplemental procedural guidelines to the GDPR were a product of statutory obscurity. After acknowledging the need for clarifications regarding consent in the GDPR, the European Data Protection Board created guidelines explaining the definition of consent and its conditions.¹¹⁶ The guidelines further expanded on different elements of valid consent, including questions of voluntariness, imbalances of power, and conditionalities.¹¹⁷ Moreover, a specific section was designated to address the withdrawal of consent, the assessment of withdrawn consents, and permissible grounds for the withdrawal.¹¹⁸

The Privacy Rule of the Health Insurance Portability and Accountability Act also gives individuals the right to revoke, at any time, an

112. Council Regulation 2016/679 of Apr. 27, 2016, Protection of Natural Persons with Regard to the Processing of Personal Data and on the Free Movement of Such Data, and Repealing Directive 95/46/EC (General Data Protection Regulation), 2016 O.J. (L 119) 1.

113. *Id.* at art. 7(3), art. 13(2), art. 14(2).

114. *Id.* at art. 7(3).

115. Kiril Krastanoff, *GDPR Consent Management: Key Principles and Implementation Strategies*, CAPTAIN COMPLIANCE (May 14, 2024), <https://www.captaincompliance.com/education/gdpr-consent-management> [<https://perma.cc/CT5T-BZSA>].

116. Eur. Data Prot. Bd., *Guidelines 05/2020 on Consent Under Regulation 2016/679*, at 6, (May 4, 2020), https://www.edpb.europa.eu/sites/default/files/files/file1/edpb_guidelines_202005_consent_en.pdf [<https://perma.cc/KSJ2-5Y2N>].

117. *Id.* at 7.

118. *Id.* at 23.

authorization they have provided for research purposes.¹¹⁹ Under Subpart E of the statute, there are specific provisions that lay out the manner in which the revocation must be made, when it can take effect, and exceptions to revocation.¹²⁰ Again, although this approach is also fairly lenient, the courts should reference these provisions when constructing limitations for consent withdrawals under Section 1052(c).

B. Ramifications on Minors in the Limelight

It is also important to note that even though public policy and contract laws are generally more favorable towards up-and-coming talent and child stars, trademark law is unfavorable and disadvantageous towards them. In any case, the need to protect child stars and young talent from their parents is crucial, notably because when children are earning substantial financial income, parents “face an enormous temptation to disregard their fiduciary responsibilities.”¹²¹

In the case of trademarking a name, if a parent or guardian of a minor registers the minor’s name as a trademark that subsequently is granted registration and generates revenue, there are no federal or state laws requiring the parents or guardian to put a percentage of the proceeds in a trust account for the child. From a practical standpoint, the parent or guardian could keep 100% of the revenue generated from the trademark of the child’s name. This is a sharp difference from the likes of the Coogan Law, which provides great financial protections for minors working in the entertainment industry by requiring parents to set aside at least 15 percent¹²² of a child’s net earnings in a trust account.¹²³ Again, with the developing landscape of NIL, these considerations will affect the ability of talent to build brands on their namesakes, especially in uncharted territory where financial exploitations of minors by parents or guardians are likely to occur absent legal or legislative intervention.

119. 45 C.F.R. § 164 (2024).

120. *Id.*

121. Danielle Ayalon, *Minor Changes: Altering Current Coogan Law to Better Protect Children Working in Entertainment*, 35 HASTINGS COMM. & ENT L.J. 351, 352 (2013).

122. *Id.* at 356.

123. *Id.*

Another premature shortcoming between trademark law and minors is that trademark law allows parents to sign a name consent on behalf of their child if the child's name is going to be used in a registered trademark. According to the TMEP, “[i]f the record indicates that the person whose name or likeness appears in the mark is a minor . . . the consent should be signed by a parent or legal guardian, clearly setting forth his or her status as a parent or legal guardian.”¹²⁴ Thus, a parent could consent on their child's behalf to allow for another party to register their name as a trademark, regardless of the child's age, which would then preclude future ownership rights from the child. For example, in 2019, Kim Kardashian (“KARDASHIAN”) signed a name consent on behalf of her daughter Chicago West (“WEST”), who was merely a year old at the time, giving legal ownership of various trademarks of West's name to Kardashian's company Kimsaprincess Inc.¹²⁵ If the USPTO were to approve the registrations, Kardashian's company would become the rightful owner of the trademarks, leaving West in a position where she would have to attempt to legally reclaim the rights at some point in her adult life, similar to Doncic.

C. Perpetual Agreements and Enforceability

When analyzing consent to register one's name as a trademark, courts should also consider common law principles such as the doctrine of indefiniteness, which includes the judicial aversion towards agreements that purport to last forever. This is because providing consent for a third party to register one's name as a trademark is effectively a contractual agreement, and therefore, consent agreements under Section 1052(c) should be treated no differently than other contracts that are subject to indefinite or perpetual durations. When analyzing the consent to register agreements attached to Doncic and West's trademark applications, there is a distinct absence as to duration.

Doncic's agreement states, “I, Luka Doncic, hereby consent to use and registration by MIRJAM POTERBIN of my name as a trademark and/or service mark with the United States Patent and Trademark Office.”¹²⁶ West's agreement reads, “I, Kim Kardashian West, hereby state that I am the parent

124. TMEP § 1206.04(a) (May 2024).

125. U.S. Trademark Application Serial No. 97,520,176 (filed July 26, 2022).

126. Respondent's Motion to Dismiss for Failure to State a Claim at 3, *Luka99, Inc. v. Poterbin*, No. 92080484 (T.T.A.B. Oct. 13, 2022), ESTTA1241473.

of Chicago West, a minor, and give my consent to the registration of Chicago West's name and/or nickname to Kimsaprincess Inc.”¹²⁷ Based off the ambiguity, Poterbin argued that the absence of duration in Doncic's one-sentence consent agreement implied that the consent to register was binding in perpetuity, a notion that is not supported historically or presently by the law.

Contracts of perpetual duration have long been disfavored by courts as a matter of public policy.¹²⁸ In fact, the following passage from the Supreme Court of Mississippi's decision in *Echols v. New Orleans, J. & G.N.R. Co.* illustrates the common law's disapproval of perpetual agreements dating back to as early as the 19th century:

Perpetual contracts . . . will not be tolerated by the law, or rather, will not be enforced as imposing an eternal and never-ending burden. An agreement to furnish a support or service, or a particular commodity, at a specified price, or to do a certain thing without specification as to time, will be construed either as terminable at pleasure, or as implying that the thing to be done shall be performed within a reasonable time, and the obligation will cease within the same limitation.¹²⁹

The reasoning is straightforward: perpetual contracts lock parties into relationships and obligations that may become undesirable as facts or circumstances change. As the Supreme Court of Illinois aptly stated in *Jespersen v. Minnesota*,

“Forever” is a long time and few commercial concerns remain viable for even a decade. Advances in technology, changes in consumer taste and competition mean that onceprofitable[sic] businesses perish-regularly...[m]en and women of commerce know this intuitively and achieve the flexibility needed to respond to market demands by entering into agreements terminable at will.¹³⁰

127. U.S. Trademark Application Serial No. 97,520,176 (filed July 26, 2022).

128. *Glacial Plains Coop. v. Chippewa Valley Ethanol Co.*, 912 N.W.2d 233, 236 (Minn. 2018); *see also* *Carolina Cable Network v. Alert Cable TV, Inc.*, 447 S.E.2d 199, 201 (S.C. 1994) (perpetual contracts “not . . . favored”); *MS Real Est. Holdings, LLC v. Donald P. Fox Fam. Tr.*, 864 N.W.2d 83, 92 (Wis. 2015) (“Wisconsin courts do not favor perpetual contracts.”); *Jespersen v. Minn. Mining & Mfg. Co.*, 700 N.E.2d 1014, 1017 (Ill. 1998).

129. *Echols v. New Orleans, Jackson & Great N. R.R. Co.*, 52 Miss. 610, 614 (Miss. 1876).

130. *Jespersen*, 700 N.E.2d at 1017.

Moreover, perpetual contracts “subject incautious persons — a class, it may be remarked, which includes the majority of mankind — into life-long servitudes, and greatly fetter and embarrass the commerce of the world.”¹³¹

However, “if it is debatable whether the parties intended to create a perpetual contract, the agreement is construed as an indefinite[sic]-duration contract terminable at will.”¹³² In other words, if the contract simply does not contain a provision for its duration, it will be deemed terminable at will.¹³³ Otherwise, a perpetual obligation will be enforced only if the intent to create it is clear.¹³⁴ The standard of determining intent differs from state to state; however, the prevailing rule is that the language of the contract must unambiguously express an intent for the agreement to be of perpetual duration to the effect that all parties have notice and knowledge of the enduring commitment they are undertaking.¹³⁵

In both *Doncic*’s and *West*’s consent to register agreements, there are no statements regarding duration, let alone clear statements of intent to enter a perpetual contract. Because common law principles impose a default rule that dictates that such contracts are terminable at the will of either party, the default rule should prevail for both *Doncic* and *West*. This is particularly apt because the rights at stake are federal trademark rights over their own names. Moreover, the default rule has been applied in a wide range of contexts, including employment, partnership, and distributor-manufacturer

131. *Echols*, 52 Miss. at 614.

132. Brief of Amici Curiae Law Professors in Support of Defendant, *New York v. New Jersey*, 2022 WL 4000902, at *9 (U.S. Aug. 29, 2022) (No. 156).

133. RESTATEMENT (SECOND) OF CONTS. § 33 cmt. d (AM. L. INST. 1981); 17B C.J.S. *Contracts* § 609 (2024).

134. *In re Miller’s Estate*, 447 A.2d 549, 553–54 (1982) (requiring a “clear manifestation” of intent to create a perpetual contract).

135. *Id.*; *Bell v. Leven*, 90 P.3d 1286, 1288 (Nev. 2004) (language of contract must “clearly provide[]” for perpetual duration); *Barton v. State*, 659 P.2d 92, 94 (Idaho 1983) (contract must be “expressly made perpetual by its terms”); *City of Billings v. Pub. Serv. Comm’n of Montana*, 631 P.2d 1295, 1306 (Mont. 1981) (contract must be “expressly made perpetual by its terms”); *Cap. Invs., Inc. v. Whitehall Packing Co.*, 280 N.W.2d 254, 261 (Wis. 1979) (intent to enter perpetual contract must be “clearly stated”).

agreements.¹³⁶ Thus, applying the rule to consent to register agreements under trademark law would not be unprecedented.

1. The Seven Year Rule

The entertainment industry, in general, is also opposed to indefinite contracts. In 1937, California enacted Section 2855 of the California Labor Code, which is often referred to as the “Seven Year Rule.” The purpose of the law was to prevent an employer’s ability to bind their employees to predatory and indefinite personal service contracts by limiting the term of the agreement to seven years.¹³⁷ The rationale for restricting the duration of the agreement is based on the understanding that over time, the conditions surrounding the contract are likely to evolve, potentially varying greatly from those existing at the commencement of the agreement.¹³⁸ Such changes could involve “personal, economic, and social considerations.”¹³⁹ In industries like entertainment and sports, the rule empowers artists, actors, musicians, and athletes by giving them the opportunity to renegotiate their contracts or seek new opportunities after a reasonable period. It prevents talent from being tied indefinitely to a single studio, team, or employer under potentially unfavorable terms.

The Seven Year Rule has influenced contract law and practices beyond the entertainment industry. It serves as a precedent for considering the fairness and flexibility of long-term contracts in various fields. Thus, the principle underlying the Seven Year Rule—that contracts should not bind individuals indefinitely—should be applied to consent agreements under Section 1052(c).

V. WHEN ALL ROADS LEAD TO LITIGATION

Until courts provide legal mechanisms for consent revocation under Section 1052(c), athletes will likely have to challenge a registered trademark

136. *Cape v. Greenville Cnty. Sch. Dist.*, 618 S.E.2d 881, 883 (S.C. 2005); *Wood v. Warner*, 15 N.J. Eq. 81, 87 (N.J. Ch. 1862); *Greenwich Vill. Beverages, Inc. v. Food Merch., Inc.*, 186 N.Y.S.2d 96, 97 (N.Y. App. Div. 1959).

137. CAL. LAB. CODE § 2855; Jonathan Blaufarb, *The Seven-Year Itch: California Labor Code Section 2855*, 6 HASTINGS COMM. & ENT. L.J. 653, 653 (1984).

138. Blaufard, *supra* note 137, at 653.

139. *Id.*

of their name that is under the ownership of a third party through litigation, as Dončić did. Although Dončić’s cancellation petition relied on general claims such as abandonment or false suggestion of a connection with a living person, challengers can rely on other grounds as well. Despite its non-uniformity, the Lanham Act provides several measures that allow a party to challenge the validity of a registered trademark in a legal proceeding to ultimately render the mark canceled.

Lanham Act Section 33(a) (“Section 33(a)”) allows challengers to assert legal and equitable defenses¹⁴⁰ against mark holders of valid registrations.¹⁴¹ The broad scope of the language, as interpreted by Thomas McCarthy in his leading treatise on trademark law, means that “any common law or statutory ground can be raised to attack the validity of the mark, and any equitable defense can be interposed”¹⁴² and “nothing shall preclude a challenger to a contestable registration from proving any legal or equitable defense or defect”¹⁴³ The 1988 Trademark Law Revision Act expanded Section 33(a) to include “any of the ‘defenses or defects’ listed in § 33(b)(1) through (8) relating to incontestable registrations” (hereinafter, “SECTION 33(B)”).¹⁴⁴ Relevant Section 33(b) defenses include: (1) fraud in obtaining the registration; (2) use of the mark to misrepresent source; (3) fair use of the mark; and (4) equitable principles.¹⁴⁵ Lack of ownership is another significant legal ground for challenging a registered trademark.

A. *Fraud*

If the registration of a mark was obtained fraudulently, the Lanham Act provides that an action to cancel a fraudulently procured registration may be

140. 15 U.S.C. § 1115(a) (“ . . . but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b), which might have been asserted if such mark had not been registered.”).

141. *Id.*; *Id.* § 1116.

142. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:139 (5th ed. 2024).

143. *Id.*

144. *Id.*

145. 15 U.S.C. § 1115.

brought “[a]t any time.”¹⁴⁶ In *Butkus v. Downtown Athletic Club of Orlando, Inc.*, hall of fame linebacker Dick Butkus sued the Downtown Athletic Club of Orlando (“DACO”), claiming that DACO committed fraud when they asked for his consent to use and register his name as a trademark without informing him of the legal consequences.¹⁴⁷ The court held that DACO did procure Butkus’ consent fraudulently because DACO did not explain Butkis’ legal rights before he signed the consent.¹⁴⁸ The court made it clear that revocation was permissible, stating that, “Indeed, the trier of fact may find that under whatever contract existed between the parties, Butkus, rather than DACO, is the constructive owner of the mark notwithstanding DACO’s registration of it, and that Butkus could and did validly revoke DACO’s consent to use the mark.”¹⁴⁹ The court’s focus on DACO not explaining Butkis’ legal rights prior to his signing of the consent to register is significant dicta that an athlete can rely on when arguing against the validity of a consent to register provided to a third party like DACO.

B. Fair Use

If a personal name is registered as a federal trademark, but the registration has not yet become incontestable, a challenger can invoke the “right to use one’s own name” defense under Section 33(a).¹⁵⁰ Courts generally address a “right to use one’s own name” challenge by balancing a senior user’s trademark rights against the junior user’s right to use his/her own name.¹⁵¹ The balancing is usually influenced by the past behavior of the parties.¹⁵² Further, even when there is evidence of infringement through a likelihood of

146. 15 U.S.C. § 1064(3); *Marshak v. Treadwell*, 240 F.3d 184, 192 (3d Cir. 2001).

147. *Butkus v. Downtown Athletic Club of Orlando, Inc.*, No. CV 07-2507 PA (JWJX), 2008 WL 11336819, at *4 (C.D. Cal. Apr. 2, 2008).

148. *Id.* at *5.

149. *Id.* at *6.

150. 15 U.S.C. § 1115; MCCARTHY, *supra* note 142, § 13:13.

151. MCCARTHY, *supra* note 142, § 13:6.

152. *Id.*

confusion, a junior users using their personal names as a mark frequently receive lenient judicial treatment.¹⁵³

VI. CONCLUSION

As athletes increasingly seek to capitalize on their personal brands and navigate the evolving landscape of NIL, the ability to control and manage federal trademarks associated with their names has become a powerful legal tool. Nonetheless, athletes face various risks when placing such a tool in the hands of a third party. The case of NBA star Luka Dončić is the first of arguably many that illustrates the intricacies and potential risks associated with athletes consenting to third party trademark registrations. The unresolved question of revoking consent to trademarks registered by third parties, as highlighted by sparse case law and the absence of a clear legal framework under Lanham Act Section 1052(c), underscores the need for a more comprehensive understanding of the various legal principles in play. Ultimately, the ability to revoke consent is a mechanism that supports individual agency, respects the dynamic interplay between personal and business relationships, and fosters fair and just legal dealings.

This paper aims to bring attention to the possibility of consent revocation to registrations made under Section 1052(c) by emphasizing the potential legal and commercial pitfalls athletes may encounter, offering insights into other areas of the law that address revocation, and encouraging the courts to interpret Section 1052(c) in a manner that is consistent with the principles of fairness and equity. Considering that the issue of consent revocation under Section 1052(c) is likely to cause more legal disputes in the developing NIL era, the courts must be prepared to address the novel issue in a manner that ensures that the law evolves to meet the needs of athletes and individuals alike.

153. *Id.* § 13:1.