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### Recommended Citation

Barret R. Arthur, *Always Protect Your Brand: Trademark Infringement Protection for Athletes using Social Media Sites*, 10 DePaul J. Sports L. & Contemp. Probs. (2014)  
Available at: <https://via.library.depaul.edu/jslcp/vol10/iss1/5>

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# ALWAYS PROTECT YOUR BRAND: TRADEMARK INFRINGEMENT PROTECTION FOR ATHLETES USING SOCIAL MEDIA SITES

*Barret R. Arthur\**

## INTRODUCTION

Shaquille O’Neal (“Shaq”) has 7,991,485 followers on Twitter.<sup>1</sup> He announced his retirement on the social media page, essentially eliminating the need for sports reporters to cover the story. Instead of providing statements to the traditional media, National Basketball Association (“NBA”) players of the past and present took to the “Twitterverse”<sup>2</sup> and wrote personal messages honoring one of the NBA’s most dominant ever players.<sup>3</sup> Once in an interview, Shaq was asked, “You don’t just focus on tech; you’ve become an investor in Five Guys, Vitaminwater, and others. Why such a broad focus?”<sup>4</sup> Shaq answered as follows:

Magic Johnson told me in 1996, “It’s okay to be famous and be well liked, but you got to start owning things.” Shaq Inc. is broken up into different silos: the regular endorsements; the Shaq brand, like the Dunkman shoe line; entertainment, like [the ABC show] Shaq Vs.; and social media. I don’t look at them as investments; I look at them as opportunities to expand.<sup>5</sup>

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\* J.D., January 2014, The John Marshall Law School. B.S., Krannert School of Management, Finance Concentration, Purdue University, May 2010. I would like to thank my family and friends, especially my wife Deanna, for supporting me throughout the writing of this article. The author is a sports agent with MCA Sports and Entertainment, helping MLB and NFL athletes achieve their personal and athletic goals on and off the field of play. Any mistakes in this article are my own.

1. Twitter is a social media website that allows members to follow anyone they choose and see the “tweets” that are written by those parties. Shaquille O’Neal, TWITTER, <https://twitter.com/SHAQ> (last visited Jan. 15, 2014).

2. The “twitterverse” is defined as the “total universe of Twitter users and their habits.” Twit-terverse, PCMAG.COM ENCYCLOPEDIA, [http://www.pcmag.com/encyclopedia\\_term/0,1237,t=Twitterverse&i=60386,00.asp](http://www.pcmag.com/encyclopedia_term/0,1237,t=Twitterverse&i=60386,00.asp) (last visited Jan. 15, 2014).

3. Anthony Rodriguez, *Shaq’s Twitter Legacy*, SOCIALNOMICS (Aug. 4, 2011), <http://www.socialnomics.net/2011/08/04/shaqs-twitter-legacy/>.

4. Jason Feifer, *How to Manage a Celebrity’s Brand*, FAST COMPANY’S THE 100 MOST CREATIVE PEOPLE IN BUSINESS (April 27, 2012, 12:00 AM), <http://www.fastcompany.com/most-creative-people/2012/shaquille-oneal>.

5. *Id.*

This opportunity for post-career income begins and ends with the nickname he has donned his entire life. Shaq started his own company, called Mine O' Mine, Inc., and currently has twelve live trademarks on file with the United States Patent and Trademark Office ("USPTO").<sup>6</sup>

Shaq is an example of an athlete who takes initiative to ensure that his brand will be protected. Unfortunately, some of today's athletes have fallen victim to cybersquatters<sup>7</sup> and imposters who attach an athlete's name to their own social media site. These cybersquatters and imposters use an athlete's name to gain personal exposure and build their own popularity at the expense of the athlete.

This comment focuses on the current state of trademark law and the need for reformation of the law to protect the expansion of athletes' brands through social media. Part I provides background on current trademark law and the ability of athletes to market themselves via social media platforms. Part II analyzes the current law and its failure to protect athletes' names and trademarks on social media sites, as athletes seek to maximize their ability to earn income after their playing career ends. Part III addresses the shortcomings of current trademark law with respect to social media, and proposes a new interpretation of the law that recognizes the ability of social media outlets to promote, acquire, and execute business opportunities.

## I. BACKGROUND

This section provides an overview of the Lanham Act and its applicability to trademarks in athletics. This is followed by a description of social media and its many uses in today's commercial spectrum. Additionally, athlete trademarking and branding of the past is compared to that of the present. Specifically, this section focuses on how social media can be used to prolong an athlete's income-generating potential.

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6. LeaderShaq, Serial No. 85547071; Shaq'n Up With Hoopz, Serial No.'s 85388711 & 85388699; Shaq Vs, Serial No. 85009613; Shaq, Serial No.'s 78875970 & 74333818; Shaqtacular, Serial No. 78410658; Shaq Vs., Serial No.'s 77804450 & 77804448; Shaq's All Star Comedy Jam, Serial No.'s. 77865412 & 77865409; Shaq Attaq, Serial No. 77725454.

7. Cybersquatting is "the act of reserving a domain name on the Internet, esp. a name that would be associated with a company's trademark, and then seeking to profit by selling or licensing the name to the company that has an interest in being identified with it." Cybersquatting, BLACK'S LAW DICTIONARY 173 (3d. pocket ed. 2006).

### A. Current Trademark Law

The Federal Trademark Act of 1946 is known as the Lanham Act. A trademark is any “word, name, symbol or device or combination thereof, used by a person or company, in order to differentiate his/her or its products, including a unique product, from the goods or merchandise of another, and to identify the source of those goods, even if that source is unknown.”<sup>8</sup> Section 1125 of the Act forbids false designations of origin, false descriptions, and dilution.<sup>9</sup>

The Lanham Act prohibits domain names that are identical or similar enough to cause confusion with a previously registered mark,<sup>10</sup> and requires the user of the subsequent domain to have a bad-faith intent to profit from the use of the name to be liable.<sup>11</sup> In *Qualitex Co. v. Jacobson Products Co.*,<sup>12</sup> the Supreme Court stated that trademark law “quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.”<sup>13</sup>

Furthermore, in order to obtain federal trademark protection, the mark must be registered with the USPTO, and the applicant must maintain a bona fide belief that the mark is, or is intended to be, used in commerce.<sup>14</sup> For goods, a mark is considered to be in commerce when it is placed on the goods or their containers and the good is put out for sale in interstate commerce.<sup>15</sup> Services are considered to be in commerce when the mark is used for advertising the services, which are then used in interstate or foreign commerce.<sup>16</sup>

A trademark will continue as long as the mark is actively used in commerce.<sup>17</sup> However, a mark is “abandoned,” that is, no longer protected, if its use is discontinued, or if there is no intent to resume its use.<sup>18</sup> Intent not to resume may be inferred from nonuse three years

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8. 15 U.S.C. §§ 1051-1127 (1946).

9. 15 U.S.C. § 1125(c).

10. 15 U.S.C. § 1125(d); *see also* Gregerson v. Vilana Fin., Inc., 2007 WL 2509718, \*6 (D. Minn. Aug. 31, 2007) (defining “domain name” as the part of the website after the http://www. and before the .com).

11. Gregerson at \*6 (D. Minn. 2007) (holding that the defendants “failed to create a genuine issue of material fact that the plaintiff had a bad faith intent to profit by using Defendants’ trade and service marks in the domain name”).

12. *Qualitex Co. v. Jacobson Prods. Co. Inc.*, 514 U.S. 159 (1995).

13. *Id.* at 164 (quoting 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2.01[2], p. 2-3 (3d ed. 1994)).

14. 15 U.S.C. § 1051.

15. *Id.* at § 1127.

16. *Id.*

17. *Id.*

18. *Id.*

in a row or when the mark loses its significance through course of conduct that verifies the loss of significance of the mark.<sup>19</sup>

Trademark infringement occurs when use of a mark by another would cause confusion as to the source of the goods or services.<sup>20</sup> In order to prevail on a claim of trademark infringement, the complaining party must establish that it holds a valid trademark, that the defendants used the mark in commerce in connection with the sale or advertising of any goods, and that the defendants used the mark in a manner likely to confuse consumers.<sup>21</sup> The main concern of trademark infringement is confusion as to the source. Today, “infringement can be based upon a confusion that creates initial customer interest, even though no actual sale is finally completed as a result of the confusion.”<sup>22</sup>

In addition to infringement, the Lanham Act’s protection against dilution provides mark holders the right to prevent overexploitation of a famous trademark.<sup>23</sup> Dilution by tarnishment is defined in the Trademark Revised Dilution Act (“TDRA”) as “the association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”<sup>24</sup> Tarnishment occurs when a famous mark is portrayed in a damaging light, or is associated with inferior or compromising products, such as pornographic material.<sup>25</sup> Trademarks are a public representation of an athlete’s identity, personality, and reputation.<sup>26</sup> Unfortunately, people connected to vulgar subject matter often use the name of an athlete in their Twitter profile in order to appear in search results, to the detriment of athletes.

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19. *Id.*

20. 15 U.S.C. § 1114(1)(a) (“trademark infringement” defined as “any person using in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.”).

21. *North Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1218 (11th Cir. 2008).

22. 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:6 (4th ed.).

23. Richard A. Spinello, *Online Brands and Trademark Conflicts: A Hegelian Perspective*, 61 BUSINESS ETHICS QUARTERLY, 343, 349 (Jul. 2006), available at <http://www.jstor.org/stable/3857920> (last visited Oct. 15, 2012).

24. 15 U.S.C.A. § 1125(c)(2)(C), cited in *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 264 (4th Cir. 2007).

25. Spinello, *supra* note 23, at 349.

26. Doris Estelle Long, *Rebooting Trademarks for the Twenty-First Century*, 49 U. LOUISVILLE L. REV. 517, 542 (2011).

### B. Athlete Trademarking

One of the most commonly known trademarks in professional sports is Pat Riley's "Three-Peat," which was created in 1989.<sup>27</sup> Riley owns the rights to "Three-Peat" and stands to profit off any goods or merchandise sold in connection with a team winning three championships in a row and using the term "Three-Peat."<sup>28</sup> Riley's was one of the first trademarks centered on athletics. Recently, however, young athletes have realized that their earnings potential may have a significantly smaller time frame than the rest of the working class.<sup>29</sup> Two notable examples of athletes taking advantage of trademark protection are Earvin Johnson ("Magic Johnson")<sup>30</sup> and Robert Griffin III ("RGIII").<sup>31</sup> Today, athletes seek trademarks for their nicknames and catchphrases, the names of their businesses,<sup>32</sup> and licensing of their names to third parties.<sup>33</sup>

Athletic entities are now filing trademark applications for hashtags<sup>34</sup> on Twitter.<sup>35</sup> A hashtag is a # symbol connected to any word or combination thereof that turns into a link on Twitter, ena-

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27. *Top Phrases Trademarked by Athletes*, FORBES (Oct. 1, 2012), <http://www.forbes.com/pictures/ffje45eem/pat-riley-three-peat/>.

28. 3 Peat, Registration No., 4,139,135 (registered for use on jewelry); ThreePeat, Registration No. 4,051,757 (registered for use on hats, jackets, shirts); Three-Peat, Registration No. 1,878,690 (registered for use on collector plates, mugs, and tankards); and Three Peat, Registration No. 1,886,018 (registered for use on bumper stickers, decals, paper pennants, paperweights, posters, and trading cards).

29. Brett H. Pavony & Jaia Thomas, *For the Love of the Name: Professional Athletes Seek Trademark Protection*, 2 PACE I.P. SPORTS & ENT. L.F. 153, 157 (2012).

30. Magic Johnson maintains approximately thirty-three live trademarks, ranging from "Magic Johnson" to "Magic Johnson Community Empowerment Center," available at [http://tess2.uspto.gov/bin/showfield?f=toc&state=4006%3Ambn029.11.201&p\\_search=search&p\\_L=50&BackReference=&p\\_plural=yes&p\\_s\\_PARA1=&p\\_tagrepl-%3A=PARA1%24LD&expr=PARA1+AND+PARA2&p\\_s\\_PARA2=magic+johnson&p\\_tagrepl-%3A=PARA2%24COMB&p\\_op\\_ALL=AND&a\\_default=search&a\\_search=Submit+Query&a\\_search=Submit+Query](http://tess2.uspto.gov/bin/showfield?f=toc&state=4006%3Ambn029.11.201&p_search=search&p_L=50&BackReference=&p_plural=yes&p_s_PARA1=&p_tagrepl-%3A=PARA1%24LD&expr=PARA1+AND+PARA2&p_s_PARA2=magic+johnson&p_tagrepl-%3A=PARA2%24COMB&p_op_ALL=AND&a_default=search&a_search=Submit+Query&a_search=Submit+Query).

31. Robert Griffin III, Serial No. 85518361; RG III, Serial No. 85518373; RG3, Serial No. 85518378.

32. *Supra* note 30 (showing the multiple business enterprises trademarked by Magic Johnson).

33. *See, e.g.*, Lebron, Serial No. 78578843.

34. *What Are Hashtags ("#" Symbols)?*, TWITTER HELP CENTER, <https://support.twitter.com/articles/49309-what-are-hashtags-symbols#> (last visited Dec. 24, 2012). (The # symbol, called a hashtag, is used to mark keywords or topics in a Tweet, and if used correctly, anyone who does a search for a certain hashtag will be able to find the corresponding tweet).

35. John Feeley, *Trademarking a Hashtag? It's Already Happening*, PCGDIGITALMARKETING.COM, (Dec. 10, 2012), <http://www.pcgdigitalmarketing.com/20121210-businesses-trademarking-hashtags/> (explaining that the Mid-American Conference filed a request to trademark #MACtion); Lisa Ritchie, *#HASHTAGquestion: Trademark Issues Surrounding Hashtags*, PRACTICAL LAW COMPANY, (Oct. 25, 2012), <http://us.practicallaw.com/7-522-0480> (showing an example of Nike filing a trademark application for #makeitcount, which is promoted on Nike's website and other general marketing materials, and therefore goes beyond the general use of a hashtag as a communication tool).

bling users to follow a certain subject. For example, during the Super Bowl, fans tweeting during the game could include “#SuperBowl” in their tweet. When a user clicks on the hashtag, it directs her to all the tweets that included the hashtag. A collegiate athletic conference trademarking a hashtag in order to control use of a certain phrase and potentially profit from its use exemplifies the future of trademark disputes.<sup>36</sup>

### C. Social Networking In General

In general, social networking sites are Internet-based services that allow people to create a public or semi-public profile within a confined system.<sup>37</sup> Social networking sites enable users to do three things: (1) create an online identity; (2) establish relationships with other users on the same system; and (3) develop communities that are defined by lists of connections that each user creates.<sup>38</sup>

Facebook and Twitter are two of the most popular social networking websites.<sup>39</sup> Twitter is a personal interaction website. It utilizes cell phone text-message technology to post “tweets” that can be seen by anyone who desires to “follow” the author of the tweet.<sup>40</sup> A tweet is a message that the writer posts to the site. Business entities and organizations also utilize social networking to promote their brand and marks.<sup>41</sup> Trademarks in athletics have evolved from t-shirt sales containing a mark to hashtags seeking mark protection.<sup>42</sup>

### D. The Athlete and Social Networking

Due to the emergence of social media sites, an athlete can now instantly interact with millions of fans, sports journalists, and anyone else with social media connections.<sup>43</sup> More than ever, athletes are a

36. See Feeley, *supra* note 35, at 9.

37. *Id.*

38. *Id.*

39. Olivia Barrow, *Top 15 Most-Popular Social Media Sites*, DAYTON BUSINESS JOURNAL, (Dec. 17, 2012, 1:43 PM), <http://www.bizjournals.com/dayton/news/2012/12/17/top-15-most-popular-social-media-sites.html>.

40. About Twitter, TWITTER, <https://twitter.com/about> (last visited Jan. 15, 2014).

41. See Angela O'Brien, *Are Attorneys and Judges One Tweet, Blog or Friend Request Away from Facing A Disciplinary Committee?*, 11 LOY. J. PUB. INT. L. 511, 513 (2010).

42. Feeley, *Supra* note 35, at 9.

43. Joe Trevino, *From Tweets to Twibel: Why the Current Defamation Law Does Not Provide for Jay Cutler's Feelings*, 19 SPORTS LAW. J. 49, 57 (2012); see also Irwin A. Kishner & Brooke E. Crescenti, *The Rise of Social Media: What Professional Teams and Clubs Should Consider*, 27 ENT. & SPORTS LAW 24, 24 (2010) (explaining that a 2009 survey of Twitter's most discussed people revealed Kobe Bryant, Tiger Woods, and Alex Rodriguez were all in the top 10).

brand, and they have to build that brand in order to expand their earnings potential beyond the realm of athletic performance.<sup>44</sup>

Social media provides an interface that allows athletes to give the public an insider's look into their lives.<sup>45</sup> The sports industry has become more transparent due to social media.<sup>46</sup> The industry's stars are seen as people, not just uniforms; a glimpse of their families, hobbies, and personalities is more available to the public.<sup>47</sup> For an athlete, the key to maintaining a strong social media following is authenticity.<sup>48</sup> Cleveland Indians first-baseman Nick Swisher was an early adopter, saying, "I think it's a way to get that closer relationship with the fans. I always try to say this: I'm a fan of the people, you know? And it's just another way to develop that relationship even more."<sup>49</sup>

Through the use of social media, Chad Johnson (formerly known as Chad Ochocinco) promoted, started, and now maintains a news network called the OCNN, which stands for OchoCinco News Network.<sup>50</sup> Once known for his superb on-field performance and outrageous touchdown celebrations, Johnson continues to maintain an excellent image and brand because of the transparency and honesty he illustrates on his Twitter page.<sup>51</sup> Johnson's followers, by reading his tweets

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44. See Pavony & Thomas, *supra* note 29, at 166 (noting the differences between the athletes of the past, compared to the athletes of the future, and explaining that today's athletes have their own reality television shows, clothing brands, and restaurants, resulting in much more importance being placed on athletes protecting their intellectual property rights).

45. See TWEETING-ATHLETES.COM, <http://www.tweeting-athletes.com/> (last visited Jan. 15, 2014). This is a website devoted to any and all professional sports athletes on twitter. Users can click on any link of any professional team in any country in the world, even retired athletes in some leagues, and be directed to a screen with every player on that team that has a twitter page, and then access any player's twitter name so that the fan may follow that player.

46. Tim McGarry, *Athletes Using Social Media for Personal Branding: 3 Case Studies*, SPORTS MARKETING 2.0, (Feb. 15, 2011), <http://www.sportsmarketing20.com/profiles/blogs/athletes-using-social-media>.

47. E.g., Daniel Barbarisi, *Yankees' Swisher Takes Center Stage: An Early Embrace of Twitter and a Marriage to a Starlet Has Yankees' Right Fielder in the Spotlight*, WALL STREET JOURNAL (Oct. 1, 2012). "Mr. Swisher is a good player but is not on a Cooperstown track. As celebrity endorsements move beyond the superstars, the mid-level player with personality and social-media savvy can reach endorsement and name-recognition levels that were once only the domain of the best of the best, said David Carter . . . This is an emerging norm—these athletes now have an ability to establish and build and then extend their brands, and break through a lot of the clutter." *Id.*

48. See *Id.*

49. *Id.* (quoting Nick Swisher, "The media stuff is so social now. It's all over the Internet. It's how you reach a lot of people.").

50. OCHOCINCO NEWS NETWORK, <http://ocnnreport.com/> (last visited Oct. 1, 2012); see also, Justin Arbogast, *Chad Johnson (Ochocinco) Ranked As the Top Must-Follow Athlete on Twitter* (July 7, 2012), <http://ocnnreport.com/2012/07/17/chad-johnson-ochocinco-ranked-as-the-top-must-follow-on-twitter/>.

51. Chad Johnson, TWITTER, <https://twitter.com/ochocinco> (last visited Oct. 1, 2012).



and viewing his pictures, gained an all-access pass into what it was like for him to sign with a new NFL team, get married, divorced, and then cut from an NFL team, all within three months.<sup>52</sup>

Finally, social media allows athletes to promote their own business ventures and outside products.<sup>53</sup> Many athletes endorse various products, and those products or companies utilize social media to advertise.<sup>54</sup> Because of icons such as Shaq and Chad Johnson paving the way, young professional athletes are benefiting from starting companies and filing trademarks to protect their name, nickname, catchphrase, and brand.<sup>55</sup> Fans at home now watch a young athlete become a phenomenon and then watch the athlete rush to file a trademark and profit from selling products online with the athlete's name, phrase, or logo.<sup>56</sup> Consequently, it is now necessary for athletes to

52. *Id.* Johnson signed a contract to play with the National Football League's ("NFL") Miami Dolphins on June 11, 2012; married Evelyn Lozada on July 4, 2012; was arrested for domestic violence on August 11, 2012; was cut by the Dolphins on August 12, 2012; and divorced from Lozada on September 19, 2012. *Id.*; see also Jaia A. Thomas, *My Coach Won't Let Me Twitter? Understanding the Legal Implications of Social Media on and Off the Field*, 28 ENT. & SPORTS L.W. 18, Fall 2010, (explaining that opening up a social media account, such as Twitter, can open a celebrity up to a number of league fines, legal risks, and other problems if used incorrectly or inappropriately). This also illustrates the fact that the major professional sports leagues, including the NFL and NBA, have implemented social media policies in order to prevent players from abusing the valuable technology. *Id.* "In August 2009, the San Diego Chargers fined cornerback Antonio Cromartie \$2,500 for using Twitter to complain about the food served at the team's training camp." *Id.* Twitter is an effective tool to bridge the gap between the players and the fans, but must be used responsibly. *Id.* at 19

53. See Shaquille O'Neal, TWITTER, <https://twitter.com/SHAQ>, (Oct. 2, 2012, 8:20 PM). Shaq tweeted, "I'm no rookie when it comes to music, and these portable speakers on @OpenSky pack a BIG punch: <http://osky.co/Qbz5ND>. These things r bangin." Clicking the link brings the user directly to a page where the speakers can be purchased. *Id.*

54. Leah W. Feinman, *Celebrity Endorsements in Non-Traditional Advertising: How the FTC Regulations Fail to Keep Up with the Kardashians*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 97, 113 (2011) (writing "The evolution of reality television, social media, and the internet has given consumers greater access to celebrities than ever before. Viewers are increasingly interested in the personal lives of celebrities, and are no longer satisfied to read about upcoming film projects or sporting events . . . [t]hese mediums do more than increase viewers' access to celebrities; they give advertisers increased opportunities to use celebrities to endorse their brands and products.").

55. Doug Williams, *Athletes Trademarking the Phrase that Pays*, ESPN, (JULY 7, 2013, 10:36 AM), [http://espn.go.com/blog/playbook/fandom/post/\\_id/6108/athlete-trademarks-becoming-commonplace](http://espn.go.com/blog/playbook/fandom/post/_id/6108/athlete-trademarks-becoming-commonplace). "Now a person sitting at home can watch a phenomenon develop . . . and rush to register it as a trademark and cash in by selling items online with the words or logo by setting up a website, Twitter account or Facebook page. The athlete must then challenge the 'cybersquatter' for use of the term in commerce." *Id.*

56. *Id.* 18. An overview of athletes such as the NBA's Anthony Davis and the NFL's Robert Griffin III filing trademarks for catchphrases before even being drafted into the professional leagues. *Id.* Specifically, Griffin III and his company, Thr3scompany, LLC filed for trademark protection of "unbelievably believable" the day after he said it in his Heisman Trophy acceptance speech. *Id.* "With so many opportunities for a high-profile athlete to build a brand—through his or her performance, via a website, Twitter, YouTube, Facebook or even reality TV—

protect their individual trademark rights as soon as possible to ensure protection in any business venture they choose.<sup>57</sup> The current laws do not adequately ensure protection for these athletes—this comment will explore a solution.

## II. ANALYSIS OF CURRENT TRADEMARK LAW

Athletes realize that their playing contracts will last only as long as their physical ability allows, so they must think of ways to expand their earning potential. This section evaluates traditional trademark laws and reveals their inability to protect athletes' unique brands on social media platforms.<sup>58</sup>

This section will also address current protections for athletes seeking to establish and maintain their brands and marks on social media sites.<sup>59</sup> The protections in place for violations of trademark rights on social media sites are reactive rather than proactive.<sup>60</sup> In order for an athlete to maximize his earnings potential in off-field ventures, the law must protect him to ensure the uniqueness of his marks in the ever-evolving social media commercial marketplace.

### A. Trademark Infringement's Lack of Protection

The Internet has created the potential for a vast, confusing array of situations dealing with trademark violations.<sup>61</sup> Beyond trademark in-

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which all can result in more income, athletes are smart to protect their words, even if it may seem silly to the fans reading about it." *Id.*

57. *Id.* (quoting Jaia Thomas saying, "I think athletes are becoming a little smarter about their own brand and wanting to make multiple streams of income for themselves both on and off the field."); see also Jaia Thomas, co-author of, *For the Love of the Name: Professional Athletes Seek Trademark Protection*, appearing in the Pace Intellectual Property, Sports and Entertainment Law Forum); Pavony & Thomas, *supra* note 29, at 6.

58. See *infra* Part II.A.

59. See *infra* Part II.B.

60. See *infra* Part II.B.

61. See Lisa P. Ramsey, *Brandjacking on Social Networks: Trademark Infringement by Impersonation of Mark holders*, 58 BUFF. L. REV. 851, 853 (2010) (discussing when Exxon Mobil was forced to take action when a person known as "Janet" registered the Twitter name "ExxonMobilCorp" and discussed the company's plans relating to philanthropy and other fields); Robert J. Kenney, *Aligning Trademark Strategy to Meet the Challenges of the Internet and Social Media*, INSIDE THE MINDS, 2012 EDITION, \*4 (explaining that "'brandjacking' is a form of trademark abuse where fake profiles are created on a site in the name of a brand owner"); Dan Malachowski, "Username Jacking" in Social Media: Should Celebrities and Brand Owners Recover from Social Networking Sites When Their Social Media Usernames Are Stolen?, 60 DEPAUL L. REV. 223, 231 (2010) (describing St. Louis Cardinal manager, Tony LaRussa's lawsuit against Twitter for trademark infringement, false designation of origin, trademark dilution, cybersquatting, misappropriation of name, misappropriation of likeness, invasion of privacy, and intentional misrepresentation; where a Twitter username called "@TonyLaRussa" tweeted that there were no drunk driving incidents on the Cardinals' roadtrip); Ramsey at 854 (discussing the

fringement, the law provides remedies for trademark violations such as dilution, tarnishment, and false designation of origin; however, these laws do not adequately protect an athlete seeking to expand her brand via social media.<sup>62</sup>

Trademark infringement is a violation of the trademark holder's rights, typically involving use by someone else for the sale of goods or services.<sup>63</sup> The traditional approach to determine the likelihood of confusion is to look at factors such as strength of the mark, marketing channels used, and the defendant's intent when selecting the mark.<sup>64</sup>

The two relevant factors in the context of an athlete's social media are actual confusion<sup>65</sup> and the defendant's intent.<sup>66</sup> This renders the traditional, more expansive test misleading. These two factors traditionally receive the least attention from courts; however, in a social media setting, they are the most important. For example, an impersonator who attempts to gain more social network exposure by including the athlete's name in his social network username displays the necessary intent.<sup>67</sup> Other than actual confusion and intent, the traditional approach used to determine a likelihood of confusion does not adequately protect athletes using social media sites.<sup>68</sup>

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suit brought by public relations firm Tanner Friedman because a Twitter account with the username "TannerFriedman" acted as the real company, and may have been set up by an employee for a competing firm).

62. Malachowski, *supra* note 61, at 237-8; Spinello, *supra* note 23, at 350.

63. 15 U.S.C. § 1114; see Spinello, *supra* note 23, at 349.

64. 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 24:39 (stating the factors to be considered in determining a likelihood of confusion are: strength of the mark, relatedness of the goods or services, similarity of the marks, evidence of actual confusion, marketing channels used, type of goods and degree of care likely to be exercised by purchasers, defendant's intent in selecting the mark, and likelihood of expansion of the product lines).

65. Ramsey, *supra* note 61, at 898 (stating if social network users believe the information is coming from the mark holder, they are more likely to believe it is accurate and rely on it).

66. Ramsey, *supra* note 61, at 903 (stating that the intent factor can be determinative if the impersonator is intending to deceive).

67. Twitter/User Search, <https://twitter.com/i/#!/search/users/lebron%20wife?q=lebron+wife> (last visited Oct. 22, 2012). A search for the terms "Lebron wife" on Twitter reveals multiple profile pages, ranging from teenage girls to scandalous models. *Id.* Many of the profiles include, "Lebron's Wife" in their profile in order to appear in the search results if a user searches the terms "Lebron wife." Moreover, some of these users are struggling models or have their own businesses and are benefiting from the real LeBron James in an unauthorized manner.

68. Ramsey, *supra* note 61, at 895-903. The strength of the mark will generally not be useful in determining a likelihood of confusion in an expression on a social media site. *Id.* Relatedness of the goods or services and likelihood of expansion of product lines do not fit into the social media platform because a user could have a parody site and not be engaging in direct sales of any products. *Id.* Moreover, similarity of the marks will not address the issue of confusion on social network sites because if a user maintains an impersonating profile, the content of the page makes it clear it is not the accurate source. *Id.* Courts will likely find the marketing channels factor to be irrelevant if the user is simply expressing himself on a social network site. *Id.* The

The likelihood of confusion test must relate to social media in a way that protects an athlete's interests as instantaneously as the communication itself. "Due to the massive celebrity and brand adoption of social networking, a user could reasonably think that a URL like [twitter.com/TonyLaRussa](https://twitter.com/TonyLaRussa) is controlled by La Russa . . . [because] the URL signifies the source as La Russa."<sup>69</sup> The only way to find out if users are being misled as to the source of the twitter is through the use of an Initial Interest Confusion analysis.<sup>70</sup>

Initial Interest Confusion exists when a competitor's product lures consumers away from the desired native site and impermissibly capitalizes on the goodwill associated with the owner's mark.<sup>71</sup> The concept should be applied to all social media interaction. The concept of Initial Interest Confusion started as early as 1975 in a case called *Grotian v. Steinway and Sons*.<sup>72</sup> In that case, the court concluded that consumers were likely to believe that two companies were related, and Steinweg would draw consumers to its pianos based on the name similarities.<sup>73</sup> The court said the harm was not that a consumer would purchase a Grotian-Steinweg believing it to be a Steinway; rather, it was that a potential customer would be attracted to even consider buying a Grotian-Steinweg because of an initial impression that the two companies were related.<sup>74</sup> The analysis centers on the fact that a consumer is confused as to why they are seeing content displayed to them at a certain location.<sup>75</sup> Courts have even found infringement in trademark disputes when the confusion did not involve any purchases or financial profit from the use of the mark.<sup>76</sup> The Initial Interest Confusion analysis is the only approach that would apply to social me-

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type of goods or degree of purchaser care factor does not relate to social network sites because courts say that there are no purchasers of goods or services. *Id.*

69. Malachowski, *supra* note 61, at 256.

70. *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 382 (7th Cir. 1996) (explaining that the Initial Interest Confusion doctrine prohibits a competitor from intercepting potential customers away from the producer initially, by advertising its goods as the producer's, even if that confusion is eliminated before any actual purchase is made by the consumer).

71. Malachowski, *supra* note 61, at 257 (explaining that the competitor's product in a social media context is the fake profile that is competing with the native profile on the search results page).

72. 523 F.2d 1331 (2d Cir. 1975).

73. *Id.*

74. *Id.*

75. Ramsey, *supra* note 61, at 907.

76. *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1432. Where the infringing party had registered the domain name "plannedparenthood.com" the Court found the use to be unauthorized because Internet users who wished to visit the real Planned Parenthood website expended time and energy accessing defendant's site. *Id.*

dia interaction because social media is typically not a marketplace where protected marks are purchased.

In social media, Initial Interest Confusion exists if a social media user searches for Kobe Bryant and reaches a webpage entitled [twitter.com/kobebryant](http://twitter.com/kobebryant), but does not find the basketball player Kobe Bryant's webpage. Moreover, in the social media world, "followers,"<sup>77</sup> "friends,"<sup>78</sup> and "likes"<sup>79</sup> are all measures of popularity,<sup>80</sup> and can be seen as a form of profit for some.<sup>81</sup> A difference between the Initial Interest Confusion doctrine and a traditional confusion analysis is that the initial confusion is erased before the consumer purchases anything from the alleged infringer. Consumers experiencing Initial Interest Confusion is damaging because "consumers might be diverted from the trademark owner's product or service to the defendant's."<sup>82</sup> This deviation deprives the mark holder of the benefit of his investment in the notoriety of his mark, and simultaneously allows the advertiser/infringer to benefit from that notoriety.<sup>83</sup> This is precisely why the Initial Interest Confusion analysis must be used. Other social media users should not be able to benefit from the use of the athlete's name and mark by diverting users from the athlete's page.

After "confusion," the requirement of "commercial activities" is difficult to define. The Lanham Act provides two definitions of "commercial activities"<sup>84</sup> that do not traditionally extend to the creation of a fake social media profile or expression relating to an athlete's mark. However, due to advertising on social networking sites, as well as the vast array of business ventures being carried out on the sites, the definition of "commerce" must be broadened to include social media in-

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77. About Twitter, TWITTER, <http://twitter.com/about> (last visited Oct. 22, 2012).

78. Facebook-About, FACEBOOK, <https://www.facebook.com/facebook/info> (last visited Oct. 22, 2012).

79. *Id.*

80. Danah M. Boyd & Nicole B. Ellison, *Social Networking Sites: Definition, History, and Scholarship*, COMPUTER-MEDIATED COMM., 210, 211-13 (2008).

81. A friend of the author's is Major League Baseball pitcher, Josh Lindblom. When Josh was on the Los Angeles Dodgers in the beginning of the 2012 baseball season, he was told by the personal relations director for the team that he had to put on a promotion to reach a certain number of followers. *As told by Mr. Lindblom to the author at dinner on May 13, 2012.* If the teams want their players to have a certain number of followers then they clearly see a financial value in those players maintaining a fan base and a positive brand for the team.

82. *Id.*

83. *Id.*

84. 15 U.S.C. § 1114(1)(a) (stating that an infringer must use a registered mark "in connection with the sale, offering for sale, distribution, or advertising of any goods or services. . ."); 15 U.S.C. § 1125(a)(1)(A) (stating that an infringer must use a registered or unregistered mark on or in connection with any "goods, services, or commercial activities").

teraction.<sup>85</sup> For example, in addition to the ads run by Twitter and Facebook, a visit to Shaq's Twitter page displays tweets promoting his comedy tour, his soup ventures, and his interviews.<sup>86</sup>

A trademark is a part of a brand that is an "identifying symbol or mark that is entitled to legal protection because it is capable of 'exclusive appropriation.'"<sup>87</sup> "The persona of a distinctive mark includes both its source identification and its substantial advertising power or commercial magnetism."<sup>88</sup> Social networking falls squarely into a traditional definition of commerce, with many athletic entities filing trademark applications for hashtags<sup>89</sup> on Twitter.<sup>90</sup> Currently, athletic entities are trademarking hashtags and several professional and collegiate facilities display hashtags and twitter usernames on their courts and fields.<sup>91</sup> An athlete must be able to utilize social media to broaden his ability to earn income and maximize his athletic career.

### B. Cybersquatting Claims

The Internet allows users to register domain names. However, social media exposes usernames to increased abuse.<sup>92</sup> By registering a username reflective of a famous athlete, an imposter can lure users to an infringing profile.<sup>93</sup> This section discusses the Anticybersquatting Consumer Protection Act ("ACPA"), and its inability to protect ath-

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85. See Malachowski, *supra* note 61, at 259.

86. SHAQ on Twitter, TWITTER, <https://twitter.com/SHAQ> (last visited Jan. 15, 2014).

87. Spinello, *supra* note 23, at 344. The value of a brand could become diluted if it is subjected to negative and hostile treatment over the Internet. *Id.*

88. *Id.*

89. The # symbol, called a hashtag, is used to mark keywords or topics in a Tweet, and if used correctly, anyone who does a search for a certain hashtag will be able to find the corresponding tweet. *What Are Hashtags ("#" Symbols)?*, TWITTER HELP CENTER, <https://support.twitter.com/articles/49309-what-are-hashtags-symbols#> (last visited Dec. 24, 2012).

90. Feeley, *supra* note 35 (explaining that the Mid-American Conference filed a request to trademark #MACTION); Ritchie, *supra* note 35 (showing an example of Nike filing a trademark application for #makeitcount, which is promoted on Nike's website and other general marketing materials; and therefore goes beyond the general use of a hashtag as a communication tool). A brand owner interested in the promotion of a hashtag will be prepared to fight unauthorized use by a third party of the mark. *Id.* An owner of a hashtag would want to prevent offending or misleading use of the hashtag; for example, #makeitcountsux or #Adidasmakeitcount. *Id.*

91. Sam Laird, *First Football Endzone Hashtag Touches Down in Mississippi*, MASHABLE.COM, (Nov. 22, 2011), <http://mashable.com/2011/11/22/football-twitter-hashtag/> (showing a picture of the #HAILSTATE in the endzone of Mississippi State's endzone, and quoting the owner of the Dallas Mavericks, Mark Cuban saying, "it's a phenomenal idea.").

92. See Thomas J. Curtin, *The Name Game: Cybersquatting and Trademark Infringement on Social Media Websites*, 19 J.L. & POL'Y 353, 394 (2010). A username is a "'vanity URL' because the reservation of the username changes the URL from a numerical identification number to the individual's or corporation's name". *Id.* at n.18.

93. Curtin, *supra* note 92, at 358-59.

letes' use of social media to promote and secure their marks and brands.

### 1. ACPA's Protection Does Not Extend to Social Media Usernames

In 1999, ACPA was enacted to prevent the "bad faith, abusive registration and use of the distinctive trademarks of others as Internet domain names, with the intent to profit from the goodwill associated with those trademarks."<sup>94</sup> On its face, ACPA does not extend to social media usernames,<sup>95</sup> even though they are now more valuable than traditional domain names.<sup>96</sup> ACPA's likelihood of confusion analysis does not consider "whether the accused domain name is confusingly similar to the plaintiff's domain name, but whether it is confusingly similar to the plaintiff's trademark."<sup>97</sup> While the definition does not include social media sites, or their username identifiers, an athlete's trademark used in her username should be protected under the first requirement of ACPA.

A split of interpretation lies in the requirement of bad faith within ACPA.<sup>98</sup> When a person has the same or similar name to that of an athlete, but the profile of the site is substantially unique as that not of the athlete, the courts are not likely to find bad faith.<sup>99</sup> However, where a user visits a site that has the same name as an athlete without disclaimers of parody or otherwise protected speech, and the site includes statements damaging the athlete's marks, then the line becomes blurred.<sup>100</sup> As athletes increase their trademark applications, the protection to their brands become more crucial. Considering the commercial value of social media, ACPA must adapt its application to usernames so that its intent remains in effect. This is especially true in social media, which is the vehicle for the development of these marks.

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94. *Shields v. Zuccarini*, 254 F.3d 476, 481 (3d Cir. 2001); *see also Long*, *supra* note 26, at 552 (stating that goodwill is an integral part of a trademark, and there is a facial appeal in identifying goodwill with brand identity).

95. ICANN-Accredited Registrars, ICANN, <http://www.icann.org/registrar-reports/accredited-list.html> (last visited Oct. 22, 2012). Neither facebook.com nor twitter.com are listed. *Id.*

96. Curtin, *supra* note 92, at 377

97. *Id.* (stating that a vanity URL would satisfy the first requirement of ACPA).

98. *Id.* at 378 (stating that some courts find bad faith intent when a defendant abuses a username, but others have trouble finding said intent where a user reserves his own nickname as his username).

99. *See generally Malachowski*, *supra* note 61 (arguing that courts ought to look at the content of a potential infringer's site before determining liability).

100. *See La Russa v. Twitter, Inc.*, No. CGC-09-488101, 2009 WL 1569936 (Cal. Super. Ct. May 6, 2009). La Russa argued that the author of the profile intended, in bad faith, to divert Internet traffic away from his personal website and make a profit from the injury to La Russa's mark. Curtin, *supra* note 92, at 358.

## 2. *The Uniform Domain Name Dispute Resolution Policy under the Internet Corporation for Assigned Names and Numbers*

The Uniform Domain Name Dispute Resolution Policy (“UDRP”) provides a fast, online procedure for controlling the most outright examples of bad faith domain registration.<sup>101</sup> Successful claimants in a UDRP proceeding can have the domain name transferred to them, rather than having the domain name cancelled or held.<sup>102</sup> However, a major drawback to the UDRP is that, because it is under the Internet Corporation for Assigned Names and Numbers (“ICANN”), it does not apply to social media usernames, as they are considered “vanity URL’s.”<sup>103</sup> Moreover, its system cannot adequately handle situations in which bad faith intent cannot be easily demonstrated.<sup>104</sup> Finally, the UDRP, even as the most expedited dispute resolution process, is not fast enough to handle the instantaneous communication of social media.

## 3. *The Social Media Site Policies Do Not Effectively Solve the Problem*

Social media platforms recognize the potential intellectual property concerns that can arise in a medium so fast, open, and unregulated.<sup>105</sup> Therefore, social media sites have implemented their own programs<sup>106</sup> to attempt to alleviate these issues.

Facebook maintains the right to reclaim usernames if they infringe on a trademark, but the mark owners are responsible for reporting any infringing use.<sup>107</sup> If successful, Facebook will transfer the

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101. Uniform Domain Name Dispute Resolution Policy, ICANN, <http://www.icann.org/en/ndr/udrp/policy.htm> (last visited March 14, 2013).

102. Connie L. Ellerbach, *UDRP Versus ACPA: Choosing the Right Tool to Challenge Cyber-squatting*, (2003), available at [http://www.fenwick.com/FenwickDocuments/UDRP\\_Versus\\_ACPA.pdf](http://www.fenwick.com/FenwickDocuments/UDRP_Versus_ACPA.pdf).

103. ICANN-Accredited Registrars, ICANN, <http://www.icann.org/registrar-reports/accredited-list.html> (last visited Oct. 22, 2012) (neither facebook.com nor twitter.com are listed).

104. *Id.*

105. See Malachowski, *supra* note 61, at 256 (stating that consumers expect brands and celebrities to be present on the social networks; therefore, they are likely to be confused by a post-domain username with the name of an athlete they are searching).

106. Facebook Copyright Policy, FACEBOOK, [http://www.facebook.com/legal/copyright.php?howto\\_report](http://www.facebook.com/legal/copyright.php?howto_report) (last visited Oct. 22, 2012) (providing a link for an alleged trademark infringement and explaining that Facebook cares about intellectual property rights); Twitter Trademark Policy, Twitter Help Center, <https://support.twitter.com/articles/18367-trademark-policy#> (last visited Oct. 22, 2012) (explaining that users can report any infringing use to Twitter administrators; however they must also provide proof of registration).

107. Help Center, FACEBOOK, <http://www.facebook.com/help/?page=897> (last visited Oct. 22, 2012); see also Report an Infringing Username, FACEBOOK, [http://www.facebook.com/help/contact.php?show\\_form=username\\_infringement](http://www.facebook.com/help/contact.php?show_form=username_infringement) (last visited Oct. 22, 2012).



username to the trademark owner.<sup>108</sup> However, this policy is reactive, rather than proactive. When the Internet is involved, the damage occurs instantly. A reactive approach does not prevent the damage; a proactive approach underlined in deterrence is the only possible effective preventative measure. Athletes require a proactive approach to protect their trademarks, brands, and names because in the social media age, the damage can be done in a matter of minutes.

Considering the instantaneous damage, who knows how long Facebook will take to answer a complaint of infringement? Twitter has implemented a verification policy in which the real account of an athlete, or any famous person or entity, has a blue badge next to their name.<sup>109</sup> While this partially helps users alleviate some confusion, it does not address the situations in which users benefit from having an athlete's name in their profile.<sup>110</sup>

Additionally, cybersquatters continue to abuse the social media platforms that athletes are attempting to use in order to maximize their earnings potential. Twitter's policy is similar to Facebook's in that it is reactive.<sup>111</sup> Trademark owners must wait until a violation occurs, then wait for the site to return the result of a complaint. In that amount of time, the damage is already done.<sup>112</sup> This problem is multiplied for athletes because they only have a limited time to earn income, and when users violate their marks on social media, athletes lose potential income even if the damage is only for a few days. This damage can hinder potential endorsement deals or sponsorships, or even negatively affect a playing contract.

### III. PROPOSAL

This section provides three ways to address the problem of athletes' trademarks being unprotected from imposters on social media websites. First, to maintain a trademark infringement or dilution claim, an Initial Interest Confusion analysis must be used. Second, the Lanham Act's definition of commerce must include the use of social media

108. *Id.*

109. See About Verified Accounts, TWITTER, <http://support.twitter.com/groups/31-twitter-basics/topics/111features/articles/119135-about-verified-accounts> (last visited Oct. 22, 2012).

110. User Search for "shaq", TWITTER, <https://twitter.com/i/#!/search/users/shaq?q=shaq> (last visited Oct. 22, 2012) (results yield pictures of the native, verified Shaquille O'Neal, with twitter accounts such as "Shaquille O'Neal @THA\_REAL\_SHAQ" with 18,267 followers and the exact same profile explanation as the verified Shaq account, as well as "Shaq @THE\_REEL\_SHAQ" with 7,844 followers).

111. Name Squatting Policy, TWITTER HELP CENTER, <http://support.twitter.com/articles/18370-name-squatting-policy> (last visited Oct. 22, 2012).

112. Curtin, *supra* note 92, at 376.

sites. Third, the social networking sites themselves must modify their own policing entities so that their trademark protections become proactive rather than reactive. These solutions will tailor the current legal landscape to accommodate the use of marks on social media websites, and most importantly, deter the infringement of mark holders' rights on social media sites.<sup>113</sup>

#### A. Trademark Law Requires Amending

This three-part proposal addresses athletes' trademarks remaining unprotected when used on social media websites.<sup>114</sup> More protection is necessary because trademark law requires adaptation to the social media context so that athletes receive the requisite legal protection.<sup>115</sup>

First, Initial Interest Confusion analysis should be used in determining trademark infringement. As previously stated, in order for trademark infringement to occur, there must be a likelihood of confusion.<sup>116</sup> In order to ensure that social media interaction is protected by trademark infringement, the Initial Interest Confusion approach must be used because it centers on the user's confusion as to why they are seeing certain profiles in certain locations.<sup>117</sup> In this approach, the competitors are considered the fake profiles that appear on the search results page.<sup>118</sup>

Second, social media must be recognized as commerce.<sup>119</sup> The Lanham Act provides for two definitions of "commercial activities" and neither of them explicitly includes the use of social media.<sup>120</sup> Commerce is no longer just brick and mortar sales of tangible items. The use of social media to build commercial value can be summed up in one statement: "Why invest in something if you aren't going to get

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113. Malachowski, *supra* note 61, at 226 (stating that Dell Computers used its Twitter page to create two million dollars in sales in the first six months of 2009).

114. See Steven Seidenberg, *Names' Sake: Social media pose trademark threats for companies*, INSIDECOUNSEL.COM, (Sept. 1, 2009), <http://www.insidecounsel.com/2009/09/01/names-sake> (discussing how companies and celebrities are at risk of someone stealing their identity because the law has not caught up to social media, as it is an "uncharted territory").

115. See Jacob Cohen, *Social Media In The Sports Agency Industry*, SPORTS AGENT BLOG, (June 2006), <http://www.sportsagentblog.com/2012/06/26/social-media-sports-agency-industry/> (stating that those who do not adapt to social media in the sports business world will be left at a "considerable disadvantage").

116. *Supra* note 67; Spinello, *supra* note 23, at 349.

117. *Supra* note 77; Ramsey, *supra* note 61, at 907.

118. *Supra* note 76; Malachowski, *supra* note 61, at 257.

119. Emphasis added.

120. *Supra* note 84; 15 U.S.C. § 1114(1)(a) (stating that an infringer must use a registered mark "in connection with the sale, offering for sale, distribution, or advertising of any goods or services. . ."); 15 U.S.C. § 1125(a)(1)(A) (stating that an infringer must use a registered or unregistered mark on or in connection with any "goods, services, or commercial activities").

anything back?”<sup>121</sup> There will certainly be an increase in athletes’ desire for greater trademark protection “as the ability to create merchandise that can be trademarked and sold directly to a social media following increases.”<sup>122</sup>

The third part of the solution is that social media sites must maintain a policing entity of all registered marks that request protection. Athletes can only do so much on their own, and the sites themselves need to ensure that their users are protected. These policing entities should constantly police athletes’ marks on social media sites to ensure that no infringement or other trademark violations occur that can devalue an athlete’s brand.

### B. *This Amendment Will Give Athletes Proper Protection*

This proposal would solve the problem because when the athlete or a policing entity discovers a violation, a decision would quickly be made on how to remedy the infringement.<sup>123</sup> Using the Initial Interest Confusion analysis, the element of confusion is satisfied as soon as users search an athlete’s name, click on, and “friend,” “follow,” or “like” the profile of someone who is not that athlete. The threat of litigation would deter most users from infringing on an athlete’s mark; however an athlete must be extremely careful when he threatens sports fans with legal remedies.<sup>124</sup> Nonetheless, an element of trademark infringement is satisfied using Initial Interest Confusion analysis.

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121. Christina Warren, *Facebook Fans Valued at \$3.60 Each*, MASHABLE.COM, (April 14, 2010), [http://mashable.com/2010/04/14/facebook-fan-valuation/?utm\\_source=feedburner&utm\\_medium=feed&utm\\_campaign=feed:+Mashable+%28Mashable%29&utm\\_content=Netvibes](http://mashable.com/2010/04/14/facebook-fan-valuation/?utm_source=feedburner&utm_medium=feed&utm_campaign=feed:+Mashable+%28Mashable%29&utm_content=Netvibes) (stating that having a Facebook presence is no longer an option; rather, it’s a necessity). For athletes, or their representatives, whether the value is \$1 or \$10 per fan or follower, the athlete will end up benefiting from the increased exposure. Darren Heitner, *Attaching Value to Your Social Media Presence*, SPORTS AGENT BLOG (last visited Nov. 12, 2012). Whether the social media presence raises a playing contract, or results in endorsements for athletes; one way or another, there is significant value in maintaining a positive social media presence—and it must be protected.

122. Pavony & Thomas, *supra* note 29, at 164 (stating that there has never been a better method for direct to consumer sales than Twitter and websites provide). More and more athletes have Twitter or Facebook profiles that contain direct links to pages where users can immediately buy merchandise containing the athlete’s trademark(s). See Twitter and Facebook of Shaq, RGIII, Bryce Harper, etc.

123. Jason Peck, *Sports and Social Media-Why Should Agents Care?*, TAKE A PECK, (Aug. 26, 2010), <http://www.jasonpeck.com/2010/08/26/sports-and-social-media-why-should-agents-care/>.

124. Curtin, *supra* note 92, at 386 (stating that the high cost of litigation could discourage users from expressing themselves because they simply would not want to risk being sued for trademark infringement); compared to Malachowski, *supra* note 61, at 230 (discussing the example of two Coca-Cola fans who created an unauthorized Facebook page for Coke; and rather than demanding the creators to take it down, Coke flew them out to their headquarters and discussed strategies for growing the page together).

Second, including social networking in the definition of commerce would satisfy another element of mark infringement. Enforcing trademark violations on social media sites must strike a delicate balance between deterrence and maintaining a large fan base.<sup>125</sup> Were social media categorized as commerce, another element of trademark infringement would more easily be established so as to allow the athlete to enforce his rights as a mark holder. Thus, the Lanham Act should be amended to include social media under the definition of commerce.

When an essential element of a violation does not include social media, athletes are hesitant to exercise the rights of their trademark because fans do not want to see athletes filing meritless claims. However, if it is recognized that these violations occur *daily*, fans will appreciate that an athlete is protecting his brand using the legal system. Establishing social media as commerce gives the athlete confidence in using the law for protection.

Third, proactive policing by social media sites would deter imposters. As long as the law is clear and precedents are created, users will recognize the foolishness of creating a profile similar to that of an athlete or using an athlete's name in their own profile to gain search popularity.<sup>126</sup> Knowing that a violation is *happening* is the first step to stopping it. A policing entity of the sites would notify users that if they create a profile with an athlete's name and Initial Interest Confusion occurs, they would become subject to legal action. Proactive social media sites would also provide athletes with a greater understanding of where their marks are being infringed upon. If the sites themselves take a proactive approach, the athlete's involvement can be minimal on a public level, and his image can be positively maintained without taking legal action unless absolutely necessary. The main goal is for the law to protect an athlete so that he is able to confidently utilize social media to improve his brand and produce income off the field. The most efficient way to do this is for the law to be known to potential imposters so that they are deterred from taking the action in the first place.

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125. See Curtin, *supra* note 92, at 385-86 (stating that cyberspace can be a challenging setting for trademark owners because criticism can be spread very quickly and owners can lose control over the reputation of their marks); compared to, Anne L. Albertson, *Trademarks in the Social Media Age*, BUCHALTER NEMER: A PROFESSIONAL LAW CORPORATION, at \*3 (discussing an example where toy company Hasbro experienced consumer backlash when they sued the creators of "Scrabulous," an online version of Scrabble available on Facebook, for trademark infringement).

126. *Supra* note 73, at 21. Searches of LeBron's wife or Kobe's wife brings up scandalous models or other fake profiles of people who are benefiting from having the name of a famous athlete in their vanity. *Id.*

C. *Athletes Can Maximize Their Income with Added Protection*

If the law does not protect trademarks where they are used, then there is no valid reason to seek out the protections of a trademark. Fans want to know as much as possible about their heroes, and social media sites give them the ability to follow their every move, but with negative consequences.<sup>127</sup> Word travels faster than ever before on social media platforms,<sup>128</sup> and the very venue that brings the parties into court could cause the destruction of an athlete's value.<sup>129</sup> Clearly, social media sites cannot possibly cure all trademark violations on their own; however, the existence of such a deterrence program would discourage imposters.

"The average career span of an athlete is short as compared to non-athletes. In view of this shortened span that is not immune from the ever-expanding cost of living, it is important that athletes be able to transition to off-the-field careers that offer consistent income streams."<sup>130</sup> Taking this into account, this proposal would force the courts to recognize the ability of social media sites to build and maintain an athlete's value through the use of protected trademarks.<sup>131</sup>

Athletes and their representatives must be aware that, as time goes on, "there is more of a perception of a value of intellectual property."<sup>132</sup> Athletes must educate themselves in how to utilize social

127. Cohen, *supra* note 115.

128. Todd Leopold, *In Today's Warp-Speed World, Online Missteps Spread Faster Than Ever*, CNN.COM, (March 6, 2012 7:14 AM), <http://www.cnn.com/2012/03/06/tech/social-media/misinformation-social-media/index.html> (explaining that this generation's connected world where social networking has made us all news sources, misinformation is used and repeated more quickly than ever because, "Wrong or right, speed is exciting" (quoting science writer James Gleick). One psychology professor noted that with everyone on a global platform to shout their opinions without regard for accuracy, he is worried that "bad information is driving out good." (quoting Frank Farley, a psychology professor at Temple University)).

129. *See generally, Id.* If an athlete threatens an alleged imposter with litigation, this third party could very easily begin a social media revolution that makes the athlete out to be an unfriendly, impersonal, or entitled "celebrity" in the eyes of the public.

130. Pavony & Thomas, *supra* note 29, at 165, quoting *Cabbott*. Most people have a professional career span of thirty years or more; however a Major League Baseball player's average career lasts 6.5 years, and an NFL player's average career is 3.5 years of non-guaranteed money. Bradley Shear, *Estate Planning for Entertainers and Professional Athletes*, AMERICAN BAR ASSOCIATION GENERAL PRACTICE, SOLO & SMALL FIRM DIVISION, (Fall 2009) [https://www.americanbar.org/newsletter/publications/law\\_trends\\_news\\_practice\\_area\\_e\\_newsletter\\_home/ep\\_feat\\_4.html](https://www.americanbar.org/newsletter/publications/law_trends_news_practice_area_e_newsletter_home/ep_feat_4.html). Internet and social media assets could be involved in estate planning because the names associated with websites or social media usernames contain value in the commercial world. *Id.*

131. Cohen, *supra* note 115 (quoting a prominent NFL agent as saying, "We have several players making tens of thousands of dollars a year off their twitter accounts alone").

132. Cynthia Sanders, "Don't be a Clown Bro," *Heavy hitter weigh in on protection of pro athlete catch phrases*, OBER KALER IPWATCH, (July 10, 2012), available at <http://oberipwatch.com/2012/07/10/dont-be-a-clown-bro-heavy-hitters-weigh-in-on-protection-of-pro-athlete-catch-phrases/> (stating that the newfound awareness of athletes to take advantage of exclusive rights to

media to promote their brand during and after their playing career.<sup>133</sup> One NFL agent said, “Twitter has also provided value through its keyword filters. I have had many local media outlets call me about a client immediately upon seeing a team name mentioned.”<sup>134</sup> In one particular tweet, the agent was able to search using “Seahawks,” “Central Washington,” “NFL,” and the name of his player so that his tweet appeared on as many searches as possible in the relevant areas of interest.<sup>135</sup> Search results bring value, and the athlete must be protected so that unauthorized users are unable to destroy potential income.

#### IV. CONCLUSION

Athletes do not need to resort to complex litigation to resolve violations of their trademarks on social media pages. Impersonators are able to drive down the value of an athlete’s mark when they use it for purposes other than promoting the athlete. Internet search results bring value to athletes. When people exploit “Lebron James” or “Kobe Bryant” in their username to attract search hits, this is a violation of the rights of the athlete.

In order for this problem to be taken seriously, and to build uniformity, the analysis of the law must be consistent. Rather than taking varied approaches at each element, courts must implement the Initial Interest Confusion approach. Courts also must realize that social media *is* commerce, so as to uniformly evaluate each claim. In mediums such as social networking websites, damage can occur before an athlete even has a chance to find the imposter. Therefore, a proactive approach backed in deterrence, and internal policing from the sites themselves, is the only way to achieve the desired uniformity.

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catch phrases and names does not take away from their ability on the field; rather, it is something they have to do or else no one will care about their trademarks).

133. Williams, *supra* note 55, at 16 (“I think athletes are becoming a little smarter about their own brand and wanting to make multiple streams of income for themselves both on and off the field,” Thomas said.”).

134. Cohen, *supra* note 115 (stating the agent [Travis Martz] used the tweet, “@BusinessArena—Report from Seattle Seahawks camp is Central Washington client Justin Helwege balled out on OTA Day 1!! Congrats on first NFL contract!!”).

135. *Id.* This situation clearly illustrates the idea that showing up on search results adds value to an athlete. When imposters are able to have an athlete’s name in their username or profile page, this takes away from the likelihood of a media outlet or other valuable party seeing the tweet and reaching out to the athlete for an interview or endorsement offer.

