

# Maintaining the Balance: Whether a Collegiate Athlete’s Filing of a Federal Trademark Application Violates NCAA Bylaws.

Ryan S. Hilbert<sup>1</sup>

I.Introduction. ....	120
II.Student-Athletes and Commercial Activities. ....	123
III.The “Bona Fide” Intent Requirement Under the Lanham Act.....	124
IV.Application of Section 1(b) of the Lanham Act to Student-Athletes.....	126
V.Conclusion. ....	129

## I. INTRODUCTION.

It is no secret that professional athletes can, and frequently do, obtain federally-registered trademarks for those words or phrases they have coined or with which they are associated. Even a casual review of the U.S. Patent and Trademark Office’s records reveals marks owned by NBA phenom Jeremy Lin (LINSANITY<sup>2</sup>), former Denver Bronco and current New York Jet quarterback

---

1. Ryan S. Hilbert is Special Counsel at Sheppard Mullin Richter & Hampton, LLP, where he is a member of the Firm’s Intellectual Property and Litigation Practice Groups and its Sports Industry Team. This piece is intended for scholarly discourse, educational use, and informational purposes only, and is not intended to be an exhaustive discussion. The views expressed herein are Mr. Hilbert’s current, personal views, and should not be attributed to, and do not necessarily represent, the views of Sheppard Mullin Richter & Hampton, or any of the Firm’s former, present or future clients. Mr. Hilbert can be reached at [rhilbert@sheppardmullin.com](mailto:rhilbert@sheppardmullin.com).

2. On February 13, 2012, Jeremy Lin filed Application Serial No. 85/541,426 for LINSANITY for “duffel bags, knapsacks, all purpose sport bags, backpacks, handbags” in Class 18; “cups, mugs, aluminum water bottles sold empty, plastic water bottles sold empty, reusable stainless steel water bottles sold empty, insulating sleeve holders for beverage cans, insulating sleeve holders for bottles” in Class 21; “clothing, namely, shirts, t-shirts, sweatshirts, hooded sweatshirts, jackets, hooded jackets, coats, headbands, sports jerseys, nightshirts, pajamas, pants, rain coats, rain wear, robes, scarves, shorts, socks, sweaters, sweatpants, underwear, warm-up suits, wristbands, sweatbands, belts; footwear, namely, shoes, slippers, sandals, athletic footwear, sneakers; headwear, namely, caps, hats, visors, bandanas” in Class 25; “toys, namely, action figures; sporting goods, namely, basketballs, shooting sleeves in the nature of body limb sleeves for use in basketball” in Class 28; and “sports drinks; beverages, namely, energy drinks, non-alcoholic fruit juice beverages” in Class 32.

Tim Tebow (TEBOWING<sup>3</sup>), New York Jet cornerback Darelle Revis (REVIS ISLAND<sup>4</sup>), and former NBA great Shaquille O’Neal (SHAQTACULAR<sup>5</sup>). But what scholars and fans alike may not know is that today’s athletes seem to be filing trademark applications earlier and earlier and likely will continue to do so.

Shortly after former University of North Carolina (UNC) basketball star Harrison Barnes became the seventh pick in the 2012 NBA Draft, he revealed that he always intended to create a brand for himself on the basketball court.<sup>6</sup> In fact, as it turns out, Barnes had even gone so far as to file a trademark application with the U.S. Patent and Trademark Office (“USPTO”) for the word mark THE BLACK FALCON – his nickname at UNC. Barnes filed his application on August 19, 2011, months before he had played his last year of college ball and almost a full year before he was selected to play in the NBA.<sup>7</sup> Now that Barnes is done participating in college athletics, the NCAA Bylaws no longer preclude him engaging in commercial activities and he can obtain a federal trademark registration. Once he does so, Barnes will enjoy constructive nationwide trademark rights dating back to August 19, 2011 – *i.e.*, the date the application was filed. The fact that Barnes was an amateur at the time, or that he could not and did not commence use of the mark until months later, is immaterial to the USPTO.

Contrast Barnes’ situation with that of another former college basketball star and the top pick of the 2012 NBA Draft, Anthony Davis. Right around the time Barnes was sharing his brand aspirations, Davis was making headlines of his own for a number of trademark applications he had filed for words based on his connected eyebrows, or “unibrow.”<sup>8</sup> Unlike Barnes, Davis did not file his

---

3. On December 20, 2011, the company who handles Tim Tebow’s marketing and endorsement deals, XV Enterprises LLC, filed Application Serial No. 85/499,416 for TEBOWING for “online and website-based education and entertainment in the field of training, sports, and cultural activities; personal appearances” in Class 41.

4. On January 7, 2010, Darrelle Revis filed Application Serial No. 77/907,325 for REVIS ISLAND for “t-shirts, sweatshirts, sweatpants, hats, footwear, sleepwear, swimwear” in Class 25.

5. On June 10, 2011, Mine o’ Mine, a company formed, owned and operated by basketball star Shaquille O’Neal, filed Application Serial No. 85/343,540 for SHAQTACULAR for “charitable fundraising services; organizing, arranging and conducting charitable fundraising events; charitable fundraising services, namely, organizing and arranging events and festivities for the public, in which athletes or entertainers volunteer their assistance to benefit children with social and economic disabilities” in Class 36.

6. Andrew Carter, *Harrison Barnes hopes his brand takes flight -- just like Mike*, THE NEWS & OBSERVER (June 30, 2012), <http://www.newsobserver.com/2012/06/30/2171792/harrison-barnes-hopes-his-brand.html#storylink=cpy>.

7. On August 19, 2011, Harrison Barnes filed Application Serial No. 85/402,627 for THE BLACK FALCON for “action figures, basketballs, golf clubs, golf gloves, golf bags” in Class 28 and “on-line journals, namely, blogs featuring information and content about sports” in Class 41.

8. Darren Rovell, *Anthony Davis Trademarks His Brow*, CNBC (June 30, 2012), <http://www.cnbc.com/id/47951613>. Davis told CNBC sports business reporter Darren Rovell that he filed the applications because he did not want anyone “to try to grow a unibrow because of [Davis] and then try to make money off of it.”

trademark applications – which are for marks like FEAR THE BROW<sup>9</sup> and RAISE THE BROW<sup>10</sup> – until after his college career was over. While still laudable – especially since Davis acted proactively and did not wait until after he had played his first NBA game – Davis’ relative delay in filing allowed someone else to file an application for at least one his marks, FEAR THE BROW, before him.<sup>11</sup> Now, Davis is in a highly publicized trademark fight over who owns prior rights to FEAR THE BROW.<sup>12</sup>

It is clear from the examples above that there are distinct advantages for those athletes who file trademark applications early. Indeed, even though Davis filed relatively early, he would now have priority over the application that currently stands in his way had he filed in August 2011 when Barnes did. But one question that logically arises from these examples is: as more athletes file trademark applications before their college athletic careers are over, how will the NCAA respond? Will the NCAA find that a college athlete who files a federal trademark application before his or her college playing days are over violates the NCAA Bylaws?

As explained below, certain NCAA Bylaws preclude a student-athlete

9. On June 5, 2012, Anthony Davis filed Application Serial No. 85/643,417 for FEAR THE BROW for “after-shave; cosmetics; deodorants and antiperspirants; fragrances; hair care preparations; non-medicated skin care preparations; perfumes, aftershaves and colognes; shaving preparations; skin cleansers; skin lotions; soaps for body care” in Class 3; “book covers; books in the field of sports; bumper stickers; calendars; decals; document covers; events albums; facial tissue; ink pens; lunch bags; memo pads; napkin paper; newsletters in the field of sports; note cards; note pads; paper pennants; pencils; posters; publications, namely, brochures, booklets and teaching materials in the fields of sports; sports trading cards; stationery; stickers; unmounted and mounted photographs; wrapping paper” in Class 16; “aluminum water bottles sold empty; bottle openers; bottles, sold empty; bowls; combs; containers for household or kitchen use; cups; insulating sleeve holder for bottles; insulating sleeve holders for beverage cans; lunch boxes; mugs; plastic water bottles sold empty; portable coolers; waste baskets” in Class 21; “belts; cloth bibs; coats; footwear; hats; headbands; hosiery; jackets; jerseys; night shirts; pajamas; pants; parkas; rugby shirts; shorts; sport shirts; sweat pants; sweat shirts; sweaters; t-shirts; tank tops; warm-up suits; wrist bands” in Class 25; “charitable services, namely, organizing and conducting volunteer programs and community service projects; endorsement services, namely, promoting the goods and services of others; on-line retail gift shops; producing promotional videotapes, video discs, and audio visual recordings” in Class 35; and “entertainment services, namely, participation in basketball; entertainment services, namely, personal appearances by a sports celebrity; providing a web site featuring sporting information; providing a website featuring information relating to the sport of basketball; providing news and information in the field of sports; sport camps; sports training services” in Class 41.

10. On June 4, 2012, Anthony Davis filed Application Serial No. 85/642,988 for RAISE THE BROW for the same goods and services included in his application for FEAR THE BROW.

11. On November 21, 2011, Reid Coffman, owner of the University of Kentucky apparel store Blue Zone, filed Application Serial No. 85/477,805 for FEAR THE BROW for “clothing, namely, footwear, headwear, tops, bottoms, shirts, pants, t-shirts, hooded sweat shirts, sweat pants, sweat shirts” in Class 25. This was almost seven months before Anthony Davis, who starred at the University of Kentucky, filed his application for FEAR THE BROW on June 5, 2012. Recently, Coffman told the TMZ website that, if Anthony Davis wants the trademark, he will have to pay for it. Coffman said: “If someone like Nike took this slogan over it could be worth millions. Anthony Davis Can Have My Trademark ... For a Price.” TMZ (June 29, 2012), <http://www.tMZ.com/2012/06/29/fear-the-brow-anthony-davis-trademark/>.

12. TMZ, *supra* note 12.

from using his or her name or likeness to promote any commercial product or service.<sup>13</sup> At the same time, a trademark applicant who has yet to use a mark in commerce<sup>14</sup> must possess a demonstrable “bona fide” intent to do so under Section 1(b) of the Lanham Act or else risk losing the application altogether.<sup>15</sup> That said, however, in this author’s opinion, there are compelling reasons why the mere filing of an “intent-to-use” (ITU) trademark application under Section 1(b) does not and should not violate the current version of the NCAA Bylaws.

## II. STUDENT-ATHLETES AND COMMERCIAL ACTIVITIES.

The United States Supreme Court has recognized the National Collegiate Athletic Association (“NCAA”) as “the guardian of an important American tradition” – amateurism in intercollegiate athletics.<sup>16</sup> The NCAA’s “Principle of Amateurism” states:

Student-athletes shall be amateurs in an intercollegiate sport, and their participation should be motivated primarily by education and by the physical, mental and social benefits to be derived. Student participation in intercollegiate athletics is an avocation, and student-athletes should be protected from exploitation by professional and commercial enterprises.<sup>17</sup>

In furtherance of this principle, the NCAA has enacted bylaws, such as NCAA Bylaw 12.5.2.1, which expressly preclude student-athletes from engaging in commercial activities. NCAA Bylaw 12.5.2.1 states:

After becoming a student-athlete, an individual shall not be eligible for participation in intercollegiate athletics if the individual: (a) Accepts any remuneration for or permits the use of his or her name or picture to advertise, recommend or promote directly the sale or use of a commercial product or service of any kind; or (b) Receives remuneration for endorsing a commercial product or service through the individual’s use of such product or service.<sup>18</sup>

The NCAA Bylaws also require a student-athlete who becomes aware of such activity to “take steps to stop such an activity” or risk losing his or her

13. See, e.g., NCAA, 2011-12 Division I Manual, Const. art. 12.5.2.1 (August 1, 2011) [hereinafter NCAA Manual].

14. The term “use in commerce” “means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” 15 U.S.C. § 1127 (2012). Whether such use necessarily violates NCAA Bylaw 12.5.2.1 is outside of the scope of this article.

15. Section 1(b) of the Lanham Act states: “A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.” 15 U.S.C. § 1051(b) (2012).

16. *Bloom v. NCAA*, 93 P.3d 621, 626 (Colo. Ct. App. 2004) (quoting *NCAA v. Bd. of Regents*, 468 U.S. 85, 101, 104 S. Ct. 2948, 2960, 82 L. Ed. 2d 70 (1984)); see also NCAA Manual, Const. art. I § 2 (c) (stating one of the stated purposes of the NCAA is “[t]o encourage its members to adopt eligibility rules to comply with satisfactory standards of scholarship, sportsmanship and amateurism.”).

17. NCAA Manual, Const. art II, § 2.9..

18. *Id.* at art. 12.5.1.

“eligibility for intercollegiate athletics.”<sup>19</sup>

The NCAA’s prohibition on commercial activities even extends to activities the student-athlete may have engaged in *prior* to becoming a student-athlete. Specifically, while NCAA Bylaw 12.5.1.3 permits a student-athlete to continue to receive remuneration for activity initiated prior to enrollment, this remuneration is *only* allowed if “the individual became involved in such activities for reasons independent of athletics ability; . . . no reference is made in these activities to the individual’s name or involvement in intercollegiate athletics; [and] . . . the individual does not endorse the commercial product.”<sup>20</sup>

In addition, unlike other NCAA bylaws, those NCAA Bylaws that address commercial activities do not contain any sport-specific qualifiers.<sup>21</sup>

Based on the foregoing, at least one court has interpreted the NCAA’s prohibition on commercial activities like endorsements and paid media appearances to be virtually absolute:

In [the Court’s] view, when read together, the NCAA bylaws express a clear and unambiguous intent to prohibit student-athletes from engaging in endorsements and paid media appearances, without regard to: (1) when the opportunity for such activities originated; (2) whether the opportunity arose or exists for reasons unrelated to participation in an amateur sport; and (3) whether income derived from the opportunity is customary for any particular professional sport.<sup>22</sup>

Even though a student-athlete can request a waiver of the NCAA’s Bylaws in certain situations, whether to grant or deny such a waiver is in the full discretion of the NCAA and courts are hesitant to intervene.<sup>23</sup> In *Cole v. NCAA*,<sup>24</sup> for instance, the court was “reluctant to replace the NCAA subcommittee as the decision-maker on private waiver applications” and stated that “the NCAA’s rules and decisions regarding the concerns and challenges of student-athletes are entitled to considerable deference . . . .”<sup>25</sup>

### III. THE “BONA FIDE” INTENT REQUIREMENT UNDER THE LANHAM ACT.

Unlike the NCAA Bylaws, U.S. trademark law promotes – and even rewards – commercial activity. “The fundamental purpose of a trademark is to

19. *Id.* at art. 12.5.2.2. Bylaw 12.5.2.2 states in its entirety:

If a student-athlete’s name or picture appears on commercial items . . . or is used to promote a commercial product sold by an individual or agency without the student-athlete’s knowledge or permission, the student-athlete . . . is required to take steps to stop such an activity in order to retain his or her eligibility for intercollegiate athletics.

20. *Id.* at art. 12.5.1.3.

21. *Cf., e.g., id.* at art. 12.3.1 (stating “an individual shall be ineligible for participation in an intercollegiate sport if he or she ever has agreed . . . to be represented by an agent for the purpose of marketing his or her athletics ability or reputation *in that sport*.”) (emphasis added).

22. *Bloom*, 93 P.3d at 626.

23. *Id.* at 627 (finding no abuse by the trial court in failing to fault the NCAA for rejecting a waiver).

24. 120 F. Supp. 2d 1060 (N.D. Ga. 2000).

25. *Id.* at 1071-72.

reduce consumer search costs by providing a concise and unequivocal identifier of the particular source of particular goods.”<sup>26</sup> Congress has defined a “trademark” as “any word, name, symbol, or device, or any combination thereof” used “to identify and distinguish [one’s] goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”<sup>27</sup>

There are two filing bases for a trademark application under federal trademark law.<sup>28</sup> The first is based on actual “use in commerce” under Section 1(a) of the Lanham Act. This basis is applicable when an applicant is already using a trademark in commerce with all the goods in the application.<sup>29</sup> When filing under Section 1(a), an applicant must also provide the date the mark was first used and a specimen (real-use sample) showing how the mark is actually being used with the goods for which registration is sought.<sup>30</sup>

The second filing basis is based on a “bona fide” intent to use a mark in commerce under Section 1(b) of the Lanham Act.<sup>31</sup> Under this Section, an applicant need not actually be using the mark with the goods and services identified in the application. Instead, the applicant need merely state that he or she has a “bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce . . . .”<sup>32</sup> It is this filing basis that is the focus of this article.

Over the years, the Trademark Trial and Appeal Board (“TTAB”), which decides appeals taken from registration refusals issued by the USPTO and oversees opposition and cancellation proceedings, has increasingly clarified what type of evidence is necessary to meet the requirement under Section 1(b). For example, a simple declaration or affidavit in which an applicant states that he or she “intends” to use a mark generally will not suffice. Indeed, in *Lane Ltd. v. Jackson International Trading Co.*,<sup>33</sup> the TTAB stated that an “applicant’s mere statement of subjective intention, without more, would be insufficient to establish [an] applicant’s bona fide intention to use the mark in commerce.”<sup>34</sup> Also generally insufficient is a demonstrated *intent* to use a mark without a corresponding demonstrated *ability* to do so. In *Honda Motor*

---

26. *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002).

27. 15 U.S.C. § 1127 (2012).

28. *Id.* (defining 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 . . .”).

29. Section 1(a) of the Lanham Act states: “The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.” 15 U.S.C. § 1051(a) (2012).

30. 15 U.S.C. § 1051(a) (2012).

31. 15 U.S.C. § 1051(b) (2012).

32. *Id.*

33. 33 U.S.P.Q.2d 1351 (TTAB 1994).

34. *Id.* at 1355.

*Co. v. Winkelmann*,<sup>35</sup> for example, the TTAB held that the requirements under Section 1(b) had not been met because there was no evidence that the applicant had the ability to manufacture “vehicles for transportation” – which were the goods in the application – notwithstanding its demonstrated intent to do so.<sup>36</sup>

Typically, the TTAB requires that an applicant be able to demonstrate his or her “bona fide” intent to use a mark through documentary evidence. In determining the sufficiency of such evidence, the TTAB “has held that the Trademark Act does not expressly impose ‘any specific requirement as to the contemporaneousness of an applicant’s documentary evidence corroborating its claim of bona fide intention.’”<sup>37</sup> However, at least some form of documentary evidence is usually necessary. In *SmithKline Beecham Corp. v. Omnisource DDS LLC*,<sup>38</sup> for example, the TTAB stated “[t]he absence of any documentary evidence on the part of an applicant regarding such intent constitutes objective proof that is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce.”<sup>39</sup> Applying this rule, the TTAB held in *Spirits International B.V. v. S. S. Tariş Zeytin ve Zeytinyağı Tarım Satış Kooperatifleri Birliği*,<sup>40</sup> that an applicant that had failed to produce any documentary evidence regarding its intent and affirmatively stated that no such documents exist did not possess a bona fide intent under Section 1(b).<sup>41</sup> The type of documentary evidence the TTAB has previously considered sufficient includes business plans, marketing plans, and correspondence with potential manufacturers, distributors or licensees.<sup>42</sup>

In order to move an application filed under Section 1(b) forward to registration, an applicant must eventually use that mark in commerce.<sup>43</sup> However, once that occurs, the trademark owner will own constructive nationwide rights to the trademark dating back to the date the application was filed, regardless of when use of the mark began.<sup>44</sup>

#### IV. APPLICATION OF SECTION 1(B) OF THE LANHAM ACT TO STUDENT-

---

35. 90 U.S.P.Q.2d 1660 (TTAB 2009).

36. *Id.* at 1664 (stating that “[a]pplicant must rely on specific facts that establish the existence of an ability and willingness to use the mark in the United States to identify its claimed [goods in the application] at the time of the filing of the application.”).

37. *Id.* at 1662.

38. 97 USPQ2d 1300 (TTAB 2010).

39. *Id.* at 1304.

40. 99 U.S.P.Q.2d 1545 (TTAB 2011).

41. *Id.* at 1549.

42. *See, e.g., Lane Ltd.*, 33 U.S.P.Q.2d at 1356.

43. 15 U.S.C. § 1051(c) (2012) (stating that “at any time during examination of an application filed under subsection (b), an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this Act, by amending his or her application to bring it into conformity with the requirements of subsection (a).”).

44. 15 U.S.C. § 1057 (2012) (“Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person . . .”).

## ATHLETES.

There is no question that the NCAA Bylaws preclude student-athletes from engaging in commercial activities. Nor is there any question that the NCAA considers this prohibition relevant to the principle of amateurism. However, the mere filing of a trademark application under Section 1(b) of the Lanham Act does not and should not violate either of these principles.

As explained above, Section 1(b) requires an applicant to possess a demonstrated “bona fide” intent to use a mark in commerce. However, merely stating an intent to do something in the future – even to engage in commercial activity – is not the same thing as actually doing that something. In fact, people “intend” to do things all the time but fail to follow through. A perfect analogy would be the student-athlete who states that he or she “intends” to one day go pro. Each year there are countless student-athletes who never make it to the next level in their particular sport, despite having every intent of doing so.

Even the TTAB’s arguably stringent requirements for substantiating a Section 1(b) claim would not automatically cause a student-athlete to run afoul of NCAA bylaws. As an initial matter, because this issue usually arises in the context of a trademark dispute and not as part of the initial application review process, it is possible that a student-athlete can obtain a federal registration without ever having to substantiate his or her bona fide intent under Section 1(b). Moreover, even in those situations in which one does have to substantiate his or her intent, this can still be done in the absence of business plans, marketing plans, and the like, so long as the surrounding circumstances support the student-athlete’s bona fide intent. Even if a student-athlete did have such documents, this still would not be enough to violate the NCAA Bylaws. Just as Silicon Valley boardrooms are littered with business plans and marketing plans that never went anywhere, the fact that a student-athlete may have such documents in his or her possession is a far cry from those plans ever reaching fruition, much less during the remainder of a student-athlete’s college career. Something more must be required before a student-athlete is deemed to violate the NCAA Bylaws.

One can argue that a student-athlete should not be allowed to file a trademark application under Section 1(b) because, once that application matures to registration, the student-athlete will receive a deferred benefit from his or her athletic ability in the form of prior constructive nationwide trademark rights. Indeed, there always exists the possibility that the NCAA enforcement division would interpret its Bylaws in this manner, notwithstanding language in the Bylaws that suggests the contrary. However, in this author’s opinion, any “benefit” that a student athlete might receive in this regard is too remote and speculative to be considered actionable. This is so for essentially two reasons.

First, contrary to popular belief, there is no direct *financial* benefit an athlete applicant receives simply by filing an application under Section 1(b). In fact, it is well-known that, unlike domain names and registered trademarks, a pending ITU trademark application cannot be assigned (*i.e.*, sold) standing



alone to a third party.<sup>45</sup> If anything, an athlete who files a trademark application under Section 1(b) will *incur* financial liabilities in the form of filing fees and legal expenses in connection with the prosecution of that application.<sup>46</sup>

Second, as alluded to above, there also is no *immediate* benefit an applicant receives simply by filing an application. Under the Lanham Act, an applicant has at least three years to use a mark in commerce before the application goes abandoned.<sup>47</sup> Therefore, depending on when the athlete filed the application in the first place, it is likely he or she does not need to use the mark in commerce until well after his or her college career is over. At most, the benefit a student-athlete applicant receives is a *future* benefit in the form of the subsequent ability to claim constructive nationwide rights dating back to the filing of the application. However, as also explained above, it is likely that many student-athletes will never end up using the mark such that the application goes abandoned before this benefit is ever realized.

There are also strong policy reasons for why the “bona fide” intent requirement under Section 1(b) should not run afoul of the NCAA Bylaws. For example, some sports, like professional basketball<sup>48</sup> and professional football,<sup>49</sup> effectively require athletes to play at least some college sports before they can jump to the pros. Therefore, it would be unfair if those athletes did not at least have an opportunity to preserve their trademark rights until that requirement has been satisfied and they are able to move on to the next level. So long as those leagues continue to dictate when a student-athlete may participate in their sport professionally, the student-athlete should have an opportunity to preserve his or her trademark rights (which could relate to his or her post-college commercial opportunities) until such requirements are met.

As another example, given the nature of an athlete’s trademarks in

---

45. There are only two ways a pending ITU application can be assigned to a third party. First, the mark is used in commerce and the application is converted under Section 1(c). *See* 15 U.S.C. §1051(c) (2012). The second way is if the application is assigned along with the underlying business with which it is associated. 15 U.S.C. §1060(a) (1) (2012). This rule is to prevent an applicant from engaging in “trademark speculation” whereby he or she files a number of trademark applications for marks in which others may be interested in later acquiring, much like domain name speculation.

46. Such expenses would necessarily have to come from the student-athlete himself or herself in accordance with those NCAA Bylaws related to future benefits. *See, e.g.*, NCAA Manual at art. 12.3.1.2.

47. *See* 15 U.S.C. § 1051(d) (2012) (stating that applicant has 36 months from the date on the notice of allowance to file a statement of use).

48. Under the NBA’s Collective Bargaining Agreement, a player must be at least 19 years old during the calendar year of the draft and, if not an “international player,” a year removed from his high school class graduation to participate in the NBA. *See, e.g.*, Nat’l Basketball Ass’n, Collective Bargaining Agreement, Art. X, § 1(b)(i) (2005), available at <http://www.nbpa.org/sites/default/files/ARTICLE%20X.pdf>.

49. Under the NFL’s Collective Bargaining Agreement, a player must either be out of high school for three years or have finished three college football seasons before joining the league. NFL Collective Bargaining Agreement August 4, 2011, Art. 6, Sect. 2(b) at 17, available at <https://www.nflplayers.com/Articles/CBA-News/2011-Collective-Bargaining-Agreement/>.

general, there is arguably nobody better suited to own these marks other than the student-athletes to which they relate. Like professional athletes, it only makes sense that a student-athlete would file for a mark he or she coined, or with which he or she is associated. Allowing student-athletes to preserve their rights to these marks in college increases their chances of obtaining registrations for these marks in the future. It would also keep them out of the hands of unscrupulous third parties who would seek to exploit the student-athletes before the student-athletes are in a position to perfect their trademark rights themselves.

#### V. CONCLUSION.

As the above examples demonstrate, today's athletes are getting more savvy about when they file for trademarks. As this trend continues, it is likely more college athletes will want to follow in the footsteps of Barnes – and avoid those of Davis – and file ITU applications before their college careers are over. And with good reason. By filing a trademark application under Section 1(b) early, an athlete can effectively hold his or her place in line at the USPTO until his or her college career is over and he or she can engage in commercial activities.<sup>50</sup> As the number of college athletes filing trademark applications increases, it is likely that the NCAA will eventually weigh in on whether a trademark application under Section 1(b) of the Lanham Act violates the NCAA Bylaws. But unless and until such time, it is this author's opinion that the mere filing of an ITU trademark application by a student-athlete does not and should not violate the current version of the NCAA Bylaws.

---

50. It is worth noting that this option applies only to those trademarks an athlete has coined or with which the athlete is associated while still in college. It will not apply to those "catch phrases" an athlete spontaneously utters as a pro, like Bryce Harper's statement "That's a clown question, bro," which is the subject of Application Serial No. 85/651,210, or Terrell Owens' phrase "I love me some me," which is the subject of Application Serial No. 77/351,301.