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Comments

FLAG ON THE PLAY: PROFESSIONAL SPORTS TEAMS CALLING TRADEMARK INFRINGEMENT ON THEIR SUPERFANS

I. INTRODUCTION

Sports fans that come decked out in their favorite team's colors and hold signs in support of their team are constant fixtures on game day.¹ These die-hard fans stand in the bleachers cheering on their team from the first play until the game clock expires.² Sports teams frequently entice these fans to attend games by offering free souvenirs for the first fans through the gates.³ Moreover, multiple sports teams encourage their "superfans" to stay actively involved by running contests that reward superfans for their knowledge and love of their team.⁴ In recent years, however, some superfans have taken their love for their team one step further, causing a stir amongst sports team trademark holders.⁵ Superfans opting to profit off of their favorite sports team by marketing their own prod-

1. See Madison Gray, *Why Are NBA Fans Showing Up To Games Wearing One Color?*, TIME NEWSFEED (May 12, 2011), <http://newsfeed.time.com/2011/05/12/why-are-nba-fans-showing-up-to-games-wearing-one-color/> (stating NBA fans have borrowed college football fans' tradition of wearing their team's colors on game day).

2. See David Luther, *College Football Rankings 2012: The 20 Rowdiest Stadiums in the Nation*, BLEACHER REPORT (Mar. 5, 2012), <http://bleacherreport.com/articles/1090935-college-football-rankings-2012-the-20-rowdiest-stadiums-in-the-nation/page/11> (noting Texas A&M fans yell and stand throughout their team's entire game).

3. See *Atlanta Braves 2012 Promotional Calendar Includes Fireworks, Live Music, Kids Run the Bases, Alumni Autographs, Bobbleheads, and Great Savings All Season*, ATLANTA BRAVES (Mar. 28, 2012), http://atlanta.braves.mlb.com/news/print.jsp?ymd=20120328&content_id=27700086&vkey=pr_atl&c_id=atl (listing promotional programs Atlanta Braves have in place for 2012 MLB season).

4. See *Steelers Name New Mascot 'Steely McBeam'*, PITTSBURGH POST-GAZETTE (Aug. 8, 2007), <http://www.post-gazette.com/stories/local/breaking/steelers-name-new-mascot-steely-mcbeam-496394/> (stating fan's submission for name of Steelers' mascot was chosen out of over 70,000 entries, and fan was awarded VIP package to Steelers home game).

5. See Melvin N.A. Avanzado, *Entertainment & Sports Litigation: Los Angeles Clippers Assert Trademark Rights Against Clipper Darrell*, ENTERTAINMENT LITIGATION BLOG (Mar. 2, 2012), <http://www.avanzadolaw.com/component/content/article/1-blog/30-clipper-darrell.html> (detailing Clippers organization's reaction to superfan making public appearances stemming from fan's love for team).

ucts and attending publicity events have led some trademark holders to seek legal action.⁶

One superfan who has not only become a household name in the Los Angeles area, but is also the most recent fan accused of trademark infringement, is Darrell Bailey.⁷ For the past fifteen seasons of the L.A. Clippers, Darrell Bailey, also known as “Clipper Darrell,” has attended over 350 consecutive home games while donning his signature red and blue suit.⁸ The Clippers initially supported Darrell’s love for his team, even including him in the Clippers’ official NBA website.⁹ In the last year, however, the Clippers have had a change of heart, asking Darrell to drop the “Clipper” from his name and to stop selling products relating to the team.¹⁰ In response to the Clippers’ requests, both fans as well as Clippers players have expressed their continued support for Clipper Darrell.¹¹ This presents two issues: what legal actions are available to the Clippers, and is it advantageous for a team to press charges against one of their most beloved fans?

This Comment begins by exploring the legal ramifications of a superfan “capitalizing” off of his or her team’s popularity. Part II of this Comment examines the history and background of trademark law, focusing on the Lanham Act’s provisions.¹² Part III discusses the causes of action that professional sports leagues have against superfans who profit without authorization from the team’s trade-

6. See *id.* (stating Clippers have opted to deny fan’s use of “Clipper” before his first name).

7. See *id.* (noting Los Angeles Clippers are protecting their trademark against infringement by their superfan, Darrell Bailey).

8. See Alissa Abril, *Clippers Cut Clipper Darrell*, SPORTS & ENTERTAINMENT L. BLOG (Mar. 2, 2012), <http://www.sportsandentertainmentlawblog.com/2012/03/clippers-cut-clipper-darrell/> (noting Darrell has been “Clippers’ biggest supporter” for fifteen seasons and has held season tickets for over ten years, attending games even while Clippers constantly lost).

9. See Avanzado, *supra* note 5 (stating Clippers’ official site contains biography of “Clipper Darrell”).

10. See Dan Woike, *Clippers Statement Regarding Clipper Darrell*, ORANGE CNTY. REGISTER CLIPPERS BLOG (Feb. 29, 2012), <http://clippers.ocregister.com/2012/02/29/clippers-statement-regarding-clipper-darrell/> (“We hold all of our fans in the highest esteem and we have been patient and generous with Mr. Bailey. He has not returned our support in an honorable way. He is not actually a fan of the Clippers, but a fan of what he can make off of the Clippers.”).

11. See Avanzado, *supra* note 5 (noting one player who tweeted “Bring back #Clipper Darrell,” while another player tweeted to Darrell, “WE GOT YOU!!”).

12. For a general discussion of the history of trademark law and background to the current state of the law, see *infra* notes 16-87 and accompanying text.

mark holders.¹³ Part IV sets forth possible defenses the superfan has in response to allegations of trademark infringement.¹⁴ Finally, Part V suggests that while sports teams will frequently prevail in litigation brought against superfans, the costs imposed by bringing legal actions against their fans will outweigh any benefit the teams receive.¹⁵

II. THE HISTORY OF TRADEMARK LAW AND THE ADVENT OF THE LANHAM ACT

Trademark law functions to protect both consumers and producers.¹⁶ Trademark law was initially established to prevent consumer confusion as to the source of goods by labeling goods “as the product of a particular trader.”¹⁷ As a corollary, trademark laws encourage producers to invest in their own products, as they will reap all benefits from such investment.¹⁸ Producers also receive protection from possible economic loss that would otherwise result in others trying to pass off the mark holder’s goods as their own.¹⁹ Property rights afforded to mark holders are not intended to be expansive, only prohibiting use of the mark that deprives the mark holders “of sales which they otherwise might have made.”²⁰ Consequently, trademark law promotes economic efficiency by reducing consumer costs in identifying the product quality they want while providing an incentive to producers to create desirable goods.²¹

13. For a general discussion on the causes of action that mark holders have against superfans that use their mark for profit, see *infra* notes 88-139 and accompanying text.

14. For a general discussion of the defenses that the superfan has against claims of trademark infringement, see *infra* notes 140-172 and accompanying text.

15. For a general discussion of the interests of both superfans and sports teams and how these two competing interests should be properly balanced, see *infra* notes 173-238 and accompanying text.

16. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 (1992) (Stevens, J., concurring) (quoting S. REP. NO. 79-1333, at 3 (1946)) (noting purpose of trademark law is primarily to protect consumers and also producers).

17. See David Franklin, *League Parity: Bringing Back Unlicensed Competition in the Sports Fan Apparel Market*, 86 CHI.-KENT L. REV. 987, 989 (2011) (noting trademark law developed primarily to prevent consumer confusion).

18. See Michael C. Shull, Comment, *Biting the Hand That Feeds: How Trademark Protection Might Threaten School Spirit*, 21 MARQ. SPORTS L. REV. 641, 642 (2011) (stating that trademark owners are protected against unauthorized uses of their mark thus, protecting their “reputation in the marketplace”).

19. See 15 U.S.C. § 1114(1) (2006) (listing protections afforded to producers against those who try to profit from another’s investment).

20. See *Borden Ice Cream Co. v. Borden’s Condensed Milk Co.*, 201 F. 510, 513 (7th Cir. 1912) (discussing property rights of mark holders).

21. See Joshua Saltzman, *Smack Apparel, College Color Schemes and the Muddying of Trademark Law*, 76 BROOK. L. REV. 1635, 1639-40 (2011) (noting economic effi-

Although trademark law protects consumers and producers, its primary focus is consumer interests.²² Mark protection is only awarded to producers to the extent that the mark is acting as a source identifier to consumers.²³ In addition to promoting well-informed consumers, trademark law encourages competition.²⁴ Increased competition in the marketplace pushes the price of merchandise down while giving consumers a wider selection of goods for purchase.²⁵ The consumer-focused competition aims of trademark law reinforce the idea that mark holders are not intended to have unlimited property rights.²⁶

The current state of trademark law is laid out in the Lanham Act of 1946.²⁷ The Lanham Act did not change the foundations of trademark law, but merely codified prior common law interpretations.²⁸ Under the Lanham Act, trademark holders can bring infringement actions via two different provisions.²⁹ First, under section 1114, trademark holders are protected when another's use of the registered mark is "likely to cause confusion."³⁰ Second,

ciency function of trademark law); see also J. Steven Gardner, Note, *Trademark Infringement, Likelihood of Confusion, and Trademark Parody: Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 28 WAKE FOREST L. REV. 705, 714 (1993) (stating consumers associate trademarks with certain qualities).

22. See Mark A. Kahn, *May The Best Merchant Win: The Law of Non-Trademark Uses of Sports Logos*, 14 MARQ. SPORTS L. REV. 283, 285 (2004) (emphasizing trademark law as "a consumer protection law").

23. See *id.* (stating when marks are not functioning as source identifiers they are not afforded protection).

24. See Stephanie Frank, *Showing Your School Spirit: Why University Color Schemes and Indicia Do Not Deserve Trademark Protection*, 92 B.U. L. REV. 329, 345 (2012) (stating endgame of trademark law is to promote competition).

25. See Matthew J. Mitten, *From Dallas Cap To American Needle and Beyond: Antitrust Law's Limited Capacity to Stitch Consumer Monopolies*, 86 TUL. L. REV. 901, 928 (2012) (noting existence of monopolies in marketplace pushes price of goods up for consumers).

26. See Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1694 (1999) (rejecting idea that trademark owners are intended to have property rights in their marks).

27. See 15 U.S.C. §§ 1051-1129 (2012) (discussing United States trademark law).

28. See Kahn, *supra* note 22, at 284 (noting Lanham Act codified prior common law trademark protections).

29. See 15 U.S.C. §§ 1114(1)-1125(a) (discussing who has standing in trademark action).

30. See *id.* § 1114(1) ("Any person who shall, without the consent of the registrant – (a) use in commerce any reproduction . . . or colorable imitation of a registered mark in connection with the sale . . . with which such use is likely to cause confusion, or to cause mistake, or to deceive; or (b) . . . or colorably imitate a registered mark . . . in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided.").

under section 1125(a), a trademark holder's registered or unregistered mark is protected when another's use of the mark is "deceptive," or, "is likely to cause confusion . . . as to the origin, sponsorship, or approval of" the mark's origin.³¹ To state a successful trademark infringement action under either provision, the mark holder needs to show: (1) distinctiveness of the mark, (2) likelihood of confusion, and (3) that the use of the mark does not infringe on a functional feature.³²

A. The Early Years of the Lanham Act

Initially, the Lanham Act sought to benefit consumers by emphasizing the likelihood of consumer confusion in trademark infringement actions.³³ Over the years, however, trademark law evolved, shifting the focus to benefitting producers.³⁴ This shift was due to trademark holders' increased belief that they held a property interest in their mark, as well as the advent of licensing agreements.³⁵ Compounding the problem, courts have continually relaxed the requirements of trademark infringement actions, en-

31. *See id.* § 1125(a) ("Any person who . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact . . . which – (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.").

32. *See, e.g.*, Shull, *supra* note 18, at 643 (listing requirements that trademark owners must meet to prove trademark infringement). For a further discussion on the elements of a trademark infringement action, see *infra* notes 88-139 and accompanying text.

33. *See* Mitten, *supra* note 25, at 905 (noting traditional rationale for trademark law was "to facilitate consumers' ability to identify desired goods and services having a consistent level of quality and to reduce their search costs by relying upon a trademark or service mark as an indicia or origin or source of particular brand of goods or services").

34. *See* *Bos. Prof'l Hockey Ass'n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1012 (5th Cir. 1975) (holding that "certain knowledge of the buyer that the source and origin of the trademark symbols" were plaintiff's satisfied Lanham Act's requirement, essentially eliminating likelihood of confusion element); *see also* Frank, *supra* note 24, at 334 (noting Boston Professional Hockey essentially held defendant liable for intentionally copying plaintiff's mark irrespective of consumer's actual confusion).

35. *See* Franklin, *supra* note 17, at 993 (noting trademark protection began to change when companies started to use their marks not just as source indicators, but also as products in themselves, especially in fan apparel); *see also id.* (stating change in public perception of "a product's 'source' changed as licensing agreements became commonplace" contributing to expanded scope of trademark law).

couraging trademark holders to bring legal actions against their most avid fans.³⁶

Beginning in the 1970s, courts began to expand trademark protection afforded to athletic marks.³⁷ The first major case to expand protection of a trademark holder's rights and effectively move away from the central purpose of the Lanham Act, was *Boston Professional Hockey Association v. Dallas Cap & Emblem Manufacturing Inc.*³⁸ The court reasoned that the likelihood of confusion requirement was met when a manufacturer other than the team used the mark because the public was likely to identify the mark as being associated with the team.³⁹ The ruling essentially exposed any manufacturer to liability for using a team's mark, regardless of a consumer's actual perception of the mark's source.⁴⁰ This represents a departure from the previous belief that the purpose of the Lanham Act's likelihood of confusion requirement was to ensure consumer awareness of the registered mark's source and origin.⁴¹

Scholars have criticized the holding in *Boston Professional Hockey* as misapplying the goals of trademark law.⁴² These scholars empha-

36. See Jeremy Kahn, *School Spirit; Rah, Rah, Rah (It's Protected)*, N.Y. TIMES, Jan. 7, 2007, at 4A, available at http://www.nytimes.com/2007/01/07/education/ed-life/07colors.html?pagewanted=print&_r=0 (chronicling trend of university trademark holders in bringing litigation to protect their mark); see also *NFL Claims Trademark Infringement*, ASSOCIATED PRESS, Jan. 30, 2010, available at <http://sports.espn.go.com/nfl/playoffs/2009/news/story?id=4871697> (stating NFL sent T-shirt makers cease-and-desist letters asking they stop selling shirts displaying cheer of New Orleans Saints fans).

37. See Kahn, *supra* note 22, at 303 (noting court extended trademark protection in order to benefit trademark owner).

38. See *Bos. Prof'l Hockey*, 510 F.2d at 1011 (acknowledging decision "may slightly tilt the trademark laws from the purpose of protecting the public to the protection of the business interests of plaintiffs" but viewing two aforementioned interests as intertwined). *Id.* at 1008. Here, plaintiffs, who played professional ice hockey, acquired trademark protection in their team symbols. *Id.* at 1009. Defendants who made and sold embroidered cloth emblems unsuccessfully attempted to enter into a licensing agreement with the plaintiffs to use their team "motifs." *Id.* Plaintiffs filed suit against defendants after they reproduced the plaintiffs' team marks on embroidered emblems, despite the unsuccessful negotiations. *Id.*

39. See *id.* at 1012 ("The confusion or deceit requirement is met by the fact that the defendant duplicated the protected trademarks and sold them to the public knowing that the public would identify them as being the teams' trademarks. The certain knowledge of the buyer that the source and origin of the trademark symbols were in plaintiffs satisfies the requirement of the act.").

40. See *id.* (rejecting District Court's focus on source of manufacture, which Fifth Circuit held was eliminated when Lanham Act was amended, and instead stated confusion relates to where consumers believe mark originated).

41. For a further discussion of the initial consumer-focused interpretation of trademark law, see *supra* notes 17-21 and accompanying text.

42. See Kahn, *supra* note 22, at 302-03 (stating likelihood of confusion analysis should not even apply to situations like *Boston Professional Hockey*, where logo was

size that the fundamental aim of trademark law is consumer assurance as to the quality of goods in the marketplace, not the creation of a property right in the mark.⁴³ Critics argue the emblems at issue did not indicate the quality of the merchandise, and thus the mark was not serving the traditional function of a trademark, which is to reduce research costs for consumers.⁴⁴ Despite the ongoing criticism of *Boston Professional Hockey*, courts have continually applied the case's line of reasoning.⁴⁵

Even though most courts continued to expand protections afforded to mark holders under the Lanham Act, one District Court held that use of a university's insignia was unlikely to cause confusion and, therefore, the court did not grant trademark protection.⁴⁶ In *University of Pittsburgh v. Champion Products, Inc.*, the University of Pittsburgh argued that use of the school's name and insignia on apparel and other items constituted trademark infringement, warranting protection.⁴⁷ The District Court held the insignia was unlikely to cause confusion because the defendant indicated that it was the actual source.⁴⁸ Moreover, there was no evidence indicat-

not being used to provide consumers with assurance of underlying product's quality); John J. Voortman, *Trademark Licensing of Names, Insignia, Characters and Designs: The Current Status of the Boston Pro Hockey Per Se Infringement Rule*, 22 J. MARSHALL L. REV. 567, 575-79 (1989) (stating *Boston Professional Hockey* created "the per se infringement rule," which was inconsistent with precedent and traditional trademark rights).

43. See Voortman, *supra* note 43, at 578 (advocating that per se infringement rule created in *Boston Professional Hockey* effectively "separate[d] confusion from the consumer's motivation for buying the product depriv[ing] the 'confusion' requirement of Section 32 of the Lanham Act of its principal if not its only policy significance."); Kahn, *supra* note 22, at 303-04 (stating "trademark law exists for the benefit of consumers" and while trademark owners derive benefits from owning marks, these benefits are "secondary in terms of the goals of trademark law.").

44. See Kahn, *supra* note 22, at 303-04 (arguing emblems did not signify level of quality and thus were not deserving of trademark protection).

45. See *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1546 (11th Cir. 1985) (applying likelihood of confusion analysis but stating confusion does not need to pertain to product's origin); see also *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 483 (5th Cir. 2008) (finding likelihood of confusion without examining whether consumers were actually confused as to source or origin of products).

46. See *Univ. of Pittsburgh v. Champion Prods., Inc.*, 566 F. Supp. 711, 719 (W.D. Pa. 1983) (rejecting suggestion in *Boston Professional Hockey* that trademark holders "had a property interest in its trademark distinct from the prevention of consumer confusion" and finding "it is not the province of the courts to create a property right in gross out of legislation intended solely to protect the consuming public and ethical businessmen from the depredations of manufacturers of counterfeit or deceptive products.").

47. See *id.* at 713 (stating that for over forty years, Champion sold goods bearing Pitt's insignia to entities not affiliated with Pitt).

48. See *id.* at 720 (indicating products clearly bore mark made by Champion).

ing that the defendant had tried to deceive customers into thinking the mark holder had actually produced the merchandise.⁴⁹ Despite the court's retreat from the producer-focused reasoning in *Boston Professional Hockey*, other courts did not follow suit.⁵⁰

B. Continued Expansion of Trademark Law and Increasing Cases of Infringement in the Professional Sports Context

Beginning in the 1980s, the majority of sports trademark infringement cases involved unlicensed uses of a protected mark by those who are in the business of producing sports apparel.⁵¹ In *Heisman Trophy Trust v. Smack Apparel Co.*, the United States District Court for the Southern District of New York considered the infringing use of an organization's mark by an unlicensed manufacturer.⁵² In that case, an unlicensed manufacturer produced sports merchandise bearing a resemblance to the organization's potential Heisman Trophy winners.⁵³ In finding an infringing use, the court rejected the defendant's argument that consumers knew the merchandise the defendant was producing was unlicensed and that therefore consumers were not confused as to the source of the goods.⁵⁴ Consequently, this decision placed little emphasis on consumers' likelihood of confusion, making it unlikely that any unlicensed use of a team's mark would subsequently be allowed.⁵⁵

In granting protection against unlicensed uses of teams' marks, courts have based their reasoning on increased consumer expecta-

49. *See id.* at 722 (finding that Pitt's insignia was only being used for decorative purposes, without any intent or likelihood of confusing consumers).

50. For a further discussion of the continued departure from a consumer-focused approach to the Lanham Act, see *infra* notes 122-124 and accompanying text.

51. *See Univ. of Kan. v. Sinks*, 644 F. Supp. 2d 1287, 1300 (D. Kan. 2008) (finding unlicensed manufacturer who sold t-shirts bearing phrases such as "Kansas Swim Team" constituted trademark infringement); *see also Tex. Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 523 (N.D. Tex. 2006) (holding that retailer's sale of sports apparel bearing Texas Tech's insignia constituted trademark infringement).

52. *See Heisman Trophy Trust v. Smack Apparel Co.*, 637 F. Supp. 2d 146, 152 (S.D.N.Y. 2009) (detailing infringing use by unlicensed clothing manufacturer that primarily sold to retailers).

53. *See id.* (stating suit was prompted by defendant producing "thirteen varieties of Heisman Trophy-related T-shirts.").

54. *See id.* at 157 (noting defendant argued that media publicity created public awareness that they were unlicensed manufacturers, which reduced likelihood of confusion).

55. *See id.* at 157-58 (rejecting defendant's argument that they incorporated their own logo and put disclaimers on t-shirts in question, stating that this defense has "limited" value).

tions regarding licensing agreements.⁵⁶ Over the years, as teams started to treat their marks as property rights and aggressively assert their power, consumers began to assume that teams sponsored all fan apparel.⁵⁷ Since consumer beliefs as to the source of a mark directly impacts likelihood of confusion, teams have been granted protection of their fan apparel as a result of consumers' changed perceptions.⁵⁸

Many scholars have argued this broadening of trademark protection raises a problem of circularity.⁵⁹ These scholars emphasize that if consumers think one needs a licensing agreement to produce team merchandise, trademark law will then have to require such authorization.⁶⁰ Accordingly, these scholars argue the courts should stick to the legal principles of trademark law that do not require a licensing agreement.⁶¹

Despite the fact that this protection is not based on legal doctrine, others argue the outcome is nevertheless consistent with the principles of trademark law.⁶² Proponents of extending protection against unlicensed uses highlight the fact that consumer perception still creates a likelihood of confusion when the team's logo is used in the absence of a licensing agreement.⁶³ Presently courts' accept-

56. See Franklin, *supra* note 17, at 996 (stating that for example, when consumers see merchandise bearing CUBS logo today, they presume team gave distributor their permission).

57. See Saltzman, *supra* note 21, at 1653 (noting increase in licensing has caused consumers to perceive team logos as functioning as seals of approval).

58. See *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 34 (1st Cir. 1989) (finding in regards to unlicensed use of organization's that mark confusion was likely). This holding was based on the fact that the shirts in question referred to the Boston Marathon and consumers were likely to purchase the shirts because of this reference. See *id.* The court reasoned that consumers were likely to be confused as to shirt's sponsorship, assuming the defendant's shirts were connected with the mark holder. See *id.*

59. See Saltzman, *supra* note 21, at 1652 (describing "problem of circularity"); see also 2 J.T. McCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 24:3, at 170 (2d ed. 1984) ("If consumers think that most uses of a trademark require authorization, then in fact they will require authorization And if owners can sue to stop unauthorized uses, then only authorized uses will be seen by consumers, creating or reinforcing the perception that authorization is necessary.").

60. See Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 489 (2005) (rejecting adherence to circular argument, stating "the fact that consumers may believe trademark owners have a right to control merchandise bearing their brands does not itself justify a merchandising right.").

61. See *id.* (stating courts should not keep "a bad law intact" but rather they should adhere to "a limited, likelihood-of-confusion rationale.").

62. See Franklin, *supra* note 17, at 997 (noting under trademark law consumer perception creates likelihood of confusion which in turn creates "the law" as to which uses of marks will require permission).

63. See *id.* (describing reason courts should adhere to circular reasoning).

ance of this circular reasoning has resulted in teams possessing a monopoly over fan apparel.⁶⁴ Thus, superfans who have not entered into licensing agreements will be barred from marketing any desirable sports merchandise.⁶⁵

Beginning in the twenty-first century, trademark holders in the sports industry have increasingly brought legal actions against the use of their team's mark.⁶⁶ This increase in litigation was partially due to the further extension of trademark protection to include protection of color schemes.⁶⁷ In *Qualitex Co. v. Jacobson Products Co.*, the Supreme Court held that in some circumstances color alone is entitled to trademark protection.⁶⁸ In *Qualitex*, the plaintiff was granted trademark protection for the green-gold color of its dry-cleaning pads because the color allowed consumers to identify the source of the goods.⁶⁹ In recent years, courts have followed the reasoning in *Qualitex*, which held that where the mark's color serves "as a symbol that distinguished a firm's goods and identifies their source, without serving any other significant function," color alone is enough to receive trademark protection.⁷⁰ In other words, for trademark owners to receive protection just for the color of their marks, the marks need only attain secondary meaning.⁷¹

During the late 2000s, the courts took trademark protection one step further in *Board of Supervisors of Louisiana State University Agricultural and Mechanical College v. Smack Apparel Co.*⁷² The Fifth Circuit in *Smack Apparel* held that where a mark's color has achieved secondary meaning and therefore identifies the mark's source, the color can also receive protection when combined with "other iden-

64. *See id.* (stating professional sports teams have gained complete monopoly over fan apparel).

65. *See id.* at 998 (noting "unlicensed fan apparel is completely barred from the marketplace").

66. *See* Frank, *supra* note 24, at 338 (describing dramatic increase in college sports litigation in mid-2000s).

67. *See* Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co., 550 F.3d 465, 476 (5th Cir. 2008) (finding that retailer violated Lanham Act by selling t-shirts with school's color schemes, logos, and designs).

68. *See* *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 166 (1995) (finding color meets basic legal requirements for trademark protection).

69. *See id.* (stating green-gold press color serves no other function but to act as symbol for identifying source of pads).

70. *See id.* at 166 (expressing when color alone can warrant trademark protection).

71. For a further discussion of secondary meaning, see *infra* notes 96-99 and accompanying text.

72. 550 F.3d at 465; *see* Saltzman, *supra* note 21, at 1646 (noting *Smack Apparel* departed from previous trademark cases).

tifying indicia.”⁷³ While allowing protection for color plus identifying indicia, the court did not indicate what types of formulations fall into this protected category.⁷⁴ Thus, the Fifth Circuit’s novel decision may protect “indicia” that is not a defined mark.⁷⁵

Despite the trend to offer protection to color schemes, the Fifth Circuit’s extension of trademark law in *Smack Apparel* does not comply with the purpose of the Lanham Act.⁷⁶ Similar to *Boston Professional Hockey*, the *Smack Apparel* decision gives teams the right to control all uses of their mark, ignoring the Lanham Act’s goal of protecting consumers.⁷⁷ Incidentally, this expansion has substantially restricted the superfan’s ability to market merchandise bearing his or her team’s colors.⁷⁸ It is unclear the extent to which superfans will be able to successfully use their teams’ color schemes due to the lack of a bright-line test in identifying “other-identifying-indicia.”⁷⁹ Moreover, since the boundaries of “other-identifying-indicia” are unclear, superfans risk unintentionally committing trademark infringement when using colors; thus, superfans are unlikely to even attempt to incorporate their teams’ colors.⁸⁰

Even though trademark protection has significantly expanded over the past several years, there has been no litigation involving individual superfans.⁸¹ The main reason for the lack of cases

73. See *Smack Apparel*, 550 F.3d at 471 (holding “t-shirts with the schools’ color schemes and other identifying indicia referencing the games of the schools’ football teams” constituted trademark infringement).

74. See Saltzman, *supra* note 21, at 1647 (noting court in *Smack Apparel* failed to define “other-identifying-indicia”).

75. See *id.* (stating “color plus other identifying indicia” does not “constitute a mark at all”).

76. See *id.* at 1653 (discussing improbability of consumers associating color scheme with one source; therefore, likelihood of confusion element of Lanham Act is not met).

77. For a further discussion on the Lanham Act’s focus on consumers, see *supra* notes 17-21 and accompanying text.

78. See *Texas Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 520 (N.D. Tex. 2006) (holding use of team’s scarlet and black color scheme bearing “a Double T” constituted trademark infringement).

79. See Saltzman, *supra* note 21, at 1649 (emphasizing lack of boundaries in defining what constitutes “color-plus-other-identifying-indicia”).

80. See *id.* at 1649-50 (noting confusion regarding what constitutes infringing use). After the Fifth Circuit ruled against *Smack Apparel*, some of the shirts produced by the company referencing college teams remained on their website, while other shirts referencing the teams were taken down, making it unclear what constitutes an infringing use. See *id.*

81. See *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 472 (5th Cir. 2008) (involving large business conducted to market sports apparel from numerous teams).

against superfans is due to “strike suits.”⁸² Strike suits occur when trademark holders send cease-and-desist letters, followed by meritless trademark infringement filings.⁸³ Trademark holders pursue these actions primarily to hinder the ability of others to enter the sports merchandise market.⁸⁴ Generally, these actions are enough to prevent small competitors, such as superfans, from continuing to produce their products due to the risk of enduring costly lawsuits.⁸⁵ Ultimately, it is the consumer who is hurt by strike suits due to fewer options in the marketplace.⁸⁶ Even though strike suits have curtailed litigation against superfans, it is only a matter of time before a brazen superfan ignores these trademark holder’s tactics.⁸⁷

III. PROFESSIONAL SPORTS LEAGUES’ CAUSES OF ACTION AGAINST THE SUPERFAN

While the scope of trademark law has varied over the years, the basic requirements of invoking trademark protection under the Lanham Act have remained the same.⁸⁸ In order to establish trademark infringement, the trademark owner must show three things: (1) the mark must be distinctive, (2) use of the mark must be likely to cause consumer confusion, and (3) use of the mark is not infringing on a functional feature.⁸⁹

A. Mark Distinctiveness

In determining whether the sports team’s mark is distinctive, a court must decide what type of mark the holder possesses.⁹⁰ There

82. See Kenneth L. Port, *Trademark Extortion: The End of Trademark Law*, 65 WASH. & LEE L. REV. 585, 589 (2008) (detailing prevalence of strike suits).

83. See *id.* (noting that if these suits were pursued, they would likely fail because they are frequently based on unmeritorious claims).

84. See *id.* (noting objective of trademark holders is not merely to stop use of mark, but rather to raise costs of market entrance).

85. See Port, *supra* note 82, at 589 (noting trademark holders send thousands of cease-and-desist letters, which are almost never prosecuted). For a further discussion regarding cease-and-desist letters’ power to eliminate superfans from the marketplace, see *infra* notes 182-185 and accompanying text.

86. See Mitten, *supra* note 25, at 928 (noting fewer available consumer choices results in higher retail prices).

87. See *NFL Claims Trademark Infringement*, *supra* note 36 (reporting on New Orleans Saints fans who plan to continue to sell t-shirts bearing team’s insignia even though they have received cease-and-desist letters).

88. For a further discussion concerning the evolution of trademark law, see *supra* notes 33-87 and accompanying text.

89. See Shull, *supra* note 19, at 643 (listing requirements that trademark owners must meet to prove trademark infringement).

90. See *id.* (noting that to determine whether trademark infringement has been committed, courts must first determine distinctiveness of mark).

are four types of marks currently recognized by the courts: generic, arbitrary or fanciful, suggestive, and descriptive.⁹¹

1. *Generic Marks*

Generic marks receive the least protection because they simply denote the particular class of which the product is a member.⁹² Courts always rule that these types of marks lack distinctiveness.⁹³ Once a mark is classified as generic, it does not receive trademark protection.⁹⁴

2. *Descriptive Marks*

Descriptive marks are afforded slightly more protection than generic marks.⁹⁵ Unlike generic marks, descriptive marks describe a feature of the product and acquire trademark protection when the mark achieves secondary meaning.⁹⁶ A mark achieves secondary meaning when, over time, a descriptive term acquires a meaning associated with the product.⁹⁷ Sports teams' colors and slogans used by superfans for profit will likely fall into this category.⁹⁸ For instance, if a consumer who sees a team's colors or slogan automatically identifies the team as the source, the mark has the requisite distinctiveness required for trademark protection.⁹⁹

91. *See id.* at 644 (listing four categories of marks).

92. *See Ashley Furniture Indus., Inc. v. San Giacomo N.A. Ltd.*, 187 F.3d 363, 369 (4th Cir. 1999) ("A generic mark refers to the genus or class of which a particular product is a member and can never be protected.").

93. *See Jeremiah Kline, Comment, Black and Blue: An Examination of Trademark University Color Schemes*, 16 SPORTS LAW. J. 47, 49 (2009) (stating generic marks lack distinctiveness).

94. *See id.* (stating generic marks are never protected).

95. *See Kline, supra* note 93, at 49 (noting in terms of level of protection, descriptive marks are awarded more protection than generic marks).

96. *See Ashley Furniture*, 187 F.3d at 369 ("A descriptive mark describes a characteristic of a product and can only be protected if it has acquired secondary meaning.").

97. *See id.* (noting descriptive marks acquire secondary meaning when they "become distinctive of the maker's goods over time").

98. *See Shull, supra* note 19, at 646 (noting that university logos, color schemes, and other indicia are normally considered to be descriptive marks).

99. *See Kline, supra* note 93, at 53 (stating that "[w]hen a mark triggers an idea in the buyer's mind that the product comes from a particular source based on that mark and that mark alone, the mark satisfies the distinctiveness requirement of secondary meaning").

3. *Suggestive Marks*

Unlike descriptive marks, suggestive marks receive automatic protection under the Lanham Act.¹⁰⁰ In practice, descriptive and suggestive marks are often confused; thus, courts have developed a three-part test to distinguish a suggestive mark from a descriptive mark.¹⁰¹ The test for suggestive marks requires that (1) consumers link the mark to some characteristic of the product, (2) competitors use the term as a trademark, and (3) the proposed use of the mark does not prevent competitors from describing their own goods.¹⁰²

4. *Arbitrary or Fanciful Marks*

While arbitrary and fanciful marks are grouped together by the courts, the two differ in regard to the types of goods they protect.¹⁰³ While a mark is classified as arbitrary when the mark “is well-known in a different context,” fanciful marks relate to items that are “newly invented.”¹⁰⁴ Both arbitrary and fanciful marks also receive automatic trademark protection.¹⁰⁵

B. Likelihood of Confusion

To bring a successful trademark infringement claim against a superfan, the mark holder will also need to show that “the infringed use will likely cause consumer confusion.”¹⁰⁶ Although each circuit applies its own likelihood of confusion test, there are eight factors

100. See *Menashe v. V Secret Catalogue, Inc.*, 409 F. Supp. 2d 412, 423 (S.D.N.Y. 2006) (stating suggestive marks automatically receive trademark protection because these marks are inherently distinct).

101. See *id.* (noting that descriptive marks are not awarded automatic protection as suggestive marks and that finders-of-fact must distinguish between types of marks).

102. See *id.* (laying out three-part test for distinguishing descriptive marks from suggestive marks).

103. See Shull, *supra* note 19, at 644 (grouping arbitrary and fanciful marks into same category).

104. See *Ashley Furniture Indus., Inc. v. San Giacomo N.A. Ltd.*, 187 F.3d 363, 369 (4th Cir. 1999) (“[A] mark qualifies as arbitrary if it is well-known in a different context, and fanciful if it is newly invented.”); see also Shull, *supra* note 18, at 644 (providing “Apple” is example of arbitrary marks because “it applies a word that has no particular relation to computers” while “Kodak” exemplifies fanciful marks because “the term was created for the product”).

105. See *Ashley Furniture*, 187 F.3d at 369 (stating arbitrary and fanciful marks receive automatic protection because they are “deemed inherently distinctive”).

106. See Shull, *supra* note 19, at 643 (stating that trademark owner’s second requirement in proving infringement is showing that “infringing use will likely cause consumer confusion”).

that are prevalent in every analysis.¹⁰⁷ These factors include: (1) strength of the mark, (2) proximity of the goods, (3) similarity of the marks, (4) evidence of actual confusion, (5) marketing channels used, (6) types of goods and the degree of care likely to be exercised by the purchaser, (7) defendant's intent in selecting the mark, and (8) likelihood of expansion of the product lines.¹⁰⁸

In the context of superfans, the team will need to show that consumers believe that the use of their team's mark on the superfan's merchandise indicates that the team is affiliated with or sponsored the merchandise.¹⁰⁹ One factor that is likely to weigh against the superfan is the similarity-of-the-marks.¹¹⁰ Usually when a superfan markets products affiliated with a team, the mark displayed is a replica of the team's logo.¹¹¹ Additionally, the marketing channels used by superfans can support a finding of trademark infringement.¹¹² When mark holders and superfans reach consumers through the same markets, the likelihood of confusion about the true source of the goods increases.¹¹³

Another factor that many courts emphasize in the likelihood of confusion analysis is the intent of the defendant.¹¹⁴ In the context of superfan litigation, defendants have relied on the affirmative defense of their use of a disclaimer to show they did not intend to deceive consumers.¹¹⁵ However, a recent trend in several circuits

107. See Franklin, *supra* note 17, at 1007 (noting that circuits generally incorporate same eight foundational factors in determining likelihood of confusion).

108. See Shull, *supra* note 18, at 647 (listing eight factors for likelihood of confusion).

109. See Univ. of Ga. Athletic Ass'n v. Laite, 756 F.2d 1535, 1546 (11th Cir. 1985) (stating confusion "need not relate to the origin of the challenged product. Rather, 'confusion' may relate to the public's knowledge that the trademark . . . originates with the plaintiff.").

110. See Franklin, *supra* note 17, at 1008 (noting "similarity-of-the-marks factor necessarily supports an inference of likely confusion in the fan apparel context").

111. See *NFL Claims Trademark Infringement*, *supra* note 36 (stating that Saints were only trying to stop use of team's trademark fleur-de-lis logo when used in combination with team's other trademarks).

112. See Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co., 550 F.3d 465, 481 (5th Cir. 2008) ("Smack concedes that the fourth factor of the analysis [marketing channels used] . . . weighs in favor of a likelihood of confusion because the Universities' licensed products are often sold wholesale to the same retailers who purchase Smack's products.").

113. See Gardner, *supra* note 21, at 722-23 (stating evidence that plaintiff and defendant "reach[ed] consumers through the same or comparable markets" increases likelihood of confusion).

114. See Franklin, *supra* note 17, at 1008 (stating that in fan apparel cases, courts concentrate on intent of defendant).

115. See *id.* (noting that use of disclaimers is included in defendant's intent).

has rendered the use of disclaimers insufficient.¹¹⁶ Currently, there is a circuit split in regard to the requisite intent.¹¹⁷ While courts have traditionally required that the defendant intend to confuse consumers, some circuits now look at whether the defendant intended to profit from a team's popularity.¹¹⁸ Courts' interpretation of intent is critical in sports merchandise cases because this factor alone is enough to establish likelihood of confusion.¹¹⁹ Additionally, once it is established that a superfan intentionally replicated a team's protected mark, the burden of proving that confusion is unlikely to occur shifts to the superfan.¹²⁰ In determining the defendant's intent, courts generally rely on circumstantial evidence such as the popularity of the mark and similarities and differences between the defendant's and plaintiff's mark.¹²¹

This new intent analysis effectively broadens the likelihood of confusion element, diluting the consumer focus of the Lanham Act.¹²² When courts focus on the intent of the defendant to capitalize off the team's popularity, the courts are viewing trademark protection as a property right.¹²³ This expansive viewpoint is contrary to the purpose of the Lanham Act because it hinders competition in the sports merchandise market.¹²⁴

116. See, e.g., *Univ. of Ga. v. Laite*, 756 F.2d 1535, 1547 (11th Cir. 1985) (citing *Bos. Prof'l Hockey Ass'n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1013 (5th Cir. 1975)) (determining that "words which indicate it was not authorized by the trademark owner are insufficient" to remedy unauthorized use). For a further discussion of courts' dismissal of disclaimers when evaluating likelihood of confusion, see *infra* notes 153-155 and accompanying text.

117. See Franklin, *supra* note 17, at 1009 (noting circuit split when it comes to interpreting defendant's intent).

118. See *id.* (stating how different circuits have interpreted requisite intent).

119. See *Bd. of Supervisors for La. State Univ. Agric. and Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 481 (5th Cir. 2008) ("[A] defendant's intent to confuse may alone be sufficient to justify an inference that there is a likelihood of confusion.").

120. See Gardner, *supra* note 21, at 724 (stating evidence of intentional similarities between marks shifts burden to defendant to prove confusion is unlikely).

121. See *id.* (noting that it is unlikely defendants will admit to intentionally replicating marks and that courts must consequently rely on circumstantial evidence, and listing types of circumstantial evidence on which courts commonly rely).

122. See Franklin, *supra* note 17, at 989 (indicating that trademark law developed primarily to protect consumers). For a further discussion on the intended consumer-focus of trademark law, see *supra* notes 17-21 and accompanying text.

123. See Franklin, *supra* note 17, at 1009 (noting focusing on intent to capitalize on team's popularity is rooted in *Boston Professional Hockey*, which expanded trademark protection to confer property rights to mark holder).

124. See *id.* at 1010 (noting pro-competition goals of trademark law).

Importantly, actual confusion is not required in finding likelihood of confusion.¹²⁵ However, where actual confusion is present, the likelihood of confusion element will generally be met.¹²⁶ Once a trademark holder establishes the mark obtained secondary meaning, and the use of the mark caused consumer confusion, the mark holder has to prove one more element, the functionality doctrine.¹²⁷

C. Functionality

In order to receive protection under the Lanham Act, mark holders must prove the use of their team's mark does not infringe on a functional feature.¹²⁸ A mark will not be afforded trademark protection when a feature of the product is functional, meaning the feature "is essential to the use or purpose of the article or if it affects the cost or quality of the article."¹²⁹ The functionality doctrine has two underlying purposes: first, to facilitate competition by allowing a product's useful features to be copied, thereby encouraging product advancement, and second, to prohibit an innovator from securing a monopoly over a product's useful features.¹³⁰

Some scholars have argued sports teams' marks are unable to receive trademark protection because the logos are an essential part of fan apparel.¹³¹ This argument emphasizes that there is no substitute for using the team's logo.¹³² Thus, a black t-shirt is not an adequate substitute for one desiring to purchase a navy and white shirt bearing Cowboy insignia.¹³³ In evaluating the functionality of

125. See Gardner, *supra* note 21, at 718 (stating actual confusion is not necessary).

126. See Alderman v. Iditarod Props., 32 P.3d 373, 392 (Alaska 2001) (holding that actual confusion provides strong evidence for finding of likely confusion).

127. See Shull, *supra* note 19, at 643 (listing three requirements needed to prove trademark infringement).

128. See Kline, *supra* note 93, at 54 (stating Lanham Act prohibits registration of marks that are functional).

129. Inwood Labs. Inc. v. Ives Labs., Inc., 456 U.S. 844, 850 n. 10 (1982) (defining "functional" for purposes of Lanham Act).

130. See Shull, *supra* note 19, at 647-48 (stating purposes of functionality doctrine).

131. See Franklin, *supra* note 17, at 1002 (noting scholarly argument that team logos are unable to receive trademark protection).

132. See Wilhelm Pudenz v. Littlefuse, Inc., 177 F.3d 1204, 1207 (11th Cir. 1999) ("[T]he functionality doctrine prevents the trademark law from conflicting with the patent law by eliminating trademark monopolies of potentially unlimited duration on a product's utilitarian features.").

133. See Gerald T. Tschura, *Likelihood of Confusion and Expressive Functionality: A Fresh Look at the Ornamental Use of Institutional Colors, Names and Emblems on Apparel and Other Goods*, 53 WAYNE L. REV. 873, 889 (2007) (noting lack of substitute for purple sweatshirts bearing LSU).

team logos and insignia, these scholars presuppose the purpose of sports merchandise is to convey one's team spirit.¹³⁴ For further support of this argument, scholars point to consumers who have admitted their primary reason for buying their team's merchandise is to convey their allegiance.¹³⁵

Despite these arguments, courts have consistently found the underlying purpose of sports merchandise is not to function as fan apparel, but rather to serve a physical purpose.¹³⁶ In *Texas Tech University v. Spiegelberg*, the Fifth Circuit addressed the functionality of a sports team logo.¹³⁷ In that case, the Fifth Circuit determined that the use of the team's logo on knitted hats did not alter the hat's effectiveness at keeping the head warm, which was the functional feature of the merchandise.¹³⁸ Thus, the court rejected the argument that the team's logo and other identifying indicia were why consumers continued to buy the product.¹³⁹

IV. THE SUPERFAN'S DEFENSES AGAINST TRADEMARK INFRINGEMENT CLAIMS

Superfans have several defenses available against claims that they are "capitalizing" on their teams' success.¹⁴⁰ To prove the majority of these defenses, the superfan will face an uphill battle given courts' current interpretation of trademark protections under the Lanham Act.¹⁴¹

134. *See id.* at 874 ("Perhaps, however, warmth is not the essential purpose of these particular sweaters. Instead, the expression of the wearer's allegiance [to their team] is the essential function.") (alteration in original).

135. *See Univ. of Pittsburgh v. Champion Prods., Inc.*, 566 F. Supp. 711, 716 (W.D. Pa. 1983) (including testimony by witness who stated, "I imagine people purchased it [soft goods with Pittsburgh insignia] because they want to *express some type of affinity* for the institution.") (emphasis added).

136. *See, e.g., Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 487 (5th Cir. 2008) (stating Fifth Circuit "has consistently rejected the concept of aesthetic functionality"). For a further discussion of the court's unwillingness to recognize the functionality of team logos, see *infra* notes 147-149 and accompanying text.

137. *See Tex. Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 520 (N.D. Tex. 2006) (rejecting defendant's argument that use of mark holder's scarlet and black color scheme was protected by functionality doctrine).

138. *See id.* (emphasizing that mere appearance of Texas Tech's logo on licensed goods "does not affect how the product works").

139. *See id.* ("[I]t is unclear how one could argue that the mere adding of the Texas Tech color scheme could be the reason the [product] works").

140. *See Shull, supra* note 19, at 652-56 (listing possible trademark defenses).

141. *See, e.g., Bd. of Supervisors for La. St. Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 480 (5th Cir. 2008) (determining t-shirts that stated "2003 National Champions" constituted infringing use even though shirts did not bear university's name). For a further discussion on the difficulties the superfan

A. Aesthetic Functionality

The first possible defense a superfan can assert arises under the functionality doctrine.¹⁴² Scholars have argued that team logos are exempt from trademark protection given the functional components of fan apparel.¹⁴³ Aesthetic functionality, a subcategory of the functionality doctrine, stands to protect against claims of trademark infringement that replicate certain aesthetically pleasing designs in order to effectively compete in the marketplace.¹⁴⁴

Aesthetic functionality is invoked only when the mark at issue provides a significant benefit which cannot be duplicated.¹⁴⁵ This defense turns on whether the design of the mark is the product's essential feature and is key to the product's commercial success.¹⁴⁶ Much like the traditional idea of functionality, most courts have rejected this argument.¹⁴⁷ In doing so, courts have held that unauthorized uses of a team's mark only disadvantages those unable to use the mark for reputational reasons.¹⁴⁸ Moreover, courts have never upheld reputational-disadvantages as aesthetically functional.¹⁴⁹

faces in defending against a trademark infringement action, see *infra* notes 142-174 and accompanying text.

142. See Franklin, *supra* note 17, at 1000-06 (noting functionality doctrine has sparked much debate in fan apparel trademark infringement cases).

143. See Tschura, *supra* note 133, at 874 (arguing that “[t]he ornamental use of institutional names and insignia on many products, apparel products in particular, is a functional use of the mark, and therefore, cannot be protected in that context”). For a further discussion of the argument that team logos are functional and should not receive trademark protection, see *infra* notes 145-149.

144. See Franklin, *supra* note 17, at 1003 (stating rationale for aesthetic functionality defense “is that competitors must be able to copy certain aesthetically pleasing designs to compete effectively”).

145. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995) (“A design is “functional” for purposes of the rule stated in §16 if the design affords benefits. . . that are important to effective competition by others and that are not practically available through the use of alternative designs.”).

146. See Tschura, *supra* note 133, at 888 (stating functionality requires that aesthetically pleasing design must be essential feature of product).

147. See Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co., 550 F.3d 465, 487 (5th Cir. 2008) (“Our circuit has consistently rejected the concept of aesthetic functionality.”).

148. See *id.* (“[A]ny demand for Smack’s t-shirts is inextricably tied to the Universities’ trademarks themselves. . . . Smack’s alleged competitive disadvantage in the ability to sell game day apparel relates solely to an inability to take advantage of the Universities’ reputation.”).

149. See Tschura, *supra* note 133, at 1003 (noting general rule is that “the exclusive use of the design must put competitors at a ‘significant non-reputation-related disadvantage’”).

B. Disclaimers

Superfans who attempt to sell products bearing their team's colors or slogans may be able to avoid trademark infringement claims by attaching disclaimers to their products.¹⁵⁰ Some scholars have emphasized that when individuals selling team products attach disclaimers, the likelihood of consumer confusion is eliminated.¹⁵¹ These scholars argue disclaimers alert consumers that they are not the actual source of the goods.¹⁵²

Despite the perceived elimination of consumer confusion, most courts will not take into account disclaimers when evaluating the likelihood of consumer confusion.¹⁵³ These courts emphasize that disclaimers are insufficient in eliminating consumer confusion when one purposefully copies the protected mark without permission.¹⁵⁴ In finding the use of disclaimers as inadequate, courts once again illustrate the move toward giving trademark holders a property right in their mark, by focusing on the defendant's intent.¹⁵⁵

C. Expressive Use

The superfan also has the option of defending against a claim of trademark infringement by asserting the doctrine of expressive use.¹⁵⁶ The expressive use defense serves to protect trademark usage that conveys a particular message, as opposed to reproduction

150. See Franklin, *supra* note 17, at 1011 (noting that avoiding trademark infringement by using disclaimers on products depends on facts of specific situation).

151. See Tschura, *supra* note 133, at 886 (stating that placing disclaimers on sports merchandise eliminates likelihood of confusion, allowing consumers to make informed decisions).

152. See *id.* ("If it mattered at all to purchasers, they could simply look to the presence or absence of the conspicuous 'officially licensed' label.")

153. See *Univ. of Ga. v. Laite*, 756 F.2d 1535, 1547 (11th Cir. 1985) (dismissing argument that beer cans bearing disclaimer stating school was not associated with product eliminated likelihood of confusion).

154. See *id.* (citing *Bos. Prof'l Hockey Ass'n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1013 (5th Cir. 1975) ("The exact duplication of the symbol and the sale as the team's emblem satisfying the confusion requirement of the law, words which indicate it was not authorized by the trademark owner are insufficient to remedy the illegal confusion.")).

155. See Franklin, *supra* note 17, at 1011 (noting courts who find disclaimers insufficient base their holdings on reasoning articulated in *Boston Professional Hockey*, which expanded trademark protection conveying property rights to mark owners).

156. See William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 56-59 (2008) (showing increasing intersection of expressive use with trademark law).

of the protected mark.¹⁵⁷ Thus, the defense will only be applicable to a limited number of cases against the superfan.¹⁵⁸ Expressive use can only be invoked when the trademark is altered or when additional words or phrases accompany the registered mark. Accordingly, merchandise containing only the official name of the team is not covered under expressive use.¹⁵⁹ In addition, case law has shown expressive use will not provide an adequate defense for the superfan when the merchandise references championship games the teams have participated in.¹⁶⁰

D. Laches and Acquiescence

Even if the aforementioned defenses fail, the superfan can invoke the equitable doctrine of laches.¹⁶¹ Laches is recognized when “a long delay in taking action causes undue prejudice to a defendant.”¹⁶² Specifically, laches turns on whether 1) the mark owner knew of the infringing use; 2) the delayed response of the owner was unreasonable; and 3) the user of the registered mark was prejudiced by the owner’s delay in asserting their right.¹⁶³

Similar to laches is the defense of acquiescence.¹⁶⁴ In addition to the elements of laches, acquiescence requires that the mark

157. See Shull, *supra* note 19, at 54 (stating “[e]xpressive’ uses of trademarks convey articulable message rather than, or in addition to, traditional functions of course identification”).

158. See McGeveran, *supra* note 156, at 55 (noting by way of example that Yankees fans who put Yankee logo on hats are not adding “expressive content or context”). When a superfan simply reproduces the trademark, the superfan is not adding expressive content and therefore is unable to assert this affirmative defense. *Id.*

159. See *id.* (stating use of registered marks only qualify as expressive use “if the trademark[s] were altered to add additional articulable expression”).

160. See Bd. of Supervisors for La. St. Univ. Agric. & Mech. Coll. v. Smack Apparel Co., 550 F.3d 465, 480 (5th Cir. 2008) (finding infringing use on t-shirts which stated “2003 National Champions”). This shirt was an infringing use even though it did not bear the mark holder’s name (LSU). *Id.*

161. See David E. Armendariz, Note, *Picking on the Little Guy? Asserting Trademark Rights Against Fans, Emulators, and Enthusiasts?*, 90 TEX. L. REV. 1259, 1269 (2012) (expressing that trademark owners face equitable doctrine of laches when they fail to timely enforce their rights against encroaching party).

162. See *id.* (noting “[w]hile the approach of courts is not always precise or consistent regarding the impact of a failure to sue infringers, in general, laches is an equitable defense that may be recognized when a long delay in taking action causes undue prejudice to a defendant”).

163. See *Brittingham v. Jenkins*, 914 F.2d 447, 456 (4th Cir. 1990) (quoting *Tobacco Workers Int’l Union, Local 317 v. Lorillard Corp.*, 448 F.2d 949, 958 (4th Cir. 1971)) (listing elements of laches).

164. See Armendariz, *supra* note 161, at 1269 (noting similarity between defenses of laches and acquiescence).

holder give consent to the party using the protected mark.¹⁶⁵ Consent is generally explicit, but in some cases consent can be inferred from silence.¹⁶⁶ Silence might constitute consent starting when the trademark holder has actual or constructive knowledge of the defendant's use of the mark and lasting until the trademark holder clearly conveys to the defendant that their use of the mark is not permitted.¹⁶⁷

The ability of the superfan to succeed under the defenses of laches and acquiescence will largely depend on the superfan's notoriety.¹⁶⁸ Specifically, the defenses turn on whether the mark holder knew or consented to the use of their mark.¹⁶⁹ Thus, when a superfan is receiving media coverage it will be easier for the fan to prove the mark holder knew or consented to the alleged "infringing use."¹⁷⁰

The biggest hurdle for superfans in proving laches and acquiescence is asserting they were harmed due to the delay in the mark holder bringing a claim.¹⁷¹ While it will be hard for a typical fan to show he or she was harmed by a delay, superfans actively profiting from merchandise associated with the mark holder's team will have less of an issue proving they were unduly prejudiced by the delay.¹⁷²

165. *See id.* (stating "active consent" is what differentiates acquiescence).

166. *See* Molly Buck Richard, Lanham Act—Infringement—Defenses—Acquiescence, 3 TEX. PRAC. GUIDE BUS. TRANS. § 16:210 (2012) (stating ways permission to use mark can be given).

167. *See id.* (showing period during which silence might constitute permission).

168. *See* Miller v. Glenn Miller Prods., 454 F.3d 975, 980 (9th Cir. Cal. 2006) (citing Jarrow Formulas, Inc. v. Nutrition Now, Inc., 304 F.3d 829, 838 (9th Cir. 2000) (indicating that when court examines laches it looks to "when a plaintiff 'knew or should have known' of the infringing activity to determine whether the plaintiff unreasonably delayed in bringing suit.")).

169. *See* Brittingham v. Jenkins, 914 F.2d 447, 456 (4th Cir. 1990) (holding laches requires mark holder knew of infringing use) (quoting Tobacco Workers Int'l Union, Local 317 v. Lorillard Corp., 448 F.2d 949, 958 (4th Cir. 1971)); *see also* Armendariz, *supra* note 161, at 1269 (stating acquiescence requires mark holder consented to use).

170. *See* Avanzado, *supra* note 5 (noting Clippers have made public statements stating that Clipper Darrell has been using Clipper name "over a long period of time").

171. *See* Armendariz, *supra* note 161, at 1271 (acknowledging that fans are typically not businesses operating to make profits; thus, it is unlikely fans will be able to show they incurred substantial expenses).

172. *See id.* (noting fans "are typically not businesses that seek to grow and expand as a normal business would" – however, those fans who do profit off their team's merchandise begin to resemble typical businesses).

V. BALANCING FANS' LOVE FOR THEIR TEAM AND THE TEAM'S INTEREST IN ENFORCING ITS TRADEMARK

When deciding whether to bring trademark infringement actions against superfans, the teams must first weigh the costs associated with enforcing their ownership rights against the benefits they will reap through such enforcement.¹⁷³ While it may seem that sports organizations that bring trademark infringement actions are “picking on the little guys,” these teams have legitimate reasons for asserting the right to their mark.¹⁷⁴

A. Reasons a Professional Sports Team Has for Protecting Their Mark

1. *Profit-Motivation*

One reason trademark holders actively assert their rights against superfans is their desire to reap additional profits.¹⁷⁵ When a superfan markets his or her own products referencing a team, the superfan diverts profits from the team or mark holder.¹⁷⁶ In order to make more money and allow others to use their mark, teams frequently enter into licensing agreements with other people or businesses.¹⁷⁷ In 2009, “retail sales of licensed sports merchandise” totaled \$12.5 billion just in the United States.¹⁷⁸ Teams eagerly enter into licensing agreements with parties who want to use the team’s mark because these agreements allow the team to recapture a share of the profits.¹⁷⁹

173. For a further discussion of the costs and benefits to mark holders in asserting their rights, see *infra* notes 174-211 and accompanying text.

174. See Armendariz, *supra* note 161, at 1267 (reflecting that trademark owners are partly driven to protect against infringement from fans because of fear of losing protection of their mark).

175. See *id.* at 1264 (stating trademark holders assert their rights against those using their mark in order to make more money).

176. See Frank, *supra* note 24, at 353 (describing free-riding, where trademark owners have argued those who use protected marks without paying licensing fees to mark owners are getting free rides).

177. See Joseph P. Liu, *Sports Merchandising, Publicity Rights, and the Missing Role of the Sports Fan*, 52 B.C. L. REV. 493, 495 (2011) (noting professional sports teams are now deriving “increasingly large amounts of their profits from licensing of trademarks, trade dress, and rights of publicity”).

178. See *Licensed Sports Merchandise is \$12.5 Billion Market In U.S./Canada; Major Leagues Account For 65%, NASCAR For Another 8%*, EPM COMMUNICATIONS, INC. (July 12, 2010), http://www.epmcom.com/public/Licensed_Sports_Merchandise_Is_125_Billion_Market_In_USCanada_Major_Leagues_Account_For_65_NASCAR_For_Another_8.cfm (showing amount of sales generated from sports licensing agreements in 2009).

179. See Michelle L. Evans, *Establishing Liability for Breach of Trademark License*, 110 AM. JUR. 3D *Proof of Facts* 1 (2012) (stating that “[t]he essence of a trademark

As professional sports teams have increasingly entered into licensing agreements, teams have subsequently become more aggressive in enforcing their rights against unlicensed uses of their marks.¹⁸⁰ In the coming years, it is likely the superfan will bear the brunt of this increased enforcement.¹⁸¹ While superfans are allowed to enter into licensing agreements with a sports team, they are unlikely to know they must do so before selling items associated with the team.¹⁸² Compounding this lack of knowledge, teams have shown an increased willingness to seek legal actions against their superfans.¹⁸³ Facing a David-and-Goliath-type battle, superfans are likely to cease production of the merchandise they are selling upon receiving word from the team that they are illegally using the team's mark.¹⁸⁴ Thus, while the team has a legitimate reason in reaping the profits from their registered mark, it is the superfans, who lack knowledge concerning licensing agreements, who will face legal action from the mark holders.¹⁸⁵

2. *Fear of Dilution by Tarnishment or Blurring*

Another reason trademark holders assert for protecting their rights is fear of dilution.¹⁸⁶ Dilution can occur through both blur-

license agreement is the agreement by the trademark owner to allow a third party to use its registered trademark in exchange for the third party's agreement to pay royalties.”).

180. See generally *C.B.G. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 820 (8th Cir. 2007) (ruling on lawsuit dealing with unlicensed use of names and information about major league baseball players).

181. For a further discussion of the increased trademark enforcement against superfans, see *supra* notes 51-80 and accompanying text.

182. See Christopher J. Belter & Joseph M. Hanna, *Turning a Playmaker Into a MoneyMaker*, 51 DRI FOR DEF. 39 (2009) (indicating that oftentimes multiple licenses are required just to produce one item).

183. See, e.g., *Baylor Compliance*, BAYLOR BEARS, <http://www.baylorbears.com/compliance/cease.html> (last visited Oct. 8, 2012) (asking superfans to cease and desist in relation to their football program and Robert Griffin III); see also Andrew Sharp, *Clipper Darrell, Our Latest Reminder That Donald Sterling Is Horrible*, SB NATION (Mar. 1, 2012), <http://www.sbnation.com/nba/2012/3/1/2834889/clipper-darrell-donald-sterling-embarrassment> (stating Clippers have asked Clipper Darrell to drop Clipper from his name).

184. See Port, *supra* note 82, at 589 (announcing that trademark holders send thousands of cease-and-desist letters, which are almost never prosecuted).

185. See Belter & Hanna, *supra* note 182, at 39 (stating complexities of entering into licensing agreements).

186. See Armendariz, *supra* note 161, at 1266 (noting that fear of dilution prompts trademark owners to police their marks).

ring and tarnishment of a team's mark.¹⁸⁷ Dilution by blurring occurs when the superfan's mark is associated with the team's protected mark, thereby diminishing the distinctiveness of the protected mark.¹⁸⁸ In evaluating whether the protected mark is sufficiently recognizable, a court considers a number of factors, including extent of publicity and volume of sales of goods associated with the mark.¹⁸⁹ In the professional sports context, the mark is likely to be considered sufficiently recognizable.¹⁹⁰ Here, even though there are numerous different teams in each professional sports league, the teams receive national attention with a fan base that is not confined to their particular team's geographic region.¹⁹¹

Alternatively, dilution by tarnishment occurs when the protected mark is associated with the superfan's mark, harming the protected mark's reputation.¹⁹² This doctrine is most commonly invoked when one uses a protected mark in conjunction with offensive language or violence.¹⁹³ Sports teams argue that when offensive phrases are used in connection with their mark, their reputation is damaged, resulting in a loss of profits amongst other

187. See Frank, *supra* note 24, at 365-67 (discussing protective doctrines of dilution by blurring and dilution by tarnishment that are available to trademark holders).

188. See 15 U.S.C. § 1125(c)(2)(B) (2006) ("'Dilution by blurring' is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.").

189. See *id.* ("In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following: (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties. (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark. (iii) The extent of actual recognition of the mark. (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.").

190. See Hector Saldaña, *Tall Cowboy Tales*, MY SAN ANTONIO (Sept. 28, 2012), <http://www.mysanantonio.com/entertainment/books/article/Tall-Cowboy-tales-3899864.php> (describing Dallas Cowboy's star logo as "second only in recognizability to that of Coca-Cola.").

191. See DJ Gallo, *Steeler Nation Has Homes Around the Globe*, ESPN (Jan. 29, 2009), http://sports.espn.go.com/espn/page2/story?page=gallo/090129_steelers&sportCat=nfl (discussing 1,500 Pittsburgh Steelers sports bars located "across the nation and around the world.").

192. 15 U.S.C. § 1125(c)(2)(C) ("'Dilution by tarnishment' is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.").

193. See *Univ. of Kan. v. Sinks*, 644 F. Supp. 2d 1287, 1300 (D. Kan. 2008) (stating university mark holder brought claims of trademark infringement against manufacturer who produced t-shirts which bore phrases such as "Kansas Drinking Team" and "Kansas Co-Ed Naked Beer Pong").

things.¹⁹⁴ However, in most cases, both dilution by blurring and dilution by tarnishment are unlikely to pose a serious threat to professional sports teams.¹⁹⁵ The typical superfan produces only a small amount of goods, which will be unlikely to reduce the distinctiveness of the mark or harm the sports team's reputation.¹⁹⁶ Nevertheless, where superfans have attained significant notoriety, dilution by blurring or by tarnishment will become an issue for mark holders.¹⁹⁷

3. *Maintaining Rights to Trademark Protection*

Finally, trademark holders have an incentive to protect their rights because failure to do so risks the loss of trademark protection.¹⁹⁸ In order to maintain trademark protection, teams must police the uses of their mark.¹⁹⁹ When enforcing their trademark rights, teams frequently claim they are acting out of fear of losing protection, making these actions appear reasonable.²⁰⁰ However,

194. See Saltzman, *supra* note 21, at 1661 (discussing Bud Light "Fan Can" marketing scheme where Bud Light featured color schemes of certain universities, causing these universities to claim their trademarks were being violated). There, the universities were concerned the cans improperly associated their marks with underage drinking. See *id.* After over twenty-five universities sent cease-and-desist letters the "Fan Can" marketing scheme was pulled. See *id.*

195. See Frank, *supra* note 24, at 366 (arguing use of team's logos on sports merchandise will not result in blurring because sports logos do not indicate quality of merchandise).

196. Compare *Elegant Designs by Jewels*, ETSY, <http://www.etsy.com/shop/elegancebyjewels#> (last visited Feb. 4, 2013) (listing fan's four sports bracelets for sale), with *Michael Caruso and Co., Inc. v. Estafan Enters., Inc.*, 994 F. Supp. 1454, 1461 (S.D. Fla. 1998) (stating extensive third-party use of "bongo," which was mark's name, had undermined mark's inherent distinctiveness). In *Michael Caruso*, "bongo" or "bongos" had been incorporated into seventy-five businesses. See *id.* at 1462.

197. See Sharp, *supra* note 183 (referring to Clipper Darrell as "probably the most famous fan in the NBA"); see also *The Case of Clipper Darrell*, RULING SPORTS (Mar. 2, 2012), <http://rulingsports.com/2012/03/02/the-case-of-clipper-darrell/> (speculating Clipper's decision to ask Darrell to remove "Clipper" from his name most likely stems from their desire to prevent dilution of their trademark).

198. See Armendariz, *supra* note 161, at 1267 (describing trademark owners' duty to police use of mark or risk losing its protection).

199. See *Nitro Leisure Prods., L.L.C. v. Acushnet Co.*, 341 F.3d 1356, 1367 (Fed. Cir. 2003) (Newman, J., dissenting) ("Trademark law requires that the trademark owner police the quality of the goods to which the mark is applied, on pain of losing the mark entirely.").

200. See Mark Murphy, *Wooden Bat Leagues Faces Splintering Relationship: MLB Licensing Issue Causes Dilemma for Cape Cod Teams*, BOS. HERALD, May 31, 2009, at b14, available at http://bostonherald.com/sports/baseball/other_mlb/view/2009_05_31_Wooden_bat_league_faces_splintering_relationship_MLB_licensing_issue_causes_dilemma_for_Cape_Cod_teams (stating MLB asked Little League to discontinue use of mark for fear of losing their trademark rights).

in regards to the superfan, these concerns are not as pressing.²⁰¹ Teams' fears of losing their marks stem from the superfan's ability to invoke the defense of laches and acquiescence.²⁰² However, the effect of these defenses is limited because injunctive relief is not barred when the likelihood of confusion is greater than the effect of a delay.²⁰³ In other words, where use of a team's mark by superfans creates significant confusion as to the actual source of the goods, teams will be protected against the equitable defenses of the superfan. Thus, teams need not worry about over-policing their rights.²⁰⁴

B. Costs Associated With Enforcing The Team's Mark

On the other hand, trademark policing is expensive for trademark holders.²⁰⁵ In the superfan context, mark holders will incur significant costs if they opt to pursue legal action against every superfan that profits from selling goods associated with their sports team.²⁰⁶ When sports teams opt to pursue legal action against their superfans, mark holders will incur the transactional costs of litigation, sending cease-and-desist letters, and monitoring the use of their mark.²⁰⁷

Additionally, the most significant, and largely unquantifiable, cost the mark holder will bear is public backlash.²⁰⁸ When a team seeks legal action against one of its own fans, the public may view

201. See Armendariz, *supra* note 161, at 1268-70 (noting defenses commonly invoked by superfans when trademark owners sleep on their rights).

202. For a further discussion of the defenses of laches and acquiescence, see *supra* notes 161-170 and accompanying text.

203. See Armendariz, *supra* note 161, at 1270 (suggesting that laches and acquiescence will not bar injunctive relief "if the likelihood of confusion is great enough to outweigh the effect of the delay.").

204. See *id.* at 1270 (stating trademark rights are not just property rights; thus, even when faced with equitable defenses of laches and acquiescence, injunctions may still be granted in favor of consumer's interests).

205. See Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2123 (2004) (outlining two most prevalent costs in enforcing one's mark: administrative costs incurred in litigation and error costs incurred by erroneous outcomes in litigation).

206. See Armendariz, *supra* note 161, at 1276 (stating that in addition to typical costs faced by trademark owners protecting their mark, actions taken against superfans also risk loss of goodwill and public backlash).

207. See *id.* at 1276 (listing transactional costs of policing one's registered mark); see also Port, *supra* note 82, at 589 (describing prevalence of cease-and-desist letters and filings required to pursue trademark infringement claims).

208. See, e.g., Avanzado, *supra* note 5 (reporting on Clippers players' support for superfan Darrell). For a further discussion of the public backlash against the Clippers' termination of its relationship with Darrell, see *supra* note 11 and accompanying text.

the team as “money-hungry” and only out for themselves.²⁰⁹ This negative backlash can potentially lead to decreased sales for the team.²¹⁰ Sports teams derive a significant amount of revenue from ticket sales and other team merchandise; thus, teams need fan support to succeed financially.²¹¹

C. Fans’ Interest in Being Able To Use Their Team’s Mark

Superfans’ primary interest in using their team’s mark is to express their love for their team.²¹² Superfans frequently buy tickets to games and purchase various other products associated with their team.²¹³ The typical superfan spends more money accumulating items associated with his or her team than he or she will receive in selling goods bearing the team’s mark.²¹⁴ Additionally, players and coaches alike frequently attribute their team’s success to their fans’ enthusiasm.²¹⁵ Thus, the relationship between the superfan and the professional sports team is not one-sided; rather, it is a symbiotic relationship.²¹⁶ Accordingly, because the team/mark holder attributes some of its success to the superfan, it is appropriate to

209. See *Can LA Clippers Use Trademark Law To Stop Clipper Darrell*, MILORD & ASSOCIATES (Feb. 29, 2012) <http://www.iptrademarkattorney.com/2012/02/los-angeles-clippers-basketball-clipper-darrel-bailey-fan-estoppel-laches.html> (advising Clippers to license Clipper Darrell in order to avoid risk of alienating their fans).

210. See Wayne DeSarbo, *Avid Sports Fans’ Passion for the Team Often Translates Into Revenue*, PENN STATE SMEAL COLL. OF BUS., <http://research.smeal.psu.edu/news/avid-sports-fans2019-passion-for-the-team-often-translates-into-revenue> (last visited Oct. 7, 2012) (advocating that revenue generated in sports industry is primarily attributed to fans).

211. See Glen Hodgson & Mario Lefebvre, *Why Pro Sports Franchises Succeed . . . and Fail*, THE CONFERENCE BOARD OF CANADA (Sept. 2011), <http://www.conferenceboard.ca/reports/briefings/bigleagues/briefing-8.aspx> (listing lack of fan support as one of main reasons why some professional sports franchises have failed).

212. See Jeff Pearlman, *Sports Fans Are Passionate, But Many Need a Dose of Perspective*, SI.COM (Aug. 6, 2010), http://sportsillustrated.cnn.com/2010/writers/jeff_pearlman/08/06/angry.fans/index.html (presenting passion and love that sports fans have for their favorite teams).

213. See *2011 NFL Football Attendance*, ESPN, http://espn.go.com/nfl/attendance/_/year/2011 (last visited Oct. 20, 2012) (reporting on average 78,685 fans attended Dallas Cowboys game during 2011 season).

214. See Jesse Dorsey, *Clipper Darrell and the 11 Biggest Super-Fans in the NBA*, BLEACHER REPORT, Sept. 8, 2012, <http://bleacherreport.com/articles/1326769-clipper-darrell-and-the-11-biggest-super-fans-in-the-nba/page/8> (noting superfan Nav Bhatia has attended over 500 games and buys thousands of seats to his team’s games every year).

215. See *Yak Attributes Success To Hard Work, Fans’ Support*, COMPLETE SPORTS (Aug. 25, 2012), <http://completesportsnigeria.com/news/2012/08/yak-attributes-success-to-hard-work-fans-support> (reporting that professional soccer player attributed his success to training as well as his fans’ support).

216. See *id.* (noting contributions of superfan).

allow the superfan leeway to produce his or her own “team” products.²¹⁷

D. Possible Solutions

Considering the possible liability professional sports teams face, superfans should be limited in their ability to profit from team merchandise sales.²¹⁸ While it is not easy to draw a bright line between acceptable superfan profits and impermissible uses of a protected mark, a standard is needed to guide superfans’ expressions of enthusiasm for their teams.²¹⁹

In maintaining a suitable balance between the interests of teams and superfans, courts should return to the underlying purpose of trademark law: consumer protection.²²⁰ Primarily, this will require courts to narrow the likelihood of confusion standard.²²¹ Once courts shift their focus from protecting the property rights of mark holders, disclaimers will adequately address consumer confusion.²²² Additionally, when superfans use their team’s mark, they should be required to attach a disclaimer to remove any consumer confusion in the marketplace.²²³ Moreover, when analyzing the likelihood of confusion in regards to a team’s color schemes, courts should concisely define “other-identifying-indicia.”²²⁴ Without a recognized meaning regarding this standard, teams are effectively granted a monopoly over the use of their color schemes, and

217. For a further discussion on the extent of leeway superfans should be afforded, see *infra* notes 218-238 and accompanying text.

218. For a further discussion of the adverse consequences a sports team faces upon failure to protect their rights, see *supra* notes 175-204 and accompanying text.

219. See *University of Kan. v. Sinks*, 644 F. Supp. 2d 1287, 1300 (D. Kan. 2008) (holding some of shirts at issue constituted trademark infringement while other shirts were not substantially similar to protected mark falling outside of trademark protection). The jury found that while T-shirts bearing the phrase “Kansas Drinking Team” were infringing, T-shirts which stated “Kansas Co-ed Naked Beer Pong” did not invoke similar protection. See *id.*

220. See Mitten, *supra* note 25, at 905 (stating traditional rationale for trademark law was consumer protection).

221. See Franklin, *supra* note 17, at 1009 (noting expansion of likelihood of confusion has shifted focus onto protecting property rights of trademark holders).

222. See Tschura, *supra* note 133, at 886 (expressing how disclaimers help to eliminate consumer confusion).

223. For a further discussion of how disclaimers eliminate confusion, see *supra* notes 150-152 and accompanying text.

224. See Saltzman, *supra* note 21, at 1649 (explaining lack of boundaries in defining what constitutes “color-plus-other-identifying-indicia.”).

superfans are left susceptible to unknowingly committing trademark infringement.²²⁵

In evaluating a mark's functionality, courts should recognize that for most consumers, sports merchandise functions to convey their allegiance to their team.²²⁶ When a mark is serving this function, the mark is not entitled to trademark protection.²²⁷ In order to support the idea that sports apparel functions to convey a fan's love for a team, courts could rely on survey evidence collected from those who have purchased sports merchandise.²²⁸

From a policy perspective, allowing superfans to make and market their own versions of their team's gear furthers the competitive aims of the functionality doctrine.²²⁹ When multiple producers, including fans, are able to present consumers with a variety of choices of a particular product, consumers are able to decide on the quality of product they wish to purchase.²³⁰ These pro-competitive aims allow the consumer to choose the quality of goods that they wish to purchase at a desirable price.²³¹ Consumers who can purchase a product at a lower price and who are presented with a wide array of products are more apt to purchase their team's merchandise.²³² An increase in the purchasing of team apparel, even if a portion of the merchandise is being purchased from superfans,

225. For a further discussion of how the lack of defining "other-identifying-indicia" hinders a superfan's ability to incorporate their team's color scheme, see *supra* notes 78-80 and accompanying text.

226. See *Univ. of Pittsburgh v. Champion Prods., Inc.*, 566 F. Supp. 711, 716 (W.D. Pa. 1983) (detailing testimony of witness who admitted fans are propelled to buy sports merchandise due to allegiance to one's team).

227. See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n. 10 (1982) (finding trademark protection cannot be granted when feature of product "is essential to the use or purpose of the article or if it affects the cost or quality of the article.").

228. See *Nat'l Football League Prop. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 657 (W.D. Wash. 1982) (finding through use of survey evidence that around half of consumers thought that NFL or individual team authorization was required for replicas).

229. See *Shull*, *supra* note 19, at 648 (stating functionality doctrine serves to facilitate competition and also prohibits people from gaining monopoly power over product's useful features).

230. See Peter E. Mims, *Promotional Goods and the Functionality Doctrine: An Economic Model of Trademarks*, 63 TEX. L. REV. 639, 665 (1984) (discussing that when trademark owners are allowed to monopolize products bearing their mark, costs of products increase leaving consumers without variety of choices).

231. See *Mitten*, *supra* note 25, at 928 (indicating when professional sports teams exercise exclusive control over team's mark, consumers are presented with fewer choices at higher retail prices).

232. See *Price and Competition in Food Markets*, USC MARHSALL, http://www.consumerpsychologist.com/food_Price_and_Competition.html (last visited Oct. 10, 2012) (concluding consumers will buy more goods when price is lower).

will nevertheless benefit the team/mark holder.²³³ Availability of team merchandise allows the community to feel a stronger connection to its team, spurring additional consumption.²³⁴

Finally, a regulation system needs to be created to ensure that superfans are able to enter the sports apparel market.²³⁵ This system would monitor and track cease-and-desist letters sent by trademark holders.²³⁶ It would also prevent teams from sending cease-and-desist letters to any superfan who used or made reference to their mark, regardless of the likelihood of confusion.²³⁷ For instance, upon receiving a cease-and-desist letter, the superfan would have the option to forward this letter, along with the merchandise at issue, to an oversight organization. While this system would initially be costly, over time the need for a regulatory system would subside. This system would deter teams from sending frivolous letters and simultaneously educate superfans about what uses constitutes infringement.²³⁸

VI. CONCLUSION

Over the years trademark protection under the Lanham Act has expanded, affording trademark holders more protection. It is consumers who will ultimately pay the price of this increased expansion, which works towards granting mark holders a monopoly over the sports merchandise market. Monopoly power in the hands of professional sports teams will drive the costs of sports merchandise up, and leave consumers with a lack of choices among products. Even though sports teams have a right to protect their mark, they should not unreasonably exercise this right against superfans who receive only a small profit from their devotion and love for their team.²³⁹ Trademark holders who bring legal action against their superfans not only stand to lose the costs associated with litigation,

233. See Tschura, *supra* note 133, at 874 (emphasizing underlying importance of team apparel by stating that “the expression of the wearer’s allegiance [to the team] is the essential function [of sports apparel].”).

234. See *id.* (reporting that effects that team merchandise in general has in conveying love for one’s team).

235. See *id.* (noting objective of strike suits is to raise cost of market entrance).

236. See Port, *supra* note 82, at 589 (discussing how trademark holders send mass amounts of cease-and-desist letters so frequently they have “sample” letters).

237. See *id.* (noting that if most of these letters and claims were pursued, they would likely fail because they are frequently based on unmeritorious claims).

238. See Armendariz, *supra* note 161, at 1276 (expressing costs associated with sending cease-and-desist letters and other legal filings).

239. See *CD Apparel*, THE OFFICIAL SITE OF CLIPPER DARRELL, <http://clipperdarrell.com/cdapparel/> (last visited Oct. 28, 2012) (displaying items for sale ranging from one to thirteen dollars).

but more importantly, the support of those who relentlessly devote their time and money to their favorite team.²⁴⁰

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240. For a further discussion of public backlash as a result of teams pursuing legal action against their superfans, see *supra* note 11 and accompanying text.

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