OCTOBER 2018

DEVOTED TO LEADERS IN THE INTELLECTUAL PROPERTY AND ENTERTAINMENT COMMUNITY

VOLUME 38 • NUMBER 9

THE Licensing Journal

Edited by Gregory J. Battersby and Charles W. Grimes

Wolters Kluwer

Right of Publicity

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In March of 2018, tennis great Roger Federer ended his twenty-one-year relationship with Nike, and in June 2018, entered into a $300 million deal with Uniqlo, a Japanese clothing company. Although Nike no longer has a clothing contract with Federer, Nike still owns the trademark registration in the iconic stylized RF logo in various registries across the world in classes of use covering clothing and footwear. *See* U.S. Trademark Reg. No. 3,838,371. During a press conference at Wimbledon, Federer suggested that he would one day gain the rights to the RF mark, stating:

> The RF logo is with Nike at the moment, but it will come to me at some point. I hope rather sooner than later, that Nike can be nice and helpful in the process to bring it over to me. It's also something that was very important for me, for the fans really. Look, it's the process. But the good news is that it will come to me at one point. They are my initials. They are mine. The good thing is it's not theirs forever. In a short period of time, it will come to me.

Roger Federer, Press Conference (July 2, 2018), *http://www.wimbledon.com/en_GB/news/articles/2018-07-02/2018-07-02_roger_federer_first_round.html*.

Federer's Uncertain Hope in Obtaining the RF Logo from Nike

From a legal perspective, it is not clear why Federer is so optimistic about recovering the RF trademark. Perhaps some provision of his contract with Nike provided him the right to one day receive these rights. Federer is one of the most famous athletes of all time. He currently has won more majors than any male tennis player in the "Open Era," and he is admired all over the world, not only for his excellence on the court but also for his humble attitude and family man persona off the court. *See* FP Staff, *Federer Most Trusted, Respected After Mandela in the World*, FirstPost (September 21, 2011), *https://www.firstpost.com/sports/federer-most-trusted-respected-after-mandela-in-the-world-survey-88642.html*.

Short of a contractual provision, Federer may be attempting to look to his right of publicity for the logo which includes his initials. Jurisdictions within the United States, however, are divided over whether foreign individuals, like Roger Federer, can claim a right of publicity in the United States. Whether a person's initials are entitled to the same protection as one's name may be another issue as well as whether he could satisfy the elements of an actionable claim. Likely the biggest issue is whether Federer gave Nike consent in his contract to use his initials when Nike originally developed the RF logo and applied for the trademark registration in 2008. Whether Nike's continued use of the RF logo after the expiration of its agreement with Federer exceeds the scope of Federer's consent would depend on the specific language in the agreement. *See, e.g.*, *Sharman v. C. Schmidt & Sons, Inc.*, 216 F. Supp. 401, 405-06 (E.D. Pa. 1963) (considering whether the use of plaintiff's photograph exceeded the authorization of his release to use the photograph); *Cepeda v. Swift & Co.*, 415 F.2d 1205, 1207-08 (8th Cir. 1969) (finding that the use of a baseball player's name and likeness in advertising materials affixed to meat products was within the scope of his agreement with Wilson Sporting Goods Company).

Federer may explore arguments related to trademark law, but such arguments are likely to also be unavailing. The law does permit the use of the name of a person—or for that matter, their initials—as a trademark when the name or initials function as a source identifier and have obtained secondary meaning. *See Experience Hendrix, LLC v. Electric Hendrix, LLC*, 2008 WL 3243896, at *4 (W.D. Wash. Aug. 7, 2008); *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990); *see also Stephano Bros. v. Stamatopoulos*, 238 F. 89, 93-94 (2d Cir. 1916) (discussing the history of trademarking names). "Marks acquire secondary meaning when 'the name and the business have become synonymous in the mind

of the public, submerging the primary meaning of the term in favor of its meaning as a word identifying that business.'" *Experience Hendrix*, 2008 WL 3243896, at *4 (quoting *Abraham Zion Corp. v. Lebow*, 761 F.2d 93, 104 (2d Cir. 1985)). Even harder for Federer is the fact that the RF mark achieved incontestable status in 2015, which means that the validity of the RF mark can only be challenged "on the grounds that it is generic, it has been abandoned, it is fraudulently used by the registrant, or it was obtained fraudulently." *Id.* at *5.

Finally, one additional interesting consideration is copyright protection and ownership of the RF logo. If there exists a sufficient amount of minimal creativity for the RF logo, which meshes together the two letters in a stylistic font, to satisfy the modicum of creativity required to be protectable by copyright law, *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991), then the issue will likely come down to who created what, whether the work is a work for hire, and what the parties' agreement says on the issue.

Because right of publicity rights, trademark rights, and copyright avenues to obtain rights in the RF logo look challenging at best for Federer, his hope may be attributable to one of two things: the contract provides that the RF logo will one day be assigned to Federer; or two, Federer's lucrative relationship with Nike may one day persuade Nike to voluntarily transfer the rights to Federer, possibly for an additional fee. Whichever route the RF logo takes, as Federer mentioned at Wimbledon, he does not have a shoe deal and he could still work out a shoe deal with Nike. So maybe the Nike + Federer relationship can live on….

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