

Blood May be Thicker than Water, but is it Thicker than Federal Trademark Rights? One Family's Relationship Tested at the USPTO

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Slovenian-born Luka Doncic became a professional basketball player at the young age of sixteen years old and the towering height of 6'7". He quickly made a name for himself, leading his Spanish team Real Madrid to the 2018 EuroLeague title, while also winning EuroLeague MVP, EuroLeague Final Four MVP, ACB Best Young Player, and ACB Most Valuable Player honors and participating in the EuroLeague 2010-2020 All-Decade Team. Recognizing that the sky was the limit for her young and talented son, Doncic's mother, Mirjam Poterbin, filed a series of trademark applications with the U.S. Patent and Trademark Office in 2018-2019. The trademarks were intended to protect her son's likeness for a vast variety of promotional-based goods and services, including computer games for basketball in Class 9, sporting equipment in Class 28, and business management services in Class 35. These trademarks each incorporate a variation of Doncic's name and the "7" jersey number he was wearing during his time in the

EuroLeague. According to the Trademark Manual of Examining Procedure (“TMEP”) § 813, when a trademark identifies a particular living individual, that mark can only be registered “with the written consent of the individual...if there is evidence that the name identifies a specific living individual who is publicly connected to the goods or services.” Unsurprisingly, Doncic gave his mother consent to use his name and protect his interests. The applications matured to registration, and Doncic’s career continued to take off.

In 2018, Doncic was selected third overall in the NBA draft by the Atlanta Hawks, and was then immediately traded to the Dallas Mavericks, with whom he currently plays. In his first season in the NBA, Doncic became the youngest 20-point scorer in the Mavericks’ history, scored his first 30-point game, made the NBA’s All-Rookie First Team, and was named NBA Rookie of the Year, all while wearing the number “77” jersey. Everything seemed satisfactory for Poterbin and her up-and-coming NBA superstar son. However, recognizing the need to protect his own likeness and career potential, Doncic founded Luka99, Inc. to handle his business affairs. In 2021, Luka99 filed numerous trademark applications, the most pertinent ones of which include the wordmarks LUKA DONCIC and ORIGINAL HOOPS OF LUKA DONCIC, covering a wide array of goods and services, from printed books about athletes in Class 16 to insulated beverage sleeve holders in Class 21 and basketball hoops in Class 28. However, Doncic immediately ran into problems at the USPTO. The problem? None other than his own mother.

On March 9, 2022, the USPTO’s examining attorney refused two of Doncic’s applications based on a likelihood of confusion under Section 2(d) of the Lanham Act with his mother’s existing LUKA 7 trademarks. In an attempt to clear the way for his applications, and in what appears to be an issue of first impression for the USPTO, on September 7, 2022, Doncic filed a cancellation action against his mother’s registrations seeking to *revoke* his consent under Section 813. His petition for cancellation notes that, on July 23, 2021, he sent his mother a letter “specifically and expressly revok[ing] the consent effective immediately.” As a result, his mother’s marks “remain[] registered without Mr. Doncic’s consent,” which violates Section 2(c) of the Lanham Act. The petition also includes claims for abandonment under Section 14(3) and false suggestion of a connection with an individual under Section 2(a).

The outcome of Doncic’s petition is difficult to predict, as neither the TMEP nor applicable case law provide a clear answer to the question whether an individual can revoke their consent once it has been given. Doncic argues that allowing his mother’s registrations to stand will undoubtedly cause consumer confusion, creating the presumption that Doncic is affiliated with, sponsored by, or otherwise connected to his mother’s LUKA DONCIC 7 trademarks. He also points out that he granted his consent in the first place when he was young and reliant on his mother “to provide assistance and guidance for his off-court business opportunities.” But now, as an adult superstar with millions of professional fans, Doncic wants control of his own affairs.

Unfortunately for the *stare decisis* fans out there, the outcome of this case might not establish new trademark law. While the revocation of consent issue is the most fascinating claim in Doncic's petition, there is an easy way out—abandonment. According to Doncic, his mother is not using the LUKA 7 trademarks, and has no known licensees. As such, her registrations may be subject to cancellation on that ground alone, leaving the consent issue for another day and another matter. But this cancellation proceeding is one to keep an eye on – it could very well result in new trademark law. And new law regarding consent would have far-reaching applications, especially as athletes, including those in college, take a more vested interest in the rights to their own likeness and publicity. Poterbin's answer to the petition is due on October 17, 2022, and her response (if any) may provide more clarity as to how this action will shake out. At this stage, it's truly a jump ball.