

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

TODD C. BANK,

Plaintiff,

-against-

NFL PROPERTIES LLC,

Defendant.

COMPLAINT

1:25-cv-3981

INTRODUCTION

1. The National Football League is an unincorporated association of 32 U.S.-based professional football teams (each an “NFL Team,” and, collectively, the “NFL”), which is in the business of “providing entertainment services to the public in the form of competitive professional football games.” Amended Complaint, *NFL Properties LLC v. The Partnerships*, No. 1:21-cv-05522 (N.D. Ill. Dkt. No. 26, Oct. 29, 2021).

2. The NFL has, to a considerable degree, convinced the public that the NFL has, and is legally entitled to have, a monopoly over the commercial use of certain names and symbols of the NFL Teams and the League (“NFL Trademarks”) on merchandise. However, “trademark rights, unlike statutory copyrights or patents, are not rights in gross or at large,” *Jackpocket, Inc. v. Lottomatrix NY LLC*, 645 F. Supp. 3d 185, 236 (S.D.N.Y. 2022), quoting *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655, 663 (2d Cir. 1979), and the NFL’s monopoly is based not on fundamental principles of trademark law, but, rather, on a perverted simulacrum of those principles, as a result of which consumers have overpaid billions of dollars for merchandise bearing NFL Trademarks (“NFL Merchandise”) and the NFL has received billions of dollars to which it has never been entitled under genuine trademark principles.

3. As observed in Jodi S. Balsam, *Timeout for Sports Trademark Overprotection*:

Comparing the United States, European Union, and United Kingdom, 52 Calif. Western Int'l Law Journal 351 (2022), whose author was in-house counsel for the National Football League from 1994 to 2007, and managed, *inter alia*, intellectual-property litigation:

Much has been written about the “overprotection” of trademark, *especially in the sports industry*. Actionable trademark infringement and dilution have been expanding, largely as a byproduct of the *trademark merchandising right*. *This relatively new-found right has transformed the names, logos, catchphrases, and colors of sports leagues and teams into commodities that can be monetized*. Sports entities and teams now possess *near-monopoly control over a broad swath of words and symbols*. In *abandoning trademark’s traditional purpose* to identify the source and origin of goods, current trademark doctrine has *harmed consumer welfare and competitive markets*, and bolstered private entitlements to language and iconography

Id. at 351 (emphases added).

4. As observed in *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188 (S.D.N.Y. 1983):

Copying [a trademark] enables one to sell the mark for a lower price than the originator is able or inclined to sell, thereby making the goods involved *accessible to more consumers as the price is reduced*. Indeed, the freedom to copy tends to create competition among copiers, and will *drive down prices* to the point where the marginal return on investment is merely adequate, thus creating the *broadest practicable public access to goods*, and tending to *prevent monopoly profits and prices*.

Id. at 1195 (emphases added).

5. What was recently recognized regarding “[t]he modern collegiate trademark-and licensing-regime,” *Pennsylvania State University v. Vintage Brand, LLC*, 614 F. Supp. 3d 101, 114 (M.D. Pa. 2022) (“*Penn State I*”), is equally true of the NFL’s trademark-and licensing-regime: it “has grown into a multibillion-dollar industry. But that a house is large is of *little matter if it’s been built on sand*.” *Id.* (emphasis added).

6. As observed in Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right*:

Fragile Theory or Fait Accompli?, 54 Emory Law Journal 461 (2005), “the fact that consumers may believe [that] trademark owners have a right to control merchandise bearing their brands *does not itself justify a merchandising right.*” *Id.* at 489 (emphases added).

7. With respect to the NFL’s house of sand: “[t]he *circularity* is apparent: the law only offers protection if there’s belief, yet the belief comes from consumers’ *(mis)conception* about the law. It would seem *perverse* to award market exclusivity based on a *fake-it-until-you-make-it approach*. If consumers’ confusion stems from their *incorrect belief* that goods bearing [NFL] emblem[s] must be licensed, *shouldn’t that belief be corrected, not perpetuated?*” *Penn. State I*, 614 F. Supp. 3d at 114 (emphases added).

8. The “fake-it-until-you-make-it approach” has led to “*self-perpetuating circular reasoning* rather than *sound legal doctrine.*” 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 Law Review 873, 879 (2007) (“*Tschura*”) (emphases added).

9. The following observation by *Tschura* is equally applicable to NFL Merchandise:

There is no rationale for treating school *color or logo decorations on apparel* or other goods any differently than the courts have historically treated the *functional or aesthetically pleasing features of any other product’s configuration*. If the useful or aesthetically pleasing features of a product are a *key component of the product itself*, such features should be *denied protection despite the undeniable role the features might play as an identifier of source*. Collegiate logos and symbols on fan/student/alumni merchandise *certainly fit this bill*.

Tschura, 53 Wayne L. Rev. at 889 (emphases added). Thus, *Tschura* recognized that sports logos are functional in both the utilitarian and aesthetic senses, which are further addressed in Sections II(A)(i) and (ii) herein. *See also* Mark A. Kahn, *May the Best Merchandise Win: The Law of Non-Trademark Uses of Sports Logos*, 14 Marquette Sports Law Review 283, 297 (2004) (“[b]ecause

purchasers of team merchandise probably would strongly prefer the *actual logo* of their favorite team to appear on the merchandise rather than merely the team name or some unauthorized logo, *such official logos properly fit under the definition of aesthetically functional features*” (emphasis added)).

10. Plaintiff, who wishes to sell NFL Merchandise without the approval of the NFL and without the risk of being sued by NFLP under the federal trademark statute, *i.e.*, the Lanham Act, 15 U.S.C. §§ 1051 - 1141, seeks a Declaratory Judgment, the granting of which would require no change to the relevant fundamental principles of trademark law, but merely the recognition and application of those principles.

PARTIES

11. Plaintiff, Todd C. Bank (“Bank”), is a natural person who resides in the State of New York.

12. Defendant, NFL Properties LLC (“NFLP”), is a limited-liability company organized and existing under the laws of the State of Delaware, and has its principal place of business in New York, New York.

13. NFLP is the NFL’s merchandising and licensing arm, and is responsible for negotiating with, and licensing, third parties to create NFL Merchandise.

JURISDICTION AND VENUE

14. This Court has subject-matter jurisdiction under 28 U.S.C. Section 1331.

15. This Court has personal jurisdiction over NFLP under Section 301 of the New York Civil Practice Law and Rules.

16. Venue is proper in this District under 28 U.S.C. Section 1391(b)(1).

LEGAL PRINCIPLES

I. Trademark Licensing

17. Although trademark licensing was once seen as antithetical to trademark law, it is now well recognized:

At one time it was accepted law that a trademark's *sole purpose* was to identify for consumers the product's *physical source or origin*. Under this early 'source theory' of protection, trademark licensing was viewed as philosophically impossible. However, in the middle of the twentieth century, a trend develop[ed] approving of trademark licensing—so long as the licensor controlled the quality of the licensee's products—on the theory that a trademark might also serve the function of identifying product quality for consumers. The quality theory permits a trademark owner to license the mark and allow licensees to buy supplies from anyone, provided the licensor maintains quality control over products reaching consumers under the mark.

Authentic Apparel Group, LLC v. United States, 989 F.3d 1008, 1016 (Fed. Cir. 2021) (emphases added).

18. The Trademark Trial and Appeal Board ("TTAB") of the United States Patent and Trademark Office ("USPTO") explained:

"Trademarks can serve to identify and distinguish a '*secondary source*' in the sense of indicating *sponsorship or authorization*. The '*secondary source*' is the *trademark owner and licensor* who has *permitted the use of its mark on certain goods or services*."

Major League Baseball Players Ass'n v. Chisena, Opp'n No. 91240180, 2023 WL 2986321, *18 (T.T.A.B. Apr. 12, 2023), quoting J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition*, § 3:8 (5th ed. 2017) (emphases added).

19. The NFL does not manufacture, *i.e.*, is not the "Primary Product Source" of, NFL Merchandise.

20. The NFL is affiliated with NFL Merchandise as a "secondary source" by sponsoring, or endorsing, it by licensing third parties to manufacture it, and is therefore a "Product Sponsor" of

NFL Merchandise.

II. Functionality

21. Bank does not, and need not, challenge trademark-licensing in general. Instead, his entitlement to sell NFL Merchandise of which the NFL is neither the Primary Product Source nor a Product Sponsor is granted by the trademark-law principle that “aspects of a product that are ‘functional’ generally ‘cannot serve as a trademark’” (the “Functionality Doctrine”). *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.*, 696 F.3d 206, 218 (2d Cir. 2012), quoting *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995) (emphases added).

22. “‘The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead *inhibiting legitimate competition by allowing a producer to control *** ‘the aesthetic design of a product . . . [where] giving the markholder the right to use it exclusively would put competitors at a significant non-reputation-related disadvantage.’”* *Sulzer Mixpac AG v. A&N Trading Co.*, 988 F.3d 174, 182 (2d Cir. 2021), quoting *Christian Louboutin*, 696 F.3d at 220.

23. Under the Functionality Doctrine, even “‘if a markholder has successfully demonstrated that its [trade]mark is valid and that the competitor’s [use of that] mark is *likely to cause confusion*” by consumers regarding the identity of the Primary Product Source or a Product Sponsor of a product that bears that trademark, “the competitor can *nevertheless prevail* ... by showing that the [competitor’s use of that] [trade]mark is *functional*—a *traditional defense to the enforcement of a trademark*.” *Christian Louboutin*, 696 F.3d at 217 (emphases added; citation and quotation marks omitted; altered).

24. “The Lanham Act . . . *does not protect* [a functional] trade[mark] . . . *simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.*” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S.

23, 34-35 (2001) (emphases added).

25. “Functionality is a potent public policy, for it trumps all evidence of actual consumer identification of source and all evidence of actual consumer confusion caused by an imitator,” and “no amount of evidence of . . . actual confusion will create a right to exclude.” 1 J. Thomas McCarthy, *McCarthy on Trademarks*, § 7:63 (5th ed. 2017).

26. In short, functionality trumps confusion.

A. Types of Functionality

27. If a product feature is functional in the utilitarian sense, a competitor of the trademark holder is free to copy it for commercial use.

28. If a product feature is aesthetic, expressive, or communicative, a competitor of the trademark holder is free to copy it for commercial use if the competitor, by being *precluded* from such copying, would, in the market, be at a significant disadvantage that is based upon something *other than* the competitor’s lack of a right to represent, with respect to the competitor’s products, that the trademark holder is the Primary Product Source or a Product Sponsor of those products (hereinafter, aesthetic functionality and expressive or communicative functionality will be collectively referred to as “non-utilitarian functionality”).

(i) Utilitarian Functionality

29. “[A] product feature is considered to be ‘functional’ in the utilitarian sense if it is (1) ‘essential to the use or purpose of the article,’ or if it (2) ‘affects the cost or quality of the article’[;] . . . [and, a] feature is essential if [it] is dictated by the functions to be performed by the article.” *Christian Louboutin*, 696 F.3d at 219, quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10 (1982) (additional citations and quotation marks omitted).

(ii) Aesthetic Functionality

30. As explained in *Sulzer Mixpac AG v. A&N Trading Co.*, 988 F.3d 174 (2d Cir. 2021):

A [product] feature can still be functional *even if* it is not essential to a product’s use or purpose and does not affect a product’s cost or operation. This is referred to as *aesthetic functionality*, where “the *aesthetic design* of a product is *itself* the mark for which protection is sought.” [*Christian Louboutin*, 696 F.3d] at 219-20 (emphasis in original). In such instances, [a] [c]ourt considers whether “giving the markholder the right to use it exclusively would put competitors at a *significant non-reputation-related disadvantage*.” *Id.* at 220 (internal quotation marks omitted).

Id. at 182 (emphases added).

(iii) Expressive or Communicative Functionality

31. A trademark is expressive or communicative if it enables its purchaser to express a feeling or point of view, such as by “offering consumers the opportunity to identify with an idea or movement with which they wish to associate.” *Who Dat Yat Chat, LLC v. Who Dat, Inc.*, No. 10-cv-1333, 2012 WL 1118602, *13 (E.D. La. Apr. 3, 2012).

32. *Who Dat Yat Chat* further observed with respect to expressive or communicative functionality:

There is support for such an analysis of the functionality defense in the context of *purchases driven by consumers’ desire to associate with expressions that may serve as trademarks*. 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 (2007). Tschura takes the view that *especially in the context of sports-branded apparel*, “the expression of the wearer’s allegiance to the team described by the trademark is the essential function.” *Id.* at 874. He argues that *in the context of clothing with sports team names*, such putative trademarks serve a *small source-identification function that is outweighed by the “expressive or communicative function of the ornamentation.”* *Id.* at 893–94.

Who Dat Yat Chat, 2012 WL 1118602 at *13, n.17 (emphases added; altered).

33. As observed in Jodi S. Balsam, *Timeout for Sports Trademark Overprotection*:

Comparing the United States, European Union, and United Kingdom, 52 Calif. Western Int'l Law Journal 351 (2022), whose author was in-house counsel for the National Football League from 1994 to 2007, and managed, *inter alia*, intellectual-property litigation: “[u]nder a *traditional trademark regime*, unaffiliated third parties would be *free to manufacture and sell shirts with team logos* [and] would not be liable for *ornamental or expressive ‘non-trademark use’ of logos.*” *Id.* at 357-358 (emphases added; footnoted omitted).

34. The Ninth Circuit Court of Appeals recognized:

It is not uncommon for a *name or emblem* that serves in one context as a . . . *trademark* also to be merchandised for its *own intrinsic utility to consumers*. *We commonly identify ourselves by displaying emblems expressing allegiances*. Our jewelry, clothing, and cars are emblazoned with inscriptions showing the organizations we belong to, the schools we attend, the landmarks we have visited, *the sports teams we support*, the beverages we imbibe. Although these inscriptions frequently include names and emblems that are also used as . . . trademarks, *it would be naive to conclude that the name or emblem is desired because consumers believe that the product somehow originated with or was sponsored by the organization the name or emblem signifies*.

Int'l Order of Job's Daughters v. Lindeburg & Co., 633 F.2d 912, 918 (9th Cir. 1980) (emphases added). *See also Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1196 (S.D.N.Y. 1983) (“[t]he Lanham Act imposes *no restraint on the free marketing of functional marks* which consumers or manufacturers mount on collateral items *as a means of personal expression*” (emphases added)); C. Knox Withers, Note, *Sine Qua Non: Trademark Infringement, Likelihood of Confusion, and the Business of Collegiate Licensing*, 11 Journal of Intellectual Property Law 421, 448 (2004) (“*Withers*”) (describing the type of functionality in *Job's Daughter* as “communicative functionality”); *id.* at 452-453 (“[p]rimarily, the ‘*Job's Daughters*’ cases refuse to concede that consumers purchase unlicensed promotional items bearing registered trademarks *because* [(emphasis in original)] they believe that the mark owner sponsored the goods. Instead, these opinions adopt the notion that

consumers buy those items in an attempt to *express allegiance to, or support for, the entity whose mark is used, irrespective of whether that entity actually endorsed the product or owned the trademark*” (emphasis added)); Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory Law Journal 461, 463, n.9 (2005) (“[i]magine, for example, that I am a Dallas Cowboys fan who wants to wear a Cowboys t-shirt *to show my support for the team*. In that case, the trademark is an *essential part of the product* I’m seeking—I am not looking to buy just *any* t-shirt, but a t-shirt *with COWBOYS as its defining feature*” (emphases added)); *id.* at 471-472:

[T]he so-called “*merchandising right*” is *something of an anomaly*. When fans buy t-shirts with the name of their school, *team*, or rock band, they are almost always buying a product bearing *an established mark entitled to some form of trademark protection*.⁴⁰

⁴⁰ Typically, the mark has acquired trademark status through use in connection with *some other primary activity*, such as *baseball entertainment services*, educational services, or music performance. As such, the mark serves as a source-indicator *with respect to these services*, and the trademark holder would have the right to prevent use of the mark on *similar services or products*.

(emphases added). *See also Withers*, 11 J. Intell. Prop. Law at 454 (“[w]hether the consumer believes that the trademark originated in the entity owning it is irrelevant; of course, the consumer believes that to be the case. That assumption does not indicate that the consumer buys the product *because* of such a belief” (emphasis in original)).

**B. Determining Whether a Product Feature is Functional Where That Feature is Non-Utilitarian, i.e., Either:
(i) Aesthetic; or (ii) Expressive or Communicative**

35. Whereas a finding of utilitarian functionality of a product feature entitles a competitor to use that feature regardless of whether doing so is a “competitive necessity,” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33 (2001), “[t]he ultimate test of [non-utilitarian] functionality ... is whether the recognition of trademark rights in a[] [non-utilitarian] design feature

would *significantly hinder competition*,”” *Christian Louboutin*, 696 F.3d at 221, quoting *Qualitex*, 514 U.S. at 170 (emphasis added; “non-utilitarian” replacing “aesthetic,” as is the case with each bracketed use of “non-utilitarian” hereinafter; additional quotation marks omitted; altered), *i.e.*, whether “giving the markholder the right to use [a non-utilitarian design feature] exclusively ‘would put competitors at a *significant non-reputation-related disadvantage*.’” *Id.* at 220, quoting *Qualitex*, 514 U.S. at 165 (emphasis added).

36. “[W]hen evaluating design trademarks,” *Christian Louboutin*, 696 F.3d at 220, *i.e.*, “trademark[s] . . . [constituting] a particular visual design, often a *logo*,” *Bechler v. MVP Group Int’l, Inc.*, No. 16-cv-8837, 2021 WL 848024, *6 (S.D.N.Y. Mar. 5, 2021) (emphasis added), “[a court] consider[s] whether certain features of the design are *essential to effective competition in the particular market*.” *Christian Louboutin*, 696 F.3d at 220 (emphasis added; citation and quotation marks omitted; altered)).

37. “Lanham Act protection does not extend to configurations of ornamental features,” *Christian Louboutin*, 696 F.3d at 220, *i.e.*, features that “‘do[] not serve a [utilitarian] purpose’ in the design of a product,” *id.* at 214, n.4, quoting *TrafFix Devices*, 532 U.S. at 35, if such protection “would *significantly* [(emphases in original)] limit the range of competitive designs available[:]; [a]ccordingly, . . . the doctrine of [non-utilitarian] functionality bars protection of a mark that is *necessary to compete in the relevant market*.” *Christian Louboutin*, 696 F.3d at 221 (emphasis added; citations and quotation marks omitted; altered).

38. “Where an ornamental feature is claimed as a trademark and trademark protection would significantly hinder competition by limiting the range of adequate alternative designs, the [non-utilitarian-]functionality doctrine denies such protection. But on the other hand, distinctive and arbitrary arrangements of predominantly ornamental features that do not hinder potential competitors from entering the same market with differently dressed versions of the product are non-functional,

and are hence eligible for trademark protection.” *Christian Louboutin*, 696 F.3d at 222 (citations and quotation marks omitted; altered). *See also Eliya, Inc. v. Steven Madden, Ltd.*, 749 F. Appx. 43, 47 (2d Cir. 2018) (“[a]n ornamental product feature is ‘ . . . functional’ [in the non-utilitarian sense] if ‘trademark protection would significantly hinder competition by limiting the range of adequate alternative designs,’” quoting *Christian Louboutin*, 696 F.3d at 222).

39. “[I]n short, a mark is . . . functional [in the non-utilitarian sense], and therefore *ineligible for protection under the Lanham Act*, where protection of the mark *significantly undermines competitors’ ability to compete in the relevant market*.” *Christian Louboutin*, 696 F.3d at 222 (emphases added).

40. “Because [non-utilitarian] function and branding success can sometimes be difficult to distinguish, the [non-utilitarian-]functionality analysis is highly fact-specific. In conducting this inquiry, courts must consider both the markholder’s right to enjoy the benefits of its effort to distinguish its product *and* the public’s right to the vigorously competitive market protected by the Lanham Act, *which an overly broad trademark might hinder*.” *Christian Louboutin*, 696 F.3d at 222 (emphases added; citation and quotation marks omitted).

41. “[T]he functionality defense does not guarantee a competitor the *greatest range* for [his] creative outlet, but only the *ability to fairly compete within a given market*. It is a first principle of trademark law that an owner *may not use the mark as a means of excluding competitors from a . . . market*.” *Christian Louboutin*, 696 F.3d at 223-224 (emphases added; citation, quotation marks, and footnote omitted).

C. A Competitor of a Trademark Holder is Free to Copy the Trademark for Commercial Use if the Competitor, by Being *Precluded* from Such Copying, Would, in the Market, be at a Significant Disadvantage That is Based upon Something Other Than the Competitor’s Lack of a Right to Represent That the Trademark Holder is the Primary Product Source or a Product Sponsor of the Competitor’s Products

42. The “reputation” in “non-reputation-related disadvantage” is the reputation of a trademark holder as either the Primary Product or a Product Sponsor of a product.

43. In *Qualitex*, the Supreme Court provided an example in which the “exclusive use of [a product] feature would put competitors at a significant non-reputation-related disadvantage,” *Qualitex*, 514 U.S. at 165:

Functionality doctrine . . . would require, to take an imaginary example, that even if customers have come to *identify* the special illumination-enhancing shape of a . . . light bulb *with a particular manufacturer*, the manufacturer *may not use that shape as a trademark*, for doing so . . . would *impede competition—not by protecting the reputation* of the original bulb maker, but by frustrating *competitors’ legitimate efforts to produce an equivalent illumination-enhancing bulb*.

Id. (emphases added). As another court explained:

[T]he “special illumination-enhancing shape of a . . . light bulb,” *even if identifying a particular manufacturer as the product’s source*, would not receive trademark protection if this would frustrate “competitors’ legitimate efforts to produce an equivalent illumination-enhancing bulb.” [*Qualitex*, 514 U.S.] at 165. Even if the light bulb shape *identifies a particular manufacturer as the source*, if that shape is deemed “functional,” it is *not a protectable trademark*.”

Who Dat Yat Chat, 2012 WL 1118602 at *12 (emphases added).

44. The *Qualitex* example demonstrates that a competitor that is precluded from producing light bulbs with the feature in question, *i.e.*, “the special illumination-enhancing shape,” would be at a disadvantage in the market because, irrespective of the feature’s status as a trademark, and irrespective of whether consumers (incorrectly) believe that the trademark holder is the Primary Product Source or Product Sponsor of the competitor’s light bulbs, the feature, by being functional,

increases the demand for light bulbs that contain it. This type of disadvantage is the opposite of the type of disadvantage that would not, and, per common sense, should not allow a competitor to use another's trademark, *i.e.*, a disadvantage based solely upon the lack of a right of the competitor to represent, with respect to the competitor's products, *e.g.*, light bulbs that do not contain "the special illumination-enhancing shape," that the trademark holder is the Primary Product Source or Product Sponsor of those light bulbs. This type of disadvantage is a *reputation-based* disadvantage, whereas a primary purpose of trademark law is to *protect* the reputation a trademark holder in his capacity as a Primary Product Source or Product Sponsor. As the Supreme Court has explained:

[A] trademark . . . *identifies a product's source* (this is a Nike) *and distinguishes that source from others* (not any other sneaker brand). In other words, a mark tells the public *who is responsible for a product*. [¶] In serving that function, trademarks benefit consumers and producers alike. A *source-identifying mark* enables customers to select "the goods and services that they wish to purchase, as well as those they want to avoid." *Matal v. Tam*, 582 U.S. 218, 224 (2017). The mark "quickly and easily assures a potential customer that *this* [(emphasis in original)] item—the item with this mark—is *made by the same producer* as other similarly marked items that he [] liked (or disliked) in the past." *Qualitex*[,], 514 U.S. [at] 164 (1995). And because that is so, the producer of a quality product may derive significant value from its marks. They ensure that the producer itself—and not some "imitating competitor"—will reap the financial rewards associated with the product's good *reputation*. *Ibid*.

Jack Daniel's Properties, Inc. v. VIP Products LLC, 599 U.S. 140, 146 (2023) (emphases added).

45. The distinction between a reputation-related disadvantage and a *non*-reputation-related disadvantage was applied in *Bubble Genius LLC v. Smith*, 239 F. Supp. 3d 586, 597 (E.D.N.Y. 2017), which recognized that, "the non-functionality requirement *protects competition even at the cost of potential consumer confusion*," *id.* at 594 (emphasis added; citation and quotation marks omitted), and explained, in ruling in favor of the trademark holder's competitor, that, "protecting [the] plaintiff's claimed trade[mark] would hinder competition for periodic[-]table[-]inspired novelty soaps; competitors in [the] market . . . for [such] soaps would be placed at a '*significant non*-

reputation-related disadvantage’ if [the] plaintiff had *exclusive rights to produce and sell* [those] soaps.” *Id.* at 597 (emphases added).

D. Judicial Recognition of Functionality Based Upon Reasoning That is Applicable to NFL Merchandise

- (i) ***University of Pittsburgh v. Champion Prods. Inc.*, 566 F. Supp. 711 (W.D. Pa. 1983), order vacated (3d Cir. Feb. 2, 1984) (due to “a consent decree that was included in the parties’ settlement agreement,” *Penn State I*, 614 F. Supp. 3d at 111)**

46. In *Univ. of Pittsburgh*, the court found that, “[t]he Pitt insignia, as used by Champion [to be] prominently emblazoned on soft goods, are functional” in the utilitarian sense and in the expressive and communicative sense, *Univ. of Pitt.*, 566 F. Supp. at 716: “[t]hese insignia perform the function of allowing the wearer to *express identity, affiliation, or allegiance to Pitt*[;] [t]his *functional feature* is an *essential feature* of the product[;] [and][,] [t]he product *could not perform this function unless it bore the Pitt insignia*.” *Id.* (emphases added). Accordingly, the court found that, “[t]he Pitt insignia prominently emblazoned on the Champion Pitt-insignia soft goods is *therefore essential to the use or purpose of the articles*,” *id.* (emphasis added), and added: “‘with negligible exception, a consumer does not desire a “Champion” T-shirt, he . . . desires a “Pitt” T-shirt. The entire impetus for the sale is the consumer’s desire to *identify with Pitt* or, perhaps more realistically, *with Pitt’s athletic programs*.’” *Id.*, quoting *University of Pittsburgh v. Champion Products Inc.*, 686 F.2d 1040, 1047 (3d Cir. 1982) (emphases added).

47. *Univ. of Pittsburgh* also explained:

We have considerable sympathy for the . . . University of Pittsburgh. The notion that a university’s name and insignia are its own property, to do with as it chooses, has *a certain common-sense appeal*. An examination of the law and the facts in this case has convinced us, however, that neither Congress, nor the Pennsylvania Legislature, nor the common law has created the property right that Pitt asserts here. We believe that were we to rule in favor of Pitt, we would be creating a *new substantive right in an area of the law in which Congress and the states have legislated extensively*. The relief

sought by Pitt is *not minor*; it amounts to a *judicially created, perpetual monopoly on a product, Pitt-insignia soft goods*, which many people wish to purchase.

Id. at 712 (emphases added).

48. As observed in *Withers*:

Although the ensuing settlement vacated the *University of Pittsburgh* decision, it still stands for *several important principles*. First, the court recognized the concept of *communicative functionality*. Unlicensed apparel or novelty items bearing a college or university's mark which *communicates the purchaser's support of that school satisfies the requirements for a defense of functionality*. . . . *University of Pittsburgh* [also] stands for the proposition that *if consumers do not care whether an academic institution sponsors or endorses a particular product, then the issue of likelihood of confusion is moot*.

Withers, 11 J. Intell. Prop. Law at 450 (emphases added). *See also id.* at 449 (“[c]ommunicative functionality was also an issue in” *Univ. of Pittsburgh*).

(ii) ***Plasticolor Molded Products v. Ford Motor Co.*, 713 F. Supp. 1329 (C.D. Calif. 1989) (Kozinski, Circuit Judge), vacated by consent judgment, 767 F. Supp. 1036 (C.D. Calif. 1991)**

49. As in *Univ. of Pittsburgh*, *Plasticolor* recognized the doctrines of utilitarian and expressive and communicative functionality in the sports-trademark context.

50. In *Plasticolor*, the court observed that, “[o]nly relatively recently have trademarks begun to leap out of their role as source-identifiers and, in certain instances, have effectively become *goods in their own right*,” *id.* at 1332 (emphasis added), and explained that, “[w]hen sports fans wear jackets bearing the names of their favorite teams . . . , they are using . . . trademarks . . . , *but not to identify the source of the product*.” *Id.* at 1332-1333 (emphasis added).

51. *Plasticolor* further observed: “[t]he wearer of a baseball jacket reading New York Mets *does not care whether the New York Mets manufactured the jacket, or authorized its production, or are in any way associated with it*. He wears it to *announce his allegiance*. New York

Mets may well be a [trade]mark, but in this context it has *become a product as well*; it is a *functional component of the jacket as surely as the material from which the jacket is made.*” *Id.* at 1333 (emphases added; footnote omitted). Accordingly:

A small but growing number of cases has recognized this change, and has found no difficulty in applying the *source-identifying/functional distinction where trademarks . . . serve purely as functional features*. See *International Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir.1980) (insignia of young women’s fraternal organization is functional element of jewelry); *University of Pittsburgh v. Champion Prods., Inc.*, 566 F.Supp. 711 (W.D.Pa.1983) (name of university is functional element of shirts); *Bi-Rite Enters., Inc. v. Button Master*, 555 F.Supp. 1188 (S.D.N.Y.1983) (names of recording artists are functional elements of buttons). [¶] These cases have presented *no difficulty for the traditional categories of trademark law because, as in the New York Mets hypothetical, it has been clear that the ordinary purchaser has treated the marks as functional items, not as source-identifiers*. This is because *the mark and the product have represented radically different industries.*”

Id. (emphases added).

52. *Plasticolor* further observed:

In *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F.Supp. 651 (W.D.Wash.1982), *the defendant, without authorization from the plaintiff, manufactured replicas of professional football jerseys*. The court found that the jerseys’ design, colors and use of team names created a likelihood of confusion as to sponsorship. *Id.* at 662. The court then discussed, *without deciding*, whether the jersey attributes were functional features, and concluded: “*Even assuming the marks are functional, this assumption does not, however, preclude trademark protection. A functional feature may additionally serve as a trademark and be protected as such.*” *Id.* at 663.¹²

¹² In another similar case, the Fifth Circuit effectively reached the same result, without being quite so explicit. *Boston Professional Hockey Ass’n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. [1975]), involved a defendant who *manufactured embroidered cloth emblems depicting the trademarks of professional hockey teams*. The court began its discussion of the case by noting that “[t]he difficulty with this case stems from the fact that a reproduction of the trademark itself is being sold, unattached to any other goods or services.” *Id.* at

1010. Despite this effective concession of functionality, the court then went on to determine that the public would likely be confused as to sponsorship, *id.* at 1011–12, and to hold that the plaintiffs were entitled to an injunction, *id.* at 1012. The Fifth Circuit has subsequently explained that *Boston Hockey* is to be interpreted as holding that a trademark owner is protected from mixed-use copying [(i.e., copying that is ‘partially functional but partially source-identifying,’ *Plasticolor*, 713 F. Supp. at 1337)], but not purely functional copying. *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 389 (5th Cir.1977). The Ninth Circuit has rejected the reasoning of *Boston Hockey* insofar as [*Boston Hockey*] protects a pure functional use [against copying], but apparently not insofar as [*Boston Hockey*] protects a mixed use [against copying]. See *International Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918–19 (9th Cir.1980).

Plasticolor, 713 F. Supp. at 1337.

53. In *Bd. of Supervisors v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008), the court stated:

[The defendant] urges . . . that the [u]niversities’ colors on the t-shirts serve several functional purposes. It contends that the shirts allow groups of people to bond and show support for a philosophy or goal; *facilitate the expression of loyalty* to the school and a determination of the loyalties of others; and *identify the wearer as a fan and indicate the team the fan is supporting*. These claimed functional uses are *nothing more than the kind of aesthetic uses at issue in Boston Hockey*. Our circuit has consistently rejected the concept of aesthetic functionality.

Id. at 486-487 (emphases added; footnote omitted).

54. Unlike the Fifth Circuit, the doctrine of aesthetic functionality has been recognized by the Supreme Court and the Second Circuit, the latter of which observed:

The doctrine of aesthetic functionality remains controversial in our sister circuits, which have applied the doctrine in varying ways (and some not at all). For example, the Seventh Circuit has applied the doctrine of aesthetic functionality liberally, holding that “[f]ashion is a form of function.” See *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 860 (7th Cir.2010). The Sixth Circuit recently discussed the doctrine, but made clear that it has not yet decided whether or not to adopt it. See *Maker’s Mark Distillery, Inc. v. Diageo N. America, Inc.*, 679 F.3d 410, 417-19 (6th Cir.2012). The Ninth Circuit has

applied the doctrine inconsistently. *See* 1 McCarthy on Trademarks § 7:80 (4th ed.) (collecting cases). *The Fifth Circuit rejects the doctrine of aesthetic functionality entirely.* [] *Smack Apparel* [], 550 F.3d [at] 487-88 [] (arguing that the Supreme Court has recognized the aesthetic functionality doctrine only in *dicta*, and that therefore the Fifth Circuit’s long-standing rejection of the doctrine was not abrogated by *Qualitex* and *TrafFix* [Devices]).

Christian Louboutin, 696 F.3d at 221, n.17 (emphases added).

55. In *Boston Hockey*, the court, in what it called a case of “first impression,” *Boston Hockey*, 510 F.2d at 1008, observed, with respect to the trademark-infringement requirement of likelihood of confusion, that, “[a] broadening of the protection afforded by [Section 1114 of the Lanham Act] occurred by amendment in 1962 which deleted the previously existing requirement that the confusion or deception must relate to the ‘source of origin of such goods or service,’” *id.* at 1010, and found that the mere recognition by the public that a symbol is a trademark precludes competitors of the trademark holder from copying that trademark:

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*. The argument that confusion must be as to the *source of the manufacture of the emblem itself is unpersuasive, where the trademark, originated by the team, is the triggering mechanism for the sale of the emblem*.

Id. at 1012 (emphases added).

56. The reasoning of *Boston Hockey* is flawed because, even after the 1962 broadening of the Lanham Act’s confusion-based liability, the type of confusion whose likelihood is necessary for trademark infringement to occur is not the mere, and *correct*, belief that a product or product feature is a trademark, *i.e.*, a belief that does not entail *any* confusion, but, rather, the *incorrect* belief that the trademark holder had a particular relationship to a *product* bearing the trademark, *i.e.*, that the trademark holder was the Primary Product Source or Product Sponsor of that product. As

explained in *Int'l Info. Systems Security Certification Consortium v. Security Univ. LLC*, 823 F. 3d 153 (2d Cir. 2016):

The district court held that the only type of confusion relevant in determining infringement is confusion as to source. This is incorrect; protection is not exclusively limited . . . to cases in which there may be confusion as to source. Rather, “[t]he modern test of infringement is whether the defendant’s use [is] likely to cause confusion *not just as to source*, but also as to *sponsorship, affiliation or connection*.” 4 McCarthy on Trademarks and Unfair Competition [hereinafter “McCarthy”] § 23:76 (4th ed.) (emphasis added). Indeed, our Court has previously observed that in 1962 Congress amended 15 U.S.C. § 1114, the Lanham Act provision that provides penalties for infringement, to “broaden liability” from the prior “statutory requirement [that] confusion, mistake, or deception applied only with respect to purchasers as to the source of origin of such goods or services.” *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 136 (2d Cir.2009) (internal quotation marks omitted). That provision now penalizes a person who

use[s] in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is *likely to cause confusion, or to cause mistake, or to deceive*

15 U.S.C. § 1114(1)(a) (emphasis added). As is plain from this statutory text, the Act’s protection against infringement is not limited to any particular type of consumer confusion, much less exclusively to confusion as to source. Rather, the Lanham Act protects against *numerous types of confusion*, including confusion regarding *affiliation or sponsorship*. See *Rescuecom Corp.*, 562 F.3d at 128 (“Sections 32 and 43 of the Act, which we also refer to by their codified designations, 15 U.S.C. §§ 1114 & 1125, *inter alia*, impose liability for unpermitted ‘use in commerce’ of another’s mark which is ‘likely to cause confusion, or to cause mistake, or to deceive,’ § 1114, ‘as to the affiliation ... or as to the *origin, sponsorship or approval* of his [] goods [or] services ... by another person.’ § 1125(a)(1)(A).” (alterations in original)); *Hormel Foods Corp. [v. Jim Jenson Products, Inc.]*, 73 F.3d [497] at 502 [(2d Cir. 996)] (“*The central inquiry is whether there is a ‘likelihood of confusion,’ a ‘likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question,’ or that there may be confusion as to plaintiff’s sponsorship or endorsement of the junior mark.*” (emphasis added))

(quoting *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir.1978)); *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 79 (2d Cir.1981) (“On the question of competition and the likelihood of confusion, it is not necessary that Warner Bros. *actually manufacture* the toy cars, but merely that a confusion as to manufacture *or sponsorship* result.” (emphasis added)); *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204–05 (2d Cir.1979) (“Appellants read the confusion requirement too narrowly. In order to be confused, a consumer need not believe that the owner of the mark *actually produced the item and placed it on the market*. The public’s belief that the mark’s owner *sponsored or otherwise approved the use of the trademark* satisfies the confusion requirement.” (citations omitted)); *see also Team Tires Plus, Ltd. v. Tires Plus, Inc.*, 394 F.3d 831, 835 (10th Cir.2005) (“[T]he relevant confusion under trademark law is not limited to confusion of consumers as to the source of the goods, but also includes confusion as to *sponsorship or affiliation*, such as a consumer’s mistaken belief that a retailer is part of a larger franchising operation.”); *Nike, Inc. v. “Just Did It” Enters.*, 6 F.3d 1225, 1228–29 (7th Cir.1993) (“[C]ustomer ‘confusion’ need not be restricted to a mistake regarding the source of the goods; the court should also consider whether the customer would believe that the trademark owner *sponsored, endorsed or was otherwise affiliated with the product*.”).

This broader prohibition on consumer confusion as to sponsorship or approval is also made explicit in Section 43 of the Lanham Act [11 U.S.C. § 1125], which prohibits false advertising and false designation of origin by providing for civil penalties to a person injured by:

Any person who, on or in connection with any goods or services, ... 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, or false or misleading representation 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, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s

goods, services, or commercial activities....

15 U.S.C. § 1125(a)(1) (emphases added).

Id. at 161-162 (emphases added). In sum: “[t]o prove confusion, a plaintiff may show that the public believed the owner of the mark actually produced the item and placed it on the market, or that the public believed [that] the mark’s owner sponsored or otherwise approved the use of the trademark.” *Hamilton Int’l Ltd. v. Vortic LLC*, 13 F.4th 264, 272 (2d Cir. 2021) (citation and quotation marks omitted).

57. One also may not sell a product by using another’s trademark in a manner that misappropriates the good will of the trademark holder, but such misappropriation is in the context of causing the incorrect belief that the trademark holder is the Primary Product Source or Product Sponsor of the product. *See American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655 (2d Cir. 1979):

One cannot sell his product by *misappropriating the good will* of another through *misleading* the public into thinking that it is ‘*sponsored*’ by or *derived from something else*. Yet, liability in this area for misimpression or misappropriation *has been limited*. For example, one can *capitalize on a market or fad created by another* provided that it is not accomplished by *confusing the public into mistakenly purchasing the product in the belief that the product is the product of the competitor*.

Id. at 662 (emphases added; citation and quotation marks omitted; altered). *See also* 15 U.S.C. §§ 1125(d)(1)(A)(I) and (d)(1)(B)(i)(V):

In determining whether a person has a bad[-]faith intent . . . to profit from [a] [trade]mark[,], . . . a court may consider . . . the person’s intent to divert consumers from the [trade]mark owner’s online location to a [web]site accessible under [a] domain name that could harm the *goodwill* represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion *as to the source, sponsorship, affiliation, or endorsement of the site*[.]

(emphases added).

58. As explained in *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980):

[T]he court in *Boston Hockey* admitted that its decision “may slightly tilt the trademark laws from the purpose of protecting the public to the protection of the business interests of plaintiffs.” 510 F.2d at 1011. We think that this tilt was not slight but an *extraordinary extension of the protection heretofore afforded trademark owners*. It is an extension we cannot endorse. Instead, *we agree with Judge Waterman of the Second Circuit*, who recently said that under the Lanham Act “one can capitalize on a market or fad created by another provided that it is not accomplished by confusing the public into mistakenly purchasing the product in the belief that the product is the product of the competitor.” *American Footwear Corp. v. General Footwear Co. Ltd.*, 609 F.2d 655, 662 (2d Cir. 1979)[.]

Id. at 919 (emphases added; additional citation omitted). *See also* Jodi S. Balsam, *Timeout for Sports Trademark Overprotection: Comparing the United States, European Union, and United Kingdom*, 52 Calif. Western Int’l Law Journal 351 (2022), whose author was in-house counsel for the National Football League from 1994 to 2007, and managed, *inter alia*, intellectual-property litigation:

[*Boston Hockey*] collapses the distinction between the trademark and the underlying goods and rests the holding on a tautology: if consumers recognize the emblem as a team symbol then that emblem is “the triggering mechanism” for the purchase and establishes confusion.⁷⁴ By equating recognition with confusion, the Fifth Circuit effectively presumed confusion as a matter of law rather than [on] the factual record.⁷⁶ Acknowledging that its ruling “may slightly tilt the trademark laws from the purpose of protecting the public to the protection of the [sports league’s] business interests,” the court offered the circular justification that professional sports created the commercial value of the emblems and now routinely exploit it themselves.⁷⁷ The court thus . . . conferred the very “trademark monopoly” abjured by the district court.

74. *Boston Hockey*, 510 F.2d at 1012.

76. *Boston Hockey*, 510 F.2d at 1012.

77. *Id.* at 1011. Possibly concerned about too radical a reorientation of trademark law, the Fifth Circuit restricted the presumption of confusion “to the emblems sold principally through sporting goods stores for informal use by the public in connection with sports

activities and to show public allegiance to or identification with the teams themselves.” *Id.*

78. *Id.* at 1013.

Id. at 366-367 (emphases added; additional quotation marks and footnotes omitted). *See also* Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory Law Journal 461, 474 (2005) (“Dogan & Lemley”) ([“*Boston Hockey*] broke new theoretical ground and effectively wrote the confusion requirement out of the Lanham Act” (emphases added)).

As Dogan & Lemley further observed:

[“*Boston Hockey*] presumed actionable *confusion* [(emphasis in original)] based solely on the consumer’s mental *association* [(emphasis in original)] between the trademark and the trademark holder. Likelihood of confusion, in the *Boston Hockey* definition, turns not on whether consumers have any misperception about where a product comes from or whether the trademark holder has endorsed it. On this approach, confusion exists by *definition* if the trademark comprises “the triggering mechanism” in the sale.

Id., quoting *Boston Hockey*, 510 F.2d at 1012 (emphases added).

59. As Dogan & Lemley also observed, “[s]ubsequent decisions and commentaries have condemned the *Boston Hockey* court’s approach to likelihood of confusion in merchandise cases.”

Id. at 475 (footnote omitted).

Boston Hockey and its relatively few followers:

have no doubt contributed to trademark holders’ intuition in favor of a licensing right. But they offer a *rather slender reed on which to build an entire new jurisprudence*. A closer look at these cases suggests that trademark holders may be *relying on a proverbial house of cards*. The fact that courts are *at best* evenly split as to whether a merchandising right *even exists*, and *even more dubious* of its existence *in the absence of consumer confusion*, makes it *all the more surprising* that trademark owners retail businesses and even government officials *simply assume the existence of such a right*.

Id. at 478 (emphases added; footnotes omitted). Indeed, “[t]he *Boston Hockey* approach conflicts with the text of the Lanham Act, which makes infringement turn *not on mental association*,

but on *confusion, deception, or mistake*.” *Id.* at 482, citing 45 U.S.C. §§ 1114(a) and 1125(a) (emphases added).

60. The reasoning of *Boston Hockey* is irrelevant because: (i) unlike the Fifth Circuit, the doctrine of aesthetic functionality has been recognized by the Supreme Court and the Second Circuit; and (ii) functionality trumps confusion.

61. The reasoning of *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651 (W.D. Wash.1982), is irrelevant because functionality trumps confusion.

62. *Plasticolor* disagreed with the rationale of *Boston Hockey* and *Wichita Falls Sportswear*:

We are unable to adopt this reasoning. *Affording the same degree of protection against mixed-use copying as against purely source-identifying copying has the effect of protecting functional features, a result clearly contrary to established trademark law.* If we apply straightforward trademark law, we would enjoin the production of articles likely to cause public confusion as to source or sponsorship both at and after the point of sale. Confusion after the point of sale, however, is inherent in a partial functional use: A mixed-use article that eliminates the likelihood of confusion after the point of sale also defeats much of the feature’s functionality. Consider some examples: A football jersey bearing the words “Seattle Seahawks (Not Affiliated with the Seattle Seahawks)”; a shoulder patch reading “Boston Bruins (Not Sponsored by the Boston Professional Hockey Association)”; a floor mat reading “Ford (Not Manufactured by Ford Motor Company).” These disclaimers would probably end confusion as to source, but would also effectively negate the functional aspects of the marks. *Treating mixed uses exactly like source-identifying uses would thus protect functional features [against copying], a result contrary to established principles of trademark law. See p. 1336 supra. The reasoning of [Wichita Falls Sportswear] flies in the face of this authority.*¹³

¹³ [*Wichita Falls Sportswear*] purports to find authority for its conclusion in [*Job’s Daughters*]. [*Wichita Falls Sportswear*], 532 F.Supp. at 663. *Job’s Daughters*, however, only suggested that *some* [(emphasis in original)] protection may be available to mixed uses. It did not indicate that trademark holders were entitled to the same

protection against mixed uses as against pure source-identifying uses. In light of the fact that the immediately preceding section of *Job's Daughters* devotes substantial space to a well-reasoned reaffirmation of the functionality doctrine, 633 F.2d at 917–19, it is hardly likely that the court would discard the doctrine when confronted by a mixed use.

Id. (emphasis added).

63. As observed in *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188 (S.D.N.Y. 1983):

Judge Knapp recently stated in considering the meaning given by the Fifth Circuit in *Boston Hockey* to “confusion”: “We do not believe our Circuit would agree that such an extension of heretofore accepted concepts should ... be accomplished by *judicial, rather than legislative fiat.*” *Warner Bros. Inc., v. Gay Toys, Inc.*, 513 F.Supp. 1066, 1070 (S.D.N.Y.), *rev'd on other grounds*, 658 F.2d 76 (2d Cir.1981). *In this Circuit, marks that are exploited only for their functional value and not to confuse the public receive no protection under unfair[-]competition laws.* Functionality in this context means that consumers desire the mark *for its intrinsic value and not as a designation of origin.* *Ives Laboratories v. Derby Drug Co.*, 601 F.2d 631, 643 (2d Cir.1979); *accord Job's Daughters*, 633 F.2d at 918. When a mark without copyright protection is exploited for its *intrinsic functional value*, Congress has implicitly determined that *society's interest in free competition overrides the owner's interest in reaping monopoly rewards.* *See Ives Laboratories*, 601 F.2d at 643; *Damn I'm Good, Inc. [v. Sakowitz, Inc.]*, 514 F.Supp. [1357] at 1360 [(S.D.N.Y. 1981)].

Id. at 1195 (emphases added).

(iii) ***Bd. of Governors of the University of North Carolina v. Helpingstine***, 714 F. Supp. 167 (M.D.N.C. 1989)

64. In *Univ. of North Carolina*, in which the plaintiff alleged trademark infringement against a seller of apparel bearing registered trademarks of the University of North Carolina-Chapel Hill (“UNC-CH”), *see id.* at 168-169, the court observed:

While cases have indicated at one extreme that an alleged infringer's use of a mark with the knowledge that the public will be *aware of the mark's origin* is enough to establish likelihood of confusion, *see Boston [] Hockey[]*, 510 F.2d [at] 1012 [], and at the other that

likelihood of confusion occurs *only where there would be confusion as to the origin of the goods themselves*, see *Conagra[, Inc.] [v. Singleton]*, 743 F.2d [1508] at 1512 [(11th Cir.1985)], *the majority of courts have taken the middle ground on this issue*. This middle position, which both parties recognize in this case, is that the requisite likelihood of confusion will exist where there is likelihood of confusion as to *source, sponsorship or endorsement* of the goods. See *Warner Bros., Inc. v. Gay Toys, Inc.*, 724 F.2d 327, 329 (2d Cir.1983); *WSM, Inc. v. Tennessee Sales Co.*, 709 F.2d 1084, 1086 (6th Cir.1983); *Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Co.*, 676 F.2d 1079, 1082 (5th Cir.1982); *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918–19 (9th Cir.1980) (1981); *Dallas Cowboys Cheerleaders v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204–05 (2d Cir.1979).

Id. at 172 (emphases added). The middle position is the one taken by the Second Circuit, see paragraph “56” herein, although, again, functionality trumps confusion.

65. *Univ. of North Carolina*, in denying summary judgment to both parties on the university’s trademark-infringement claim, see *id.* at 168-169, 173, reasoned as follows: “the court is *skeptical* that those individuals who purchase unlicensed tee-shirts bearing UNC–CH’s marks *care one way or the other whether the University sponsors or endorses such products or whether the products are officially licensed*. Instead, as [the] [d]efendants contend, it is equally likely that individuals buy the shirts *to show their support for the University*.” *Id.* at 173 (emphases added).

66. As observed in *Withers*:

[T]he courts deciding *Job's Daughters*, *Bi-Rite*, *University of Pittsburgh*, and *University of North Carolina* were far more willing to recognize the defense of functionality than their “*Boston Hockey*” counterparts. These courts acknowledged that consumers purchase collegiate items *for their functional features and not as an indicator of source of origin*. A functional product may obtain the necessary secondary meaning to qualify for Lanham protection if the consumer purchases the good not only for its functional features but also *because he believes the trademark indicates an association between the product and the mark’s owner*.²⁵¹ That situation occurs, for example, when a consumer buys a Ralph Lauren “Polo” shirt because of Ralph Lauren’s reputation for quality and status, but that is *rarely the case when one purchases, for example, a University of Georgia shirt*. In most cases, consumers buy collegiate merchandise because

they want to *express their support for and allegiance to a particular college or university*, not because they view the phrase “Go Dawgs!” as an indication that the University of Georgia was the *source of the product*.

²⁵¹ *Nat’l Football League Props., Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 633 (W.D. Wash. 1982) (citing *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980)).

Withers, 11 J. Intell. Prop. Law at 454-455 (emphases added).

**(iv) *Pennsylvania State University v. Vintage Brand, LLC*,
614 F. Supp. 3d 101 (M.D. Pa. 2022) (“*Penn State I*”)**

67. *Penn State I* addressed a question similar to the one that *Boston Hockey* created a legal fiction to answer: “should trademark holders—particularly those in the business of education, research, and New Year’s Six [football bowl games]—have an exclusive right to control merchandise bearing their marks[,] [¶] [where] *the mark itself is the product*[,] [¶] [and] when consumers are purchasing the products *not for their guaranteed quality, but to signal their support for or affiliation with the trademark holder?*” *Id.* at 106, 107 (emphases added). *Penn State I* initially noted:

Entities’ efforts to control the use of their marks on merchandise beginning in the 1970s represented yet another attempt to expand the protections provided to sellers under the law. For universities, *this trademark use diverged from traditional areas of trademark protection, such as Penn State preventing an unaffiliated educational institution from using its name*. In this hypothetical, a consumer might reasonably believe that they are enrolling in a Penn State affiliate. But university-trademarked apparel and merchandise present a different case; *the mark itself is the product*.

From the outset[,] views diverged on whether, given this *overriding non-trademark function*, the marks still identified the entity as *the source or sponsor of the goods*. Some, notably . . . *Boston* [*Hockey* and the [United States Patent and Trademark Office’s] Trademark Trial and Appeals Board in *In re Olin Corp.*, [181 U.S.P.Q. 182, 1973 WL 19761 (T.T.A.B. 1973)][,], found that the marks inherently do. The Fifth Circuit drew this conclusion from the fact that consumers only purchase the merchandise because of the

*mental association it creates between the trademark and trademark holder. The question as [Boston Hockey] saw it was answered by sole reference to whichever party's toil generated the sale, with no need to undertake a fact-intensive inquiry into whether consumers believed the trademark holder had manufactured or sponsored the product. The Trademark Trial and Appeals Board, on the other hand, reasoned from the negative. It found that a mark—like that of New York University's—"inherently.... advise[s] the purchaser [that] the university is the secondary source of that shirt" because "[i]t is not imaginable that Columbia University will be the source of an N.Y.U. T-Shirt." This per se approach (as I'll call it) is forwarded by Penn State here; and, if adopted, it would entitle the University to its motion to dismiss as there can be no doubt that Vintage Brand's customers are buying its Penn State products *because of the associations they create with the University.**

Id. at 107-108 (emphases added; footnotes omitted). *Penn State I* added, however: "*still more have rejected* this per se approach—even if they ultimately found that a bona fide mark had been infringed. Instead, as these courts have emphasized, trademark law requires *more than a mental association between the trademark and trademark holder.* As they see it, the consumer must instead believe that the trademark indicates that the trademark holder is the *source, sponsor, or is otherwise affiliated with the good*—a question of fact," *id.* at 108 (emphases added; footnote omitted), although "many courts have still not squarely addressed the question. And that list includes the Supreme Court and the United States Court of Appeals for the Third Circuit." *Id.*

68. *Penn State I* then addressed "*Champion Products v. University of Pittsburgh*[,] [which] migrated back and forth between the Western District of Pennsylvania and the Third Circuit." *Id.* First: "the [*Univ. of Pittsburgh*] district court . . . reject[ed] the *Boston Hockey* approach. It found that there was no likelihood of confusion as to the good's *source, origin, authorization, or sponsorship*; that the marks served the *solely functional purpose of 'allow[ing] the consumer to show his [] allegiance to Pitt'*; and[,] finally[,] that apparel with Pitt's mark did not *primarily* serve a *secondary purpose of 'identify[ing] the source of the product rather than the product itself.'* [*Inwood Labs.*, 456 U.S. at 851, n.11][.]" *Id.* at 110-111, quoting *Univ. of Pittsburgh*, 566 F. Supp.

at 721 (emphases added; footnote omitted)).

69. *Penn State I* also criticized the reasoning of the Trademark Trial and Appeals Board:

I find the analysis offered by the Trademark Trial and Appeals Board in its eligibility cases unconvincing. In the university context, these revolve around *In re Olin Corp.*[.] [181 U.S.P.Q. 182, 1973 WL 19761 (T.T.A.B. 1973)][.] There, in explaining why a New York University-branded shirt would identify the university as the sponsor or authorizer, the Board reasoned, “[i]t is not imaginable that Columbia University will be the source of an N.Y.U. T-shirt.” [*In re Olin Corp.*, 1973 WL 19761 at *1] But this play on an intercollegiate rivalry distracts from an error in reasoning: *you cannot determine whether consumers believe an entity is the source or secondary source of a good by crossing out one entity that consumers obviously believe is not*. The conclusion that purchasers will think that N.Y.U. sponsored or authorized the shirt *does not necessarily follow from the statement that no purchaser will think that Columbia University is the source*. There’s a gulf of other possibilities.

Penn State I, 614 F. Supp. 3d at 111 (emphases added). Accordingly: “[*Penn State I*] [saw] no reason to perpetuate or resuscitate this per se approach. Whether consumers believe that a university is the *source, sponsor, or authorizer of merchandise* bearing its marks should—minimally—turn on just that: *what the consumers believe*. And for that reason, Penn State’s motion to dismiss [¶] Vintage Brand’s counterclaim, [which] contends that three of the University’s marks should be canceled because they are ornamental and fail to function as trademarks[,] [¶] is denied.” *Id.* at 103, 111-112 (emphases added).

(v) ***Pennsylvania State University v. Vintage Brand, LLC*,
715 F. Supp. 3d 602 (M.D. Pa. 2024) (“*Penn State II*”)**

70. In *Penn State II*, “Penn State University . . . challenge[d] Vintage Brand’s use of . . . historical sports images . . . on the goods that it produces, as many of those images incorporate[d] in some form one or more of Penn State’s trademarks,” *id.* at 613, even though “the images [were] visually distinct from those trademarks,” *id.*, and even though “Vintage Brand provide[d] numerous disclaimers on its website that disavow[ed] affiliation with any university.” *Id.* *Penn State II* held that,

“[t]hese facts mean that many of Penn State’s claims fail[,] [but] the existence of dueling facts regarding likelihood of confusion mean[s] that Vintage Brand’s trademark[-]infringement claim must proceed to trial.” *Id.*

71. The likelihood-of-confusion issue would have been moot *if* the court had ruled that, as a matter of law, Penn State’s marks were functional, but, instead, the court found that, “it *cannot be said, as a matter of law*, that Penn State’s exclusive use and control of its marks would put Vintage Brand at a *significant non-reputation related disadvantage*,” *id.* at 647 (emphases added):

It is not necessary for Vintage Brand to use the specific Penn State Marks to compete in the athletics[-]apparel marketplace or even the Penn State[-]apparel marketplace. For example, Vintage Brand could use *non-trademarked Penn State historical images* that omit the Penn State Marks. Or Vintage Brand could use *its own creative language* to attempt to entice Penn State supporters to purchase its goods. Vintage Brand could even seek to use *non-protected color schemes* to invoke Penn State in the minds of consumers without infringing upon any trademark. For instance, many alumni and supporters of Syracuse University or Bucknell University would undoubtedly associate a bright orange and navy blue necktie with their favored [sic] university—and likely purchase such goods—even if that tie *lacked any marks that explicitly associated it with those universities*.

Id. at 647-648 (emphases added). *See also id.* at 647, n.308 (“[f]or example, companies are prohibited from using the term ‘Super Bowl’ without authorization; many creative companies skirt this prohibition by using terms such as ‘the Big Game’—a reference that any fan of the National Football League instantly recognizes.”).

72. *Penn State II* concluded with respect to functionality:

Although prohibiting Vintage Brand from using the Penn State Marks would *undoubtedly place Vintage Brand at a disadvantage* in trying to win over Penn State supporters, the evidence is *simply insufficient at this stage* to describe that disadvantage as *significant*. Consequently, there remains a genuine issue of material fact as to *whether the marks are aesthetically functional*, and [Vintage Brand’s request for] summary judgment on that ground [(see *id.* at 638)] will be denied.

Id. at 648 (emphases added).

FACTUAL ALLEGATIONS

I. NFL Trademarks

73. Of the NFL Trademarks, one, *i.e.*, the “NFL Shield,” is the most widely known to represent the National Football League (the “League”).

74. Of the NFL Trademarks, 32 of them, each of which corresponds to one of the NFL Teams, are the most widely known to represent the NFL Teams (the “NFL Teams’ Principal Symbols,” and, collectively with the NFL Shield, the “NFL Principal Symbols” (a copy of the NFL Principal Symbols is attached as Exhibit “A” hereto).

II. NFL Merchandise

A. Reasons for Purchasing

75. Each year, millions of people in the United States purchase a variety of merchandise, including, but not limited to, apparel, caps, jewelry, toys, furniture, pennants, and bags that such people view as pertaining to an NFL Team, the League, or each (such people will hereinafter be referred to as “NFL Fans,” and such merchandise will hereinafter be referred to as “NFL-Related Merchandise”).

76. The primary purposes for which NFL Fans purchase NFL-Related Merchandise are, with respect to an NFL Team in its capacity as a football team (“Team Capacity”) or with respect to the League in its capacity as a football league (“League Capacity”), as opposed to their capacities as Primary Product Sources or Product Sponsors: (i) expressing and communicating (A) allegiance to an NFL Team or the League, or (B) fondness, enthusiasm, or love for an NFL Team or the League, or (ii) identifying with an NFL Team or the League (these two purposes will hereinafter be collectively referred to as the “Primary Purposes”).

77. Nearly one hundred percent of the NFL-Related Merchandise that NFL Fans purchase

in order to achieve one, or each, of the Primary Purposes is NFL Merchandise as defined in paragraph “2” herein, *i.e.*, merchandise that bears at least one NFL Trademark.

78. The NFL Trademarks on NFL Merchandise enables NFL Fans to achieve the Primary Purposes.

79. Reflecting both the importance of NFL Trademarks in enabling NFL Fans to achieve the Primary Purposes by purchasing NFL Merchandise, virtually or literally one hundred percent of the merchandise for sale on the official NFL-authorized merchandise website, nflshop.com, is NFL Merchandise as defined in paragraph “2” herein, *i.e.*, merchandise that bears at least one NFL Trademark.

80. Nearly one hundred percent of NFL Fans, in purchasing NFL Merchandise, care that the NFL Trademarks on that merchandise represent an NFL Team in its Team Capacity or the League in its League Capacity.

81. Nearly one hundred percent of NFL Fans, in purchasing NFL Merchandise, do not know, or know but do not care, that the NFL has trademark rights in any of the features that enable that merchandise to satisfy one or each of the Primary Purposes.

82. Insofar as NFL Fans, in purchasing NFL Merchandise, know and care that the NFL has trademark rights in any of the features that enable that merchandise to satisfy one or each of the Primary Purposes, the importance of that fact to them is, with respect to nearly one hundred percent of the purchases, less important than the ability of those features to satisfy one or each of the Primary Purposes.

83. Insofar as NFL Fans, in purchasing NFL Merchandise, know and care that the NFL is a Product Sponsor of that merchandise, the importance of that fact to them is, with respect to nearly one hundred percent of the purchases, less important than the ability of that merchandise to satisfy one or each of the Primary Purposes.

B. The NFL Trademarks are Functional in the Utilitarian Sense

84. The use of NFL Trademarks on NFL Merchandise is “dictated by [one of] the functions to be performed by [that merchandise],” *Christian Louboutin*, 696 F.3d at 219 (citation and quotation marks omitted), *i.e.*, the Primary Purposes. Therefore, the NFL Marks are “essential to [one of] the use[s] or purpose[s] of [that merchandise],” *id.* (citation and quotation marks omitted), and, as such, are functional in the utilitarian sense.

C. The NFL Trademarks are Aesthetically Functional

85. The NFL Trademarks are ornamental.

86. Because the appeal, to NFL Fans, of NFL-Related Merchandise that does not bear any NFL Trademarks pales in comparison to NFL-Related Merchandise that bears at least one NFL Trademark, *i.e.*, NFL Merchandise, Bank, if unable to sell NFL Merchandise, would be at a significant disadvantage in the market of NFL Fans.

D. The NFL Trademarks are Expressively and Communicatively Functional

87. Because the NFL Trademarks on NFL Merchandise satisfy the Primary Purposes, the NFL Trademarks on NFL Merchandise are expressive and communicative.

88. Because the appeal, to NFL Fans, of NFL-Related Merchandise that does not bear any NFL Trademarks pales in comparison to NFL-Related Merchandise that bears at least one NFL Trademark, *i.e.*, NFL Merchandise, Bank, if unable to sell NFL Merchandise, would be at a significant disadvantage in the market of NFL Fans.

III. Bank Will Offer NFL Merchandise for Sale if Granted the Relief Requested Herein

89. In or around April, 2025, Bank purchased 33 blank t-shirts (the “T-Shirts”).

90. In or around April, 2025, Bank purchased embroidered patches of each of the NFL Principal Symbols (the “Patches”).

91. In or around April, 2025, Bank caused one Patch to be affixed to each T-Shirt.

92. In or around May, 2025, Bank obtained the uniform resource locator and domain name of www.fairgamemerch.com (the “FGM Website”).

93. In or around May, 2025, Bank created content for the FGM Website (the “FGM Website Content”).

94. Bank, immediately upon being granted the relief requested herein, would cause the FGM Website Content to appear on the FGM Website (the “Post-Relief Website,” a copy of the home page of which is attached as Exhibit “B” hereto).

95. Bank, in causing the FGM Website Content to appear on the Post-Relief Website, would thereby, and simultaneously, commence doing business as “Fair Game Merch.”

96. The Post-Relief Website would offer the T-Shirts described in paragraph “91” herein (the “FGM T-Shirts”) for sale. *See* Exh. “B.”

97. Bank has taken all necessary preliminary steps to enable the Post-Relief Website to immediately operate upon being granted the relief requested herein, *i.e.*, to enable purchases, accept payments, and collect applicable sales taxes.

98. The images of the FGM T-Shirts that would appear on the Post-Relief Website, *see* Exh. “B,” are of the actual FGM T-Shirts as opposed to any non-physical, *e.g.*, digital, versions.

99. Bank, immediately upon being granted the relief requested herein, would draw attention to the Post-Relief Website by utilizing search-engine optimization and word of mouth.

100. The NFL would not be a Product Sponsor of the FGM T-Shirts.

IV. The Parties’ Dispute

101. On November 1, 2024, Bank sent a letter to the NFL that stated Bank’s view that the sale of unlicensed NFL Merchandise would not constitute trademark infringement or dilution under the Lanham Act, 15 U.S.C. §§ 1051 - 1141 (a copy of Bank’s letter is attached as Exhibit “C” hereto).

102. On November 18, 2024, Bank received a letter from NFLP that stated its view that sales of unlicensed NFL Merchandise would constitute trademark infringement and dilution, and expressly reserved the NFLP's rights to sue the seller of that merchandise for trademark infringement and dilution (a copy of NFLP's letter is attached as Exhibit "D" hereto).

103. If Bank were to operate as Fair Game Merch through the Post-Relief Website without having been granted the relief sought herein, NFLP would most likely learn of such operation as a result of NFLP's membership of the Coalition to Advance the Protection of Sports Logos ("CAPS"), in collaboration with which NFLP has established a program for discovering e-commerce stores that sell unlicensed NFL Merchandise.

104. If Bank were to operate as Fair Game Merch through the Post-Relief Website without having been granted the relief sought herein, NFLP would most likely sue Bank. *See* Exh. "D."

PRAYER FOR RELIEF

Plaintiff requests the following:

(a) Pursuant to 28 U.S.C. Section 2201(a), a Judgment declaring that Bank's selling of unlicensed NFL Merchandise would not violate any of the following: (i) 15 U.S.C. Section 1114(1)(a); (ii) 15 U.S.C. Section 1114(1)(b); (iii) 15 U.S.C. Section 1125(a)(1)(A); and (iv) 15 U.S.C. Section 1125(c); and

[continued on next page]

(b) Pursuant to 28 U.S.C. Section 2202, further necessary or proper relief, after reasonable notice and hearing, based upon all, or any part of, the Judgment described in the preceding paragraph.

Dated: May 12, 2025

Respectfully submitted,

s/ Todd C. Bank
TODD C. BANK,
ATTORNEY AT LAW, P.C.
119-40 Union Turnpike
Fourth Floor
Kew Gardens, New York 11415
(718) 520-7125

By Todd C. Bank

Counsel to Plaintiff

EXHIBIT “A”

The NFL Principal Symbols



EXHIBIT “B”

Home Page of Post-Relief Website

FAIR GAME MERCH

Welcome to Fair Game Merch!

Our merchandise is not approved by the NFL, any NFL Team, or anyone else for that matter except Fair Game Merch and, we hope, you!

Each t-shirt is unisex and size large, and has a printed black or white label (no annoying tags!) as follows:

FAIR GAME MERCH

RN 172290

60% Cotton
40% Polyester

Machine-wash cold.
When bleach is needed,
use only non-chlorine bleach.
Tumble-dry low.
If ironing the shirt, avoid the patch
(also: if ironing the shirt inside-out,
avoid the portion where the patch is).

Made in Nicaragua

L



NFL

\$18.00

[Add to Cart](#)



Arizona Cardinals

\$18.00

[Add to Cart](#)



Atlanta Falcons

\$18.00

[Add to Cart](#)



Baltimore Ravens

\$18.00

[Add to Cart](#)



Buffalo Bills

\$18.00

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Carolina Panthers

\$18.00

[Add to Cart](#)



Chicago Bears

\$18.00

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Cincinnati Bengals

\$18.00

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Cleveland Browns

\$18.00

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Dallas Cowboys

\$18.00

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Denver Broncos

\$18.00

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Detroit Lions

\$18.00

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Green Bay Packers

\$18.00

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Houston Texans

\$18.00

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Indianapolis Colts

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Jacksonville Jaguars

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Kansas City Chiefs

\$18.00

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Las Vegas Raiders

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Los Angeles Chargers

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Los Angeles Rams

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Miami Dolphins

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Minnesota Vikings

\$18.00

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New England Patriots

\$18.00

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New Orleans Saints

\$18.00

Add to Cart



New York Giants

\$18.00

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New York Jets

\$18.00

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Philadelphia Eagles

\$18.00

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Pittsburgh Steelers

\$18.00

Add to Cart



San Francisco 49ers

\$18.00

Add to Cart



Seattle Seahawks

\$18.00

Add to Cart



Tampa Bay Buccaneers

\$18.00

Add to Cart



Tennessee Titans

\$18.00

Add to Cart



Washington Commanders

\$18.00

Add to Cart

[Home](#)

[Terms](#)

[Privacy](#)

[Contact](#)

[Cart/Checkout](#)

EXHIBIT “C”

Letter from Todd C. Bank to National Football League

November 1, 2024

TODD C. BANK, ATTORNEY AT LAW, P.C.
119-40 Union Turnpike, Fourth Floor
Kew Gardens, New York 11415
Telephone (718) 520-7125
Facsimile (856) 997-9193

www.toddbanklaw.com

tbank@toddbanklaw.com

November 1, 2024

National Football League
345 Park Avenue
Fifth Floor
New York, New York 10154
Attn.: Jeffrey Pash

Via Federal Express

Re: John Doe

Dear Mr. Pash:

I represent a client to whom I will refer as John Doe. Mr. Doe wishes to sell unlicensed NFL merchandise, but, as he is aware that the NFL, acting through NFL Properties LLC (“NFLP”), seeks to prevent such sales, he would like to enter into an agreement with NFLP that would assure him of freedom from litigation.

By “NFL merchandise,” I mean: (i) merchandise with an NFL team’s color patterns and overall design except for an NFL, or NFL team’s, logo or insignia, *i.e.*, a trademark in the form of a trade dress (*see Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 599 U.S. 140, 145 (2023) (“[t]he Lanham Act [(15 U.S.C. §§ 1051 - 1141)], the core federal trademark statute, defines a *trademark* . . . [in] [15 U.S.C.] § 1127. The first part of that definition, identifying the kind of things covered, is broad: It *encompasses* words . . . , graphic designs . . . , and so-called *trade dress*, the overall appearance of a product and its packaging” (emphases added))); and (ii) merchandise, whether or not including such trade dress, that contains a trademark in the form of an NFL, or NFL team’s, logo or insignia, *i.e.*, a ‘customary’ trademark.

I will use the term “trademarks” (or “marks”) to refer to both customary trademarks and trade dress unless indicated otherwise, and will use the term “NFL Trademarks” (or “NFL Marks” or “Marks”) to refer to customary NFL and NFL-team trademarks and NFL and NFL-team trade dresses unless indicated otherwise. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992) (“the protection of [customary] trademarks and trade dress under [15 U.S.C. § 1125(a)] serves the same statutory purpose of preventing deception and unfair competition.”); *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.*, 696 F.3d 206, 216 (2d Cir. 2012) (“the same analysis used in claims of trade[-]dress infringement applies to claims of trademark infringement under [15 U.S.C. § 1114]” (cleaned up)); *Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc.*, 270 F.3d

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298, 308, n.2 (6th Cir. 2001) (“[t]rade[-]dress issues follow the same rules and laws as [customary-]trademark issues.”); *D’Pergo Custom Guitars, Inc. v. Sweetwater Sound, Inc.*, 111 F.4th 125, 133 (1st Cir. 2024) (“[t]rade dress is registrable as a trademark if it serves the same source-identifying function as a [customary] trademark,” quoting *In re Forney Indus., Inc.*, 955 F.3d 940, 945 (Fed. Cir. 2020)); *adidas America, Inc. v. Skechers USA, Inc.*, 890 F.3d 747, 755 (9th Cir. 2018) (“[l]ikelihood of confusion in the trade[-]dress context is evaluated by reference to the same factors used in the ordinary trademark context” (citation and quotation marks omitted)); *Savant Homes, Inc. v. Collins*, 809 F.3d 1133, 1147, n.12 (10th Cir. 2016) (“[t]rade dress ... serves the same function as trademark, and is treated the same way by the Lanham Act and the cases interpreting it,” quoting *Publications Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 338 (7th Cir. 1998)); *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 235, n.8 (5th Cir. 2010) (“[t]he same tests apply to both trademarks and trade dress to determine whether they are protectible and whether they have been infringed, regardless of whether they are registered or unregistered,” citing *Two Pesos*, 505 U.S. at 768-770 (additional citation and quotation marks omitted)).

Mr. Doe’s sale of unlicensed NFL merchandise would not constitute either trademark infringement or dilution. That is because NFL Trademarks in the merchandise context are ‘functional’ within the meaning of trademark law, and, “aspects of a product that are ‘functional’ generally ‘cannot serve as a trademark,’” *Christian Louboutin*, 696 F.3d at 218, quoting *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995); see also *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (“in construing the Lanham Act, we have been ‘careful to caution against misuse or over-extension’ of trademark and related protections into areas traditionally occupied by patent or copyright,” quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001)).

With respect to infringement specifically: “[e]ven after a mark is registered, it is a defense to infringement ‘[t]hat the mark is *functional*.’ [15 U.S.C.] § 1115(b)(8)[.] . . . Thus, even if copying would confuse consumers about a product’s source, competitors may copy unpatented *functional* designs,” *Ezaki Glico Kabushiki Kaisha v. Lotte Int’l America Corp.*, 986 F.3d 250, 256 (3d Cir. 2021) (emphases added); see also *Christian Louboutin*, 696 F.3d at 217 (“if a markholder has successfully demonstrated that its mark is valid and that the competitor’s mark is likely to cause confusion, the competitor can nevertheless prevail ... by showing that the [competitor’s] mark is *functional*—a traditional defense to the enforcement of a trademark” (emphasis added; citation and quotation marks omitted; cleaned up)).

With respect to dilution, see *Groeneveld Transport Efficiency, Inc. v. Lubecore Int’l, Inc.*, 730 F.3d 494, 519 (6th Cir. 2013) (“[the defendant’s] [product] design . . . is [not] *nonfunctional* . . . [.] which [is a] *requirement[] of a dilution claim* under [15 U.S.C. § 1125(c)]” (emphases added)); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998) (explaining, with respect to “trademark infringement and dilution,” *id.* at 37, that: “[f]unctionality, or, more precisely, . . . non-functionality . . . , is an essential component of the protection the law gives to trademarks and trade dress. . . . [N]on-functionality is essential because the doctrine [of functionality] prevents trademarks from limiting legitimate competition,” *id.* at 38); 15 U.S.C. § 1125(c)(4) (placing burden on

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markholder of an unregistered trade dress to show, in support of a dilution claim, that the trade dress is “not functional and is famous”).

Trademark dilution differs from trademark infringement in two respects: first, the mark at issue must be “famous,” 15 U.S.C. § 1125(c)(1), and, second, a likelihood of confusion is not required. *See id.* Regarding the fame requirement, “a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of *source* of the goods or services of the mark’s owner,” 15 U.S.C. § 1125(c)(2)(A) (emphases added); *see also Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 167 (4th Cir. 2012) (“dilution theory provides that ‘if customers or prospective customers *see the plaintiff’s famous mark used by other persons* in a non-confusing way to *identify other sources* for many different goods and services, then the ability of the famous mark to clearly identify and distinguish *only one source* might be “diluted” or weakened,” quoting Thomas McCarthy, 4 *McCarthy on Trademarks and Unfair Competition*, § 24:67 (4th ed.) (emphases added)).

In order for a markholder to be a ‘source’ of goods, *i.e.*, a ‘source’ of a product, he must *manufacture* a product that bears his trademark, or *authorize a third party to do so* such as through a license or other type of sponsorship. *See Jack Daniel’s, supra*, 599 U.S. at 156-157 (“[f]rom its definition of ‘trademark’ onward, the Lanham Act views marks as *source identifiers*—as things that function to ‘indicate the *source*’ of goods, and so to ‘distinguish’ them from ones ‘*manufactured or sold by others*,’” quoting 15 U.S.C. § 1127 (emphases added)); *Qualitex, supra*, 514 U.S. at 163-164 (“[i]n principle, trademark law, by preventing others from copying a *source-identifying mark*, . . . quickly and easily assures a potential customer that *this* [(emphasis in original)] item—the item with this mark—is *made by the same producer* as other similarly marked items” (emphases added)); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000):

Although [a product’s] words and packaging can serve subsidiary functions—a suggestive word mark (such as “Tide” for laundry detergent), for instance, may invoke positive connotations in the consumer’s mind, and a garish form of packaging (such as Tide’s squat, brightly decorated plastic bottles for its liquid laundry detergent) may attract an otherwise indifferent consumer’s attention on a crowded store shelf—their *predominant function* remains *source identification*. Consumers are therefore predisposed to regard those symbols as *indication of the producer*, which is why such symbols almost automatically *tell a customer that they refer to a brand, and immediately signal a brand or a product source*.

Id. at 212-213 (emphases added; citations and quotation marks omitted; cleaned up).

Regarding the type of source that the NFL is with respect to the merchandise that it licenses, *i.e.*, a ‘secondary source,’ the Federal Circuit Court of Appeals explained:

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At one time it was accepted law that a trademark’s *sole purpose* was to identify for consumers the product’s *physical source or origin*. Under this early ‘source theory’ of protection, trademark licensing was viewed as philosophically impossible. However, in the middle of the twentieth century, a trend develop[ed] *approving of trademark licensing*—so long as the licensor controlled the quality of the licensee’s products—on the theory that a trademark might also serve the function of identifying product quality for consumers. The quality theory *permits a trademark owner to license the mark* and allow licensees to buy supplies from anyone, provided the licensor maintains quality control over products reaching consumers under the mark.

Authentic Apparel Group, LLC v. United States, 989 F.3d 1008, 1016 (Fed. Cir. 2021) (emphases added; citation and quotation marks omitted). *See also Major League Baseball Players Ass’n v. Chisena*, Opp’n No. 91240180, 2023 WL 2986321, *18 (T.T.A.B. Apr. 12, 2023) (“[t]rademarks can serve to identify and distinguish a “secondary source” in the sense of indicating *sponsorship or authorization*. The “secondary source” is the *trademark owner and licensor* who has permitted the use of its mark on certain goods or services,” quoting J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition*, § 3:8 (5th ed.) (emphases added)); *id.* at *19 (“it has been held that trademarks can serve to identify and distinguish a “secondary source” in the sense of indicating sponsorship or authorization by a recognized entity. For example, the mark of a university on clothing *can signify that the university endorses and licenses the sale of such [] apparel by the manufacturer,*” quoting 3 *McCarthy on Trademarks and Unfair Competition*, § 24.03(4)(a) (3d ed.) (emphasis added; additional citation and quotation marks omitted)).

I will refer, collectively, to manufacturing and to the various types of authorizations as “Product Sponsorship,” and will refer to NFL merchandise of which the NFL, and/or an NFL team, is a Product Sponsor as “NFL-Sponsored,” and to the corresponding sponsorship as an “NFL Sponsorship.” Likewise, when I refer to the NFL in the Product Sponsorship context, such reference includes the NFL and the relevant team.

There is no doubt that some purchasers of NFL merchandise, and perhaps most, are aware that the NFL is a Product Sponsor of that merchandise. Therefore, it is reasonably possible that the NFL Marks are famous as source identifiers. However, regardless of the role of NFL Marks as source identifiers, whether famously for purposes of dilution, or generally for purposes of infringement, they nevertheless could be, and, in fact, are, functional.

The considerations that determine whether a trademark is functional depend upon the type of functionality at issue, *i.e.*, “traditional ‘utilitarian’ functionality or ‘aesthetic’ functionality,” *Christian Louboutin*, 696 F.3d at 217 (citation and quotation marks omitted). First, “a product feature is considered to be ‘functional’ in the *utilitarian* sense if it is (1) ‘*essential to the use or purpose of the article,*’ or if it (2) ‘*affects the cost or quality of the article*’[;] . . . [and, a] feature is

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essential if [it] is dictated by the functions to be performed by the article,” *id.* at 219, quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10 (1982) (emphases added; additional citations and quotation marks omitted) (the quotations from *Inwood Labs.* are also quoted in *TrafFix Devices*, 532 U.S. at 32, and *Qualitex*, 514 U.S. at 165); put simply: “utilitarian functionality . . . is based on how well the product works[.] . . . [It] relates to the performance of the product in its intended purpose.” *Blumenthal Distributing, Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 865 (9th Cir. 2020) (citation and quotation marks omitted).

Second, “aesthetic functionality . . . is based on how good the product looks. . . . [It] is based on intrinsic aesthetic appeal.” *Id.* (citation and quotation marks omitted). However, whereas a finding of utilitarian functionality precludes the “need to proceed further to consider if there is a *competitive necessity* for the [utilitarian] feature,” *TrafFix Devices*, 532 U.S. at 33 (emphasis added), *i.e.*, the need to consider if “the ‘exclusive use of . . . [the] functional feature . . . would put competitors at a *significant non-reputation-related disadvantage*,’” *id.* at 32, quoting *Qualitex*, 514 U.S. at 165 (emphasis added), “[i]t is proper to inquire into a ‘significant non-reputation-related disadvantage’ in cases of *[a]esthetic* functionality, the question involved in *Qualitex*,” *id.* (emphases added), as the “‘ultimate test of aesthetic functionality . . . is whether the recognition of trademark rights would *significantly hinder competition*.”” *Christian Louboutin*, 696 F.3d at 221, quoting *Qualitex*, 514 U.S. at 170, in turn quoting *Restatement (Third) of Unfair Competition*, § 17, Comment c, p.176 (1993) (emphasis added; additional quotation marks omitted).

As *Christian Louboutin* further explained, “when the aesthetic design of a product is *itself* [(emphasis in original)] the mark for which protection is sought, we may also deem the mark functional if giving the markholder the right to use it exclusively ‘would put competitors at a *significant non-reputation-related disadvantage*,’” *Christian Louboutin*, 696 F.3d at 219-220, quoting *Qualitex*, 514 U.S. at 165 (emphasis added); *see also id.* at 220 (“when evaluating design trademarks [(*i.e.*, ‘trademark[s] . . . [constituting] a particular visual design, often a logo,’ *Bechler v. MVP Group Int’l, Inc.*, No. 16-cv-8837, 2021 WL 848024, *6 (S.D.N.Y. Mar. 5, 2021) (footnote omitted))][,] we consider whether certain features of the design are *essential to effective competition in the particular market*” (emphasis added; citation and quotation marks omitted; cleaned up)); *id.* (“if the design feature is not ‘functional’ from a *traditional* perspective, it must still pass the fact-intensive *Qualitex* test and be shown *not to have a significant effect on competition in order to receive trademark protection*” (emphases added)); *id.* at 221 (“Lanham Act protection does not extend to configurations of *ornamental features*” (emphasis added), *i.e.*, features that “‘do[] not serve a [utilitarian] purpose’ in the design of a product,” *id.* at 214, n.4, quoting *TrafFix Devices*, 532 U.S. at 35, where such protection “would *significantly* [(emphasis in original)] limit the range of competitive designs available[;] [a]ccordingly, . . . the doctrine of aesthetic functionality bars protection of a mark that is *necessary to compete in the relevant market*” (emphasis added; citations and quotation marks omitted; cleaned up)); *id.* at 222 (“[i]n short, a mark is aesthetically functional, and therefore *ineligible for protection under the Lanham Act*, where protection of the mark *significantly undermines competitors’ ability to compete in the relevant market*” (emphases added)); *id.* (“[b]ecause aesthetic function and branding success can sometimes be difficult to distinguish, the aesthetic[-]functionality analysis is highly fact-specific. In conducting this inquiry, courts must

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consider both the markholder’s right to enjoy the benefits of its effort to distinguish its product and the public’s right to the vigorously competitive market protected by the Lanham Act, *which an overly broad trademark might hinder*” (emphasis added; citation and quotation marks omitted)); *id.* at 223-224 (“the functionality defense does not guarantee a competitor the *greatest range* for [his] creative outlet, but only *the ability to fairly compete within a given market*. It is a first principle of trademark law that an owner may not use the mark as a means of excluding competitors from a ... market” (emphases added; citation, quotation marks, and footnote omitted)).

In sum, a trademark or trademarked feature is aesthetically functional where: (i) it is aesthetically functional in the dictionary sense, *i.e.*, aesthetically appealing; *and* (ii) the inability of a competitor to utilize it would put the competitor at a significant non-reputation-related disadvantage.

The “reputation” in “non-reputation-related disadvantage” is not the reputation of a markholder *per se*, such as the reputation of an NFL team as a football team (*e.g.*, as a good team, a popular team, etc.). Instead, the “reputation” is of a markholder in the context of “*source identification*,” *Qualitex*, 514 U.S. at 165 (emphasis added) (made clear by the fact that the Court, immediately after using the phrase “significant non-reputation-related disadvantage,” *id.*, contrasted a product feature’s “play[ing] [of] an important role . . . in making a product more desirable” with the feature’s role in “source identification,” *id.*); that is, the “reputation” is that of a markholder as a *Product Sponsor*. See also *Jack Daniel’s*, *supra*, 599 U.S. at 146 (“the *producer* of a quality product may derive significant value from its marks. They ensure that the *producer* itself—and not some ‘imitating competitor’—will reap the financial rewards associated with the product’s *good reputation*,” quoting *Qualitex*, 514 U.S. at 164 (emphases added)); *TraFFix Devices*, 532 U.S. at 34 (“[f]ederal trademark law ‘has no necessary relation to invention or discovery,’ but rather, by preventing competitors from copying ‘a *source-identifying mark*,’ ‘reduce[s] the customer’s costs of shopping and making purchasing decisions,’ and ‘helps assure a *producer* that it (and not an imitating competitor) will reap the financial, *reputation-related* rewards associated with a desirable product,’” quoting *Qualitex*, 514 U.S. at 163–164 (emphases added)); *Matal v. Tam*, 582 U.S. 218, 225 (2017) (“[n]ational protection of trademarks is desirable . . . because trademarks foster competition and the maintenance of quality by securing to the *producer* the benefits of *good reputation*” (emphases added; citation and quotation marks omitted)); *Sulzer Mixpac AG v. A&N Trading Co.*, 988 F.3d 174, 191 (2d Cir. 2021) (“[t]he *functionality doctrine* prevents trademark law, which seeks to promote competition by protecting a firm’s *reputation*, from instead inhibiting legitimate competition by allowing a *producer* to control a useful product feature,” quoting *Qualitex*, 514 U.S. at 164 (emphases added)); *Bubble Genius LLC v. Smith*, 239 F. Supp. 3d 586, 597 (E.D.N.Y. 2017) (“protecting [the] plaintiff’s claimed trade dress would hinder competition for periodic[-]table[-]inspired novelty soaps; competitors in [the] market . . . for [such] soaps would be placed at a ‘*significant non-reputation-related disadvantage*’ if [the] plaintiff had *exclusive rights to produce and sell* [those] soaps,” quoting *TraFFix Devices*, 532 U.S. at 32 (emphases added)).

Under the principles recited above, Mr. Doe would be entitled to sell unlicensed NFL merchandise, regardless of a likelihood of confusion, if the NFL Trademarks are, with respect to NFL merchandise: (i) functional in the utilitarian sense; or (ii) aesthetically functional because (a) they are

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aesthetically appealing, and (b) their absence on Mr. Doe’s merchandise would put him at a significant disadvantage in the relevant market, *i.e.*, NFL fans, if that disadvantage were based on something other than his inability to represent his products as NFL-Sponsored.

In *NFL Properties LLC (“NFLP”) v. The Partnerships, et al.*, No. 1:21-cv-05522 (N.D. Ill.), a trademark-infringement-and-dilution case, the NFLP alleged:

Hundreds of millions of fans have attended NFL games and related events, enjoyed television and radio broadcasts of NFL games and related events, and purchased merchandise bearing NFL Trademarks *to identify with their favorite Member Clubs*. Millions visit <nflshop.com>, the official NFL Internet web store, as well as the official websites of the individual Member Clubs, which prominently display, and in many cases are accessed by domain names containing, NFL Trademarks.

NFLP Compl. (Dkt. No. 1, Oct. 18, 2021), ¶ 8 (emphasis added). The NFLP further alleged:

As a result of the extensive use of NFL Trademarks, not only in connection with the NFL’s well-known football games and related events, but also in connection with a wide variety of licensed merchandise promoted, sold and/or rendered in the United States and abroad, as well as widespread use in connection with a broad array of sponsorship activities spanning diverse industries, the NFL Trademarks have for many decades, and long prior to any use made by Defendants, functioned *as unique identifiers and synonyms in the public mind for NFLP, the NFL, and the Member Clubs*. As a result, NFL Trademarks are famous and possess significant goodwill of great value to NFLP, the NFL, and the Member Clubs.

Id., ¶ 12 (emphasis added).

Paragraph “8” states the primary reason why NFL fans buy NFL merchandise: “to identify with their favorite Member Clubs”; and, of course, this identification is not in the source-identification, *i.e.*, Product Sponsorship, sense, but, rather, in the sense of identification of an NFL team, or “Member Club,” *per se*, and, likewise, in the sense of identification of the NFL as a football league *per se*. It is primarily in *this* sense that NFL Marks “function[] as unique identifiers and synonyms in the public mind for . . . *the NFL[] and the Member Clubs*.” *Id.*, ¶ 12 (emphasis added). Thus, insofar as NFL Marks also “function[] as unique identifiers and synonyms” of “the NFL[] and the Member Clubs” as *Product Sponsors*, this functioning is secondary in terms of purchasers’ knowledge of that Product Sponsorship *and* in terms of the *importance* that purchasers ascribe to it (I omitted the paragraph “12” reference to the NFLP because I doubt that many purchasers are aware of it).

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The use of NFL Marks as *per se* identifiers on NFL merchandise is “dictated by the function[] to be performed by [that merchandise],” *Christian Louboutin*, 696 F.3d at 219 (citation and quotation marks omitted), *i.e.*, the *primary* function of that merchandise, which, again, is to enable fans “to identify with their favorite Member Clubs.” Therefore, the NFL Marks are “essential to the use or purpose of [that merchandise],” *id.* (citation and quotation marks omitted), and, as such, are functional in the utilitarian sense. The saliency of this type of functionality is emphasized by the fact that, regardless of what a fan thinks of the *aesthetic* appeal of his favorite team’s trademarks compared to the trademarks of other teams, he will have to choose merchandise containing the former in order “to identify with [his] favorite Member Club[].” Of course, the NFL Marks are not ‘utilitarian’ in the traditional sense of the word, *i.e.*, they do not bear on the physical capabilities or quality of the merchandise, such as by making an item more comfortable or durable than would the same item with a different color scheme or a non-NFL logo. However, the NFL Marks are utilitarian in a broader sense.

The NFL Marks are also aesthetically functional because, in order for an item of merchandise to enable a fan “to identify with [his] favorite Member Club[],” the aesthetics of the merchandise must be correct, *i.e.*, the item must *look* like it refers to “[his] favorite Member Club[]”; and, of course, that Member Club’s trademarks fulfill this requirement.

Some fans, of course, purchase NFL merchandise of *non*-favorite teams primarily because of the aesthetic appeal of that merchandise or because they have positive feelings for the team; and, of course, some do so for both reasons, although it would almost always be important to the ‘aesthetic appeal’ purchasers that the merchandise enables them to identify with a well-known football team, as opposed, for example, to a high-school team. There are also people who would not think of themselves as a fan of any team, or even of the NFL in general, but purchase NFL merchandise for the same reasons that ‘real’ fans do, with the difference being that, to the extent that such purchases are based on the identity of the team, the purchaser’s feelings would typically not be as strong as those of a ‘real’ fan; a New Yorker, for example, might buy Jet *and* Giant merchandise, but not many ‘real’ Jet and Giant fans would do so.

To the extent that purchasers desire that their NFL merchandise is NFL-Sponsored, that desire would almost always be in the context of preferring such merchandise to NFL Merchandise that is *not* NFL-Sponsored; but, it would remain that the *primary* reasons for purchasing NFL merchandise altogether are those discussed above. Thus, if all Jet merchandise lacked NFL Sponsorship, for example, very few Jet fans would, for that reason, decline to purchase that merchandise and instead purchase NFL-Sponsored Giant merchandise.

If NFL Marks are functional in the utilitarian sense, there would be “no need to proceed further to consider if there is a competitive necessity for the [use of those Marks].” *TrafFix Devices*, 532 U.S. at 33. However, if the NFL Marks are instead, *and only*, aesthetically functional, the question of competitive necessity would be presented, in which event it would be easily answered in the affirmative, because the inability of Mr. Doe to sell NFL merchandise would undoubtedly put him at a significant disadvantage in the relevant market, *i.e.*, NFL fans; and, this disadvantage, rather than

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being based on his inability to represent his products as NFL-Sponsored, would be based on his inability to reasonably compete for the business of NFL fans by enabling them to purchase NFL merchandise for the reasons that, as discussed above, underlie virtually all such purchases. Although one could, with sufficient creativity, sell merchandise that, without bearing any NFL Trademarks, would enable fans “to identify with their favorite Member Clubs,” such a seller would be conducting his business with a weight on his side of the scale of competition; that is, a weight that would be so heavy as to, at best, leave him marginally competitive if he were fortunate enough to survive in the first place.

In *Bd. of Supervisors v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008), in which the plaintiffs were several universities and their licensing agent, *see id.* at 471-472, the court maintained its “long-settled view rejecting recognition of aesthetic functionality,” *id.* at 488, explaining:

In *Boston [Professional] Hockey [Ass’n v. Dallas Cap & Emblem Mfg., Inc.]*, 510 F.2d 1004 (5th Cir. 1975) (“*Boston Hockey*”), we held that *emblems of a hockey team sold on embroidered patches* had no demonstrated value *other than their significance as the trademarks of the team*. Relying on our decision in *Boston Hockey*, the district court here similarly held that the [u]niversities’ color schemes, logos, and designs also had *no significance other than to identify with the [u]niversities* and were *therefore nonfunctional*. We agree. Fans and other members of the public purchase [the defendant]’s shirts *only because the shirts contain the plaintiffs’ colors and indicia identifying the [u]niversities’ football teams*, just as people purchased the defendant’s emblems in *Boston Hockey* only because they *contained the hockey team’s trademarks*. In other words, the presence of the plaintiffs’ marks *serve[s] no function unrelated to trademark*.

Id. at 486 (emphases added; footnotes omitted). The court further explained:

[The defendant] urges . . . that the [u]niversities’ colors on the t-shirts serve several functional purposes. It contends that the shirts allow groups of people to bond and show support for a philosophy or goal; facilitate the expression of loyalty to the school and a determination of the loyalties of others; and *identify the wearer as a fan and indicate the team the fan is supporting*. These claimed functional uses are *nothing more than the kind of aesthetic uses at issue in Boston Hockey*. Our circuit has *consistently rejected the concept of aesthetic functionality*.

Id. at 486-487 (emphases added; footnote omitted). According to *Boston Hockey*, “the embroidered symbols are sold *not because of any . . . aesthetic characteristic*,” *Boston Hockey*, 510 F.2d at 1013

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(emphases added), *i.e.*, not because of their “attractiveness and eye-appeal,” *id.* (citation and quotation marks omitted), “but because they are the *trademarks of the hockey teams*,” *id.*, whereas: “[t]hose cases which involved *utilitarian* articles . . . all involved products which had a consumer demand *regardless of their source or origin*. The principles involved in those cases are *not applicable to a trademark[-]symbol case where the design or symbol has no demonstrated value other than its significance as the trademark of a hockey team*.” *Id.* (emphases added).

Boston Hockey also explained that the teams that brought the case (*i.e.*, the Bruins and 12 other National Hockey League teams, *see id.* at 1008): “[had] *acquainted the public with their marks and thereby created a demand for those marks*. Through extensive use, [the] plaintiffs have acquired a *property right in their marks which extends to the reproduction and sale of those marks as embroidered patches for wearing apparel*. What [the] plaintiffs have acquired by use, the substantive law of trademarks as it is embodied in the Lanham Act will protect against infringement. There is *no overriding policy of free competition* which would remove [the] plaintiffs, under the facts of this case, from the protective ambits of the Lanham Act.” *Id.* at 1014 (emphases added).

In sum, the bases of the *Boston Hockey* line’s rejection of the doctrine of aesthetic functionality are: first, ascribing, to *association* with a markholder *per se*, the same significance as *source identification*, *i.e.*, identification of a markholder as a Product Sponsor, and thereupon finding that the use of a trademark to create such an association is a trademark-only, and hence, non-functional use; and, second, the notion that it is simply unfair of a markholder’s competitors to free-ride on the reputation of the markholder *per se* and the value that he has imparted to his mark.

Although the Fifth Circuit later backtracked from the property-right element of *Boston Hockey* by noting that “[o]ur cases . . . reject any notion that a trademark is an owner’s ‘property’ to be protected irrespective of its role in the operation of our markets,” *Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Co.*, 676 F.2d 1079, 1085 (5th Cir. 1982) (citation and quotation marks omitted), *Smack Apparel* has left, in place, the Fifth Circuit’s ‘association’ rationale and consequent rejection of the doctrine of aesthetic functionality. However, as set forth above, that the doctrine is well recognized by the Supreme Court and the Second Circuit Court of Appeals, the latter of which noted, in *Christian Louboutin*, that, “[d]espite its apparent counterintuitiveness (how can the purely aesthetic be deemed functional, one might ask?), our [c]ourt has long accepted the doctrine of aesthetic functionality,” *Christian Louboutin*, 696 F.3d at 220-221; *see also id.* at 221, n.17:

The doctrine of aesthetic functionality remains controversial in our sister circuits, which have applied the doctrine in varying ways (and some not at all). For example, the Seventh Circuit has applied the doctrine of aesthetic functionality liberally, holding that “[*f*]ashion is a form of function.” *See Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 860 (7th Cir.2010). The Sixth Circuit recently discussed the doctrine, but made clear that it has not yet decided whether or not to adopt it. *See Maker’s Mark Distillery, Inc. v. Diageo N. America*,

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Inc., 679 F.3d 410, 417-19 (6th Cir.2012). The Ninth Circuit has applied the doctrine inconsistently. *See* 1 McCarthy on Trademarks § 7:80 (4th ed.) (collecting cases). *The Fifth Circuit rejects the doctrine of aesthetic functionality entirely.* [] *Smack Apparel* [], 550 F.3d [at] 487-88 [] (arguing that the Supreme Court has recognized the aesthetic functionality doctrine only in *dicta*, and that therefore the Fifth Circuit’s long-standing rejection of the doctrine was not abrogated by *Qualitex*[], [*supra*][], and *TrafFix* [*Devices*]).

(emphases added). I agree that the *Qualitex* Court’s recognition of aesthetic functionality was *dicta*, as the type of functionality at issue was utilitarian, not aesthetic. First, the Court noted that, “it is important to use *some* color on [dry-cleaning-]press pads to avoid noticeable stains,” *Qualitex*, 514 U.S. at 166 (emphasis in original), which is a utilitarian function.

Second, *Qualitex*, in using the phrase “significant non-reputation-related disadvantage,” did so in the context of addressing utilitarian functionality. *See id.* at 165 (“[t]his Court consequently has explained that, ‘[i]n general terms, a product feature is functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,’ that is, if exclusive use of the feature would put competitors at a *significant non-reputation-related disadvantage*,” quoting *Inwood Labs.*, *supra*, 456 U.S. at 850, n.10 (emphasis added)) (nevertheless, as discussed at p.5, *supra*, *TrafFix Devices* held, in effect, that the existence of a significant non-reputation-related disadvantage is an irrebutable presumption in the utilitarian-functionality context). In any event, *TrafFix Devices* did not view the *Qualitex* Court’s discussion of aesthetic functionality as *dicta*, and neither has the Second Circuit. Moreover, that doctrine is merited in its own right, as both utilitarian and aesthetic features contribute to the benefits of a product, and there is no reason why competition should be promoted only with respect to the former.

In *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062 (9th Cir. 2006), the court observed that, “[t]aken to its limits, . . . [the] doctrine [of aesthetic functionality] would permit a competitor to trade on any mark simply because there is *some* ‘aesthetic’ value to the mark that consumers desire,” *id.* at 1064 (emphasis added), and noted that, in *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769 (9th Cir. 1981), the court had “emphatically rejected the notion that ‘any feature of a product which contributes to the consumer appeal and saleability of the product is, *as a matter of law*, a functional element of that product,’” *Au-Tomotive Gold*, 457 F.3d at 1069, quoting *Vuitton*, 644 F.2d at 773 (emphasis added), such that, “‘a trademark which identifies the source of goods and *incidentally serv[es] another function* may still be entitled to protection.”” *Id.*, quoting *Vuitton*, 644 F.2d at 775 (emphasis added). The NFL Trademarks, of course, do not merely have *some*, or *incidental*, non-source-identifying functionality (whether utilitarian or aesthetic); rather, the NFL Marks are *central* to such functionality, *i.e.*, to fans’ ability “to identify with their favorite Member Clubs.”

Au-Tomotive Gold also explained that, “the *mere fact* that the mark is the ‘*benefit* that the consumer wishes to purchase’ will not override trademark protection if the mark is source-

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identifying,” *Au-Tomotive Gold*, 457 F.3d at 1069, quoting *Vuitton*, 644 F.2d at 774 (emphases added); but, as made clear in *Vuitton*, which concerned aesthetic functionality, *see Vuitton*, 644 F.2d at 771, 774-775, the “benefit” was not *Boston Hockey* ‘association,’ but, rather, genuine source identification. That is, *Vuitton* explained that, “[f]unctional features of a product are features which constitute the *actual benefit* that the consumer wishes to purchase, *as distinguished from* an assurance that *a particular entity made, sponsored, or endorsed* a product,” *Vuitton*, 644 F.2d at 774 (emphases added; citation and quotation marks omitted); *see also id.* at 776 (“[i]f the Vuitton mark increases consumer appeal only because of the *quality associated with Vuitton goods*, or because of the prestige associated with owning a *genuine Vuitton product*, then the design is serving the legitimate function of a trademark; it is *identifying the source of the product*, and thus should be protected. [¶] [T]he only *legally relevant* function of a trademark is to *impart information as to the source or sponsorship of the product*” (emphases added)); *id.* (noting, with approval, the Ninth Circuit’s rejection of the Fifth Circuit’s ‘association’ rationale, *i.e.*, rejection of the rationale that “protection should also be extended to [a] trademark’s commercially more important function of embodying consumer good will created through extensive, skillful, and costly advertising,” *id.* (citation and quotation marks omitted), such rejection having been explained by the Ninth Circuit’s observation that “[t]he courts ... have generally confined legal protection to the trademark’s source[-]identification function for reasons grounded in public policy favoring a free, competitive economy.” *Id.* (citation and quotation marks omitted)).

Although *Au-Tomotive Gold* stated that, “[w]ith *Vuitton*, [the doctrine of] aesthetic functionality was dealt a limiting but not fatal blow[,] [as] the case was remanded for trial,” *Au-Tomotive Gold*, 457 F.3d at 1069, citing *Vuitton*, 644 F.2d at 776, *Vuitton*, as shown above, addressed that doctrine in accordance with traditional trademark principles.

Au-Tomotive Gold also found that, “[e]xtending the functionality doctrine, which aims to protect ‘useful’ product features, to *encompass unique logos and insignia* is not an easy transition,” *Au-Tomotive Gold*, 457 F.3d at 1067 (emphasis added), explaining: “[f]amous trademarks have assumed an exalted status of their own in today’s consumer culture that cannot neatly be reduced to the historic function of trademark to designate source. Consumers sometimes buy products bearing marks such as the Nike Swoosh, the Playboy bunny ears, the Mercedes tri-point star, the Ferrari stallion, and countless *sports franchise logos*, for the *appeal of the mark itself, without regard to whether it signifies the origin or sponsorship of the product*.” *Id.* (emphases added). The essential purpose of a trademark, of course, is to “signif[y] the origin or sponsorship of the product,” *i.e.*, to signify Product Sponsorship; and, as set forth above, the extent to which a mark serves a purpose (whether utilitarian or aesthetic) “without regard to whether it signifies” Product Sponsorship is the extent to which it is functional (provided that, in the case of aesthetic functionality, the competition element is satisfied). The typical purchase of apparel that, per the court’s examples, bears a Playboy, Mercedes, or Ferrari emblem is surely made in order for the purchaser to express his positive feelings about the product (or service) that the emblem represents, as is the case (and, if anything, more strongly so) with respect to merchandise that bears an NFL Mark. By contrast, the Nike Swoosh, per the court’s example, might be aesthetically appealing without regard to the fact that the product bearing it was made by Nike, but it remains that, *primarily*, the Swoosh is viewed with respect to the

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latter.

Au-Tomotive Gold further found that, “[i]n practice, aesthetic functionality has been limited to product features that serve an aesthetic purpose *wholly independent of any source-identifying function*,” *Au-Tomotive Gold*, 457 F.3d at 1073 (emphasis added), citing: *Qualitex*, 514 U.S. at 166, as finding that “coloring dry cleaning pads served [a] nontrademark purpose by avoiding visible stains,” *id.*; *Publications Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 342 (7th Cir. 1998), as finding that “coloring edges of cookbook pages served [a] nontrademark purpose by avoiding color ‘bleeding’ between pages”), *id.*; *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532 (Fed. Cir. 1994), as finding that “[the] color black served [a] nontrademark purpose by reducing the apparent size of [an] outboard boat engine,” *id.*; and, *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952), as finding that “[the] china patterns at issue were attractive and served [a] nontrademark purpose because ‘one of the essential selling features of hotel china, if, indeed, not the primary, is the design.’” *Id.* *Au-Tomotive Gold* was therefore expressing agreement with the ‘association’ rationale of *Boston Hockey*, which *Au-Tomotive Gold* described as “holding that reproductions of [a] professional hockey franchise’s logo sold alone are not ‘functional’ and can be protected.” *Id.* at 1068.

The court further expressed its agreement with the ‘association’ rationale, explaining:

It is difficult to extrapolate from cases involving a *true aesthetically functional feature*, like a box shape or certain uses of color, to cases involving well-known registered logos and company names, which generally have *no function apart from their association with the trademark holder*. The present case illustrates the point well, as the use of [the plaintiffs]’ marks [on key chains and license-plate covers, *see id.* at 1064] is *neither aesthetic nor independent of source identification*. That is to say, there is no evidence that consumers buy Auto Gold’s products solely *because of their “intrinsic” aesthetic appeal*. Instead, the alleged aesthetic function is *indistinguishable from and tied to the mark’s source-identifying nature*.

By Auto Gold’s strident admission, consumers want “*Audi*” and “*Volkswagen*” accessories, not *beautiful* accessories. This consumer demand is *difficult to quarantine from the source[-]identification and reputation-enhancing value of the trademarks themselves*. . . . The demand for Auto Gold’s products is *inextricably tied to the trademarks themselves*. . . . Any disadvantage Auto Gold claims in not being able to sell Volkswagen or Audi marked goods is *tied to the reputation and association with Volkswagen and Audi*.

Id. at 1073-1074 (emphases added). The court concluded that, “Volkswagen and Audi’s trademarks undoubtedly increase the marketability of Auto Gold’s products[,] [b]ut their entire significance lies

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in the demand for goods bearing those non-functional marks.” *Id.* at 1074 (citation and quotation marks omitted).

In *LTTB LLC v. Redbubble, Inc.*, 840 F. Appx. 148 (9th Cir. 2021), the court distinguished *Au-Tomotive Gold* and perhaps suggested a retreat from the latter’s ‘association’ rationale. As to the distinguishing, *LTTB* stated:

In *Au-Tomotive Gold*, where the defendant admitted that consumers wanted the goods because they identified the sources (Volkswagen and Audi), “the alleged aesthetic function [was] indistinguishable from and tied to the mark’s *source-identifying nature*.” *Au-Tomotive Gold*, 457 F.3d at 1074. *By contrast*, there is no evidence here that consumers buy LTTB’s goods *because they identify LTTB as the source*, rather than because of the aesthetic function of the phrase, “LETTUCE TURNIP THE BEET.” . . .

Although LTTB’s evidence may indicate that its goods are popular, it does not indicate that consumers buy the goods *because the marks identify LTTB as the source of the goods*. In *Vuitton*, the plaintiff presented an *affidavit* by a buyer of goods for a department store stating that it was unlikely “there is anyone who would purchase a Vuitton product solely because they found the characteristic Vuitton trademark to be *aesthetically pleasing*,” but instead “it is *because the design associates the products with Vuitton*.” *Vuitton*, 644 F.2d at 776.

Id. at 150, 151 (emphases added). In *Vuitton*, the reference to the affidavit was made in the context of the court’s discussion of genuine source identification. *See Vuitton*, 644 F.2d at 776. Accordingly, it appears that *LTTB* was likewise referring to genuine source identification rather than to *Boston Hockey* ‘association.’ To be sure, this is not perfectly clear, as the court also quoted from *Au-Tomotive Gold*’s embrace of the ‘association’ rationale. *See LTTB*, 840 F. Appx. at 151 (“LTTB has presented no evidence to avoid the conclusion that the marks here ‘*serve an aesthetic purpose wholly independent of any source-identifying function*’ and thus are aesthetically functional,” quoting *Au-Tomotive Gold*, 457 F.3d at 1073 (emphasis added)).

In *Plasticolor Molded Products v. Ford Motor Co.*, 713 F. Supp. 1329 (C.D. Calif. 1989), *vacated by consent judgment*, 767 F. Supp. 1036 (C.D. Calif. 1991), the court observed that, “[o]nly relatively recently have trademarks begun to leap out of their role as *source-identifiers* and, in certain instances, have effectively become *goods in their own right*,” *id.* at 1332 (emphases added), and explained, by way of an example that concerns the ‘association’ rationale, that, “[w]hen sports fans wear jackets *bearing the names of their favorite teams* . . . , they are using registered trademarks and service marks, but *not to identify the source of the product*.” *Id.* at 1332-1333 (emphases added) (*N.B.*: “[a] service mark is a trademark that is used in connection with services,” *Restatement (Third)*

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of *Unfair Competition*, § 9 (Am. Law Inst. 1993); *see also* 15 U.S.C. § 1127 (defining “trademark” and “service mark”)); *Patsy’s Italian Restaurant, Inc. v. Banas*, 658 F.3d 254, 259, n.1 (2d Cir. 2011) (“trademarks and service marks are generally protected by the same standards,” citing 15 U.S.C. § 1053); *Savannah College of Art and Design, Inc. v. Sportswear, Inc.*, 872 F.3d 1256, 1261, n.3 (11th Cir. 2017) (“[s]ervice marks and trademarks are governed by identical standards” (citations and quotation marks omitted))).

With respect to the “leap[ing] out of [trademarks’] role as source-identifiers and . . . effectively becom[ing] goods in their own right,” *Plasticolor*, 713 F. Supp. at 1332, the court further observed: “[t]he wearer of a baseball jacket reading New York Mets does not care whether the New York Mets *manufactured* the jacket, or *authorized its production*, or are *in any way associated with it*. He wears it *to announce his allegiance* [(i.e., ‘to identify with [his] favorite Member Club[]’)]. New York Mets may well be a service mark, but in this context *it has become a product as well*; it is a *functional component of the jacket as surely as the material from which the jacket is made*.” *Id.* at 1333 (emphases added; footnote omitted). Accordingly, “[a] small but growing number of cases has recognized this change, and has found no difficulty in applying the source-identifying/functional distinction where trademarks or service marks serve purely as functional features.” *Id.* (citing cases). Furthermore, the court noted: “[t]hese cases have presented no difficulty for the traditional categories of trademark law because, *as in the New York Mets hypothetical*, it has been clear that the ordinary purchaser has *treated the marks as functional items, not as source-identifiers*. This is because the mark and the product have represented radically different industries.” *Id.* (emphases added). As for NFL Marks, they primarily represent the NFL and its teams *per se*, whereas NFL merchandise represents the industry to which it belongs, such as the apparel industry. The court further observed that, “reasonable purchasers could not believe *or care* that the mark holder would be competing in the same market as the product manufacturer,” *id.* (emphasis added), “the same market” being, with respect to the NFL, the market of which given NFL merchandise is a part, such as the apparel market. By contrast, “[w]here the mark and the product come from the same or similar industries, however, the distinction between the categories blurs, because a mark can serve simultaneously as a source-identifier and a functional element,” *id.*, as might have been the case, for example, if the United States Football League had had a team that used NFL Trademarks.

Given the NFL’s history of licensing NFL Marks to merchandise manufacturers, those Marks, with respect to NFL merchandise, *do*, to some, and perhaps most, NFL fans, “serve simultaneously as a source-identifier and a functional element,” such that those fans “could easily interpret the [M]arks both ways simultaneously,” *id.* at 1335 (as discussed at pp.4, 7-8, *supra*), even though the NFL and its licensees do not “come from the same or similar industries.” *Id.* at 1333. This dual, or mixed, use of NFL Marks raises “three alternatives,” *id.* at 1337: “[f]irst, . . . that the source-identifying aspects of the feature trump the functional aspects, and simply [are governed by] the standard law of trademark infringement[;] [s]econd, . . . the opposite, [i.e.,] that the feature is unprotected from copying[;] [and] [t]hird, . . . an appropriate middle ground.” *Id.* The first alternative was “adopted in a case very similar to [*Plasticolor*].” *Id.* That is, “in *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F.Supp. 651 (W.D.Wash.1982), the defendant, without authorization from the plaintiff, manufactured *replicas of professional football*

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jerseys,” id. (emphasis added), and: “[t]he court found that the jerseys’ design, colors and use of team names *created a likelihood of confusion as to sponsorship*. The court then discussed, without deciding, whether the jersey attributes were functional features, and concluded: ‘*Even assuming the marks are functional*, this assumption does not, however, preclude trademark protection. A functional feature *may additionally serve as a trademark and be protected as such.*’” *Id.*, quoting *Wichita Falls*, 532 F. Supp. at 662 (emphases added; additional citation omitted; cleaned up). However, the *Plasticolor* court disagreed with this rationale:

We are unable to adopt this reasoning. Affording the same degree of protection against *mixed-use* copying as against *purely source-identifying* copying has the effect of *protecting functional features*, a result *clearly contrary to established trademark law*. If we apply straightforward trademark law, we would enjoin the production of articles likely to cause public confusion as to source or sponsorship both at and after the point of sale. Confusion *after* the point of sale, however, is *inherent in a partial functional use*: A mixed-use article that eliminates the likelihood of confusion after the point of sale also defeats much of the feature’s functionality. Consider some examples: *A football jersey bearing the words “Seattle Seahawks (Not Affiliated with the Seattle Seahawks)”*; *a shoulder patch reading “Boston Bruins (Not Sponsored by the Boston Professional Hockey Association)”*; *a floor mat reading “Ford (Not Manufactured by Ford Motor Company).”* These disclaimers *would probably end confusion as to source*, but would also *effectively negate the functional aspects of the marks*. Treating *mixed uses* exactly like *source-identifying uses* would thus protect *functional features* [from being copied], a result *contrary to established principles of trademark law*. See p. 1336 *supra*. *The reasoning of [Wichita Falls] flies in the face of this authority.*

Id. (emphases added; footnote omitted).

Plasticolor also rejected the second of the three alternatives quoted above, explaining: “[the] treat[ment] [of] *mixed uses* as *entirely functional uses*, and accordingly [the] withhold[ing] [of] all protection[,] . . . has been implicitly adopted in the Third and Sixth Circuits. [citing cases] Again, we decline to follow, this time because to do so would contravene the clear language of the Lanham Act.” *Id.* at 1338, citing 15 U.S.C. § 1114(1) (emphasis added). Upon noting that “[t]he Ninth Circuit has twice posited the existence of the situation we confront today, and has twice suggested that there may be a middle ground between pure functionality and pure source-identification,” *id.*, thus “indicating that mixed uses are entitled to some protection . . . [without] suggest[ing] that mixed uses are to be afforded full trademark protection,” *id.* at 1339, the court found that the appropriate resolution regarding mixed-use trademarks was the third alternative, *i.e.*, “a solution that permits trademarks to be copied as functional features, but minimizes the likelihood that the public will

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associate the copied mark with the [markholder].” *Id.*

As to “the point of sale,” *id.*, the court found that “[t]here need be no conflict . . . , [because] [t]he functional use of a trademark does not preclude a clear indication at the point of sale (in the form of a label, packaging, or other identification easily removed or concealed by the consumer) that the product is not manufactured or sponsored by the [markholder],” *id.*, but: “after the point of sale[,] the likelihood[-]of[-]confusion standard must be tempered . . . [because] requiring the manufacturer to eliminate the likelihood of confusion past the point of sale will, in most cases, entirely eliminate the possibility that the mark could serve a functional purpose. A floor mat whose upper surface reads ‘FORD (not authorized by Ford Motor Company)’ would obviously attract few customers.” *Id.* Thus, the court found that, “[p]rotecting functional copying of trademarks will therefore require that we tolerate at least some confusion as to source or sponsorship after the point of sale. . . . [,] [although] [t]he possibility of post-sale confusion can be eliminated entirely if the [markholder] is able to embody its trademark in a copyrighted logo.” *Id.* & n.17. The court further explained:

The potential for confusion can be diminished, however, by requiring that the manufacturer of a product that employs a trademark for functional purposes take all reasonable steps to eliminate post-sale confusion consistent with the functional use of the mark. The manufacturer will, for example, often be able to place a disclaimer on a portion of the article not generally visible while the article is in use. A notice of non-authorization on the underside of a [car’s] floor mat, or a *disclaimer affixed to the inside of a football jersey*, will not hinder the functional use of a trademark, but may somewhat reduce the likelihood of post-sale confusion. In other cases, the copier may be able to *place its own name alongside the copied trademark without interfering with the mark’s functionality*. There may also be cases where a visible disclaimer will not detract from the functional purpose of the trademark. Whatever the method chosen, it must be *the most effective reasonably available that does not materially interfere with the trademark’s functional purpose*.

Id. (emphases added). Regardless of whatever appeal this rationale might have, it is now settled that one who copies functional features is not required take affirmative measures to avoid the likelihood of confusion. See p.2, *supra* (quotations from *Ezaki Glico Kabushiki Kaisha, supra*, and *Christian Louboutin, supra*). The same was clearly implied in *TrafFix Devices, supra*, which happened to concern a utilitarian product feature, *i.e.*, “[a] dual-spring design[] to keep . . . [t]emporary road signs . . . upright despite adverse wind conditions,” *TrafFix Devices*, 532 U.S. at 25, “the dual-spring design [being] the essential feature of the [plaintiff’s] trade dress,” which comprised “[a] sign stand[] incorporating . . . [that] design.” *Id.* The Sixth Circuit Court of Appeals, which *TrafFix Devices* reversed, had required the defendant to “avoid emulating the trade dress,” *Marketing Displays, Inc. v. TrafFix Devices, Inc.*, 200 F.3d 929, 940 (6th Cir. 1999), such as by using “a *hidden* dual-spring mechanism or a *tri*[-] or *quad*-spring mechanism,” *id.* (emphases added), in order “to set

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its [sign stand] apart to avoid infringing [on] the . . . trade dress,” *id.* at 940 (emphases added), as, otherwise, the defendant’s sign stand “could confuse the public.” *Id.*

On appeal, the Supreme Court ruled that, “[b]ecause the dual-spring design is functional, it is unnecessary for competitors to explore designs to hide the springs, say, by using a box or framework to cover them, as suggested by the Court of Appeals.” *TrafFix Devices*, 532 U.S. at 34. The Court then explained: “[t]he dual-spring design assures the user [that] the device will work. If buyers are assured [that] the product serves its purpose by seeing the operative mechanism[,] that in itself serves an important market need. It would be at cross-purposes to those objectives, and something of a paradox, were we to require the manufacturer to conceal the very item [that] the user seeks.” *Id.* The Court, given its review, and rejection, of the Sixth Circuit’s reasoning, surely recognized that the defendant, by copying the plaintiff’s dual-spring design and making it publicly visible, “could confuse the public,” *TrafFix Devices, Inc.*, 200 F.3d at 940; indeed, the Court had also noted that, “the dual-spring design . . . inform[s] consumers that the sign stands are *made by [the plaintiff]* [,] [but is also] *[f]unctional[.]*” *TrafFix Devices*, 532 U.S. at 33 (emphases added). The Court further made clear that a likelihood of confusion was tolerable, by noting that, “[t]he Lanham Act . . . does not protect trade dress in a functional design simply because an investment has been made to encourage the public to *associate a particular functional feature with a single manufacturer or seller.*” *Id.* at 34-35 (emphasis added).

The toleration of a likelihood of confusion in the utilitarian-functionality context is clearly applicable in the aesthetic-functionality context as well, as nothing about the differences between these two types of functionality would call for such toleration in the one context but the avoidance of it in the other. Of course, no competitor may go beyond copying functional features in order to pass off his product as that of another, such as if the defendant in *TrafFix Devices* were to have affixed the plaintiff’s customary trademark to the defendant’s sign stands, or if Mr. Doe were to represent, on a label, that his merchandise is NFL-Sponsored.

In *Pennsylvania State University v. Vintage Brand, LLC*, 614 F. Supp. 3d 101 (M.D. Pa. 2022) (“*Penn State I*”), the court addressed the question that *Boston Hockey*, in effect, answered in the affirmative: “[u]nder the Lanham Act, does a symbol *identify the source of the goods* if it *merely creates an association between it and the trademark holder*?” *Id.* at 103 (emphases added). *See also id.* at 106, 107 (“should trademark holders—particularly those in the business of education, research, and New Year’s Six [football bowl games]—have an exclusive right to control merchandise bearing their marks[,] [¶] [where] *the mark itself is the product*[,] [¶] [and] when consumers are purchasing the products *not for their guaranteed quality*, but to *signal their support for or affiliation with the trademark holder*?” (emphases added)). The court initially noted:

Entities’ efforts to control the use of their marks on merchandise beginning in the 1970s represented yet another attempt to expand the protections provided to sellers under the law. For universities, this trademark use diverged from traditional areas of trademark protection, such as Penn State preventing an unaffiliated

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educational institution from using its name. In this hypothetical, a consumer might reasonably believe that they are enrolling in a Penn State affiliate. But university-trademarked apparel and merchandise present a different case; *the mark itself is the product*.

From the outset[,] views diverged on whether, given this *overriding non-trademark function*, the marks still identified the entity as *the source or sponsor of the goods*. Some, notably . . . *Boston [Hockey]* and the [United States Patent and Trademark Office’s] Trademark Trial and Appeals Board in *In re Olin Corp.*, [181 U.S.P.Q. 182, 1973 WL 19761 (T.T.A.B. 1973)][,], found that the marks inherently do. The Fifth Circuit drew this conclusion from the fact that consumers only purchase the merchandise because of the *mental association it creates between the trademark and trademark holder*. The question as [*Boston Hockey*] saw it was answered by sole reference to *whichever party’s toil generated the sale, with no need to undertake a fact-intensive inquiry into whether consumers believed the trademark holder had manufactured or sponsored the product*. The Trademark Trial and Appeals Board, on the other hand, reasoned from the negative. It found that a mark—like that of New York University’s—“inherently.... advise[s] the purchaser [that] the university is the secondary source of that shirt” because “[i]t is not imaginable that Columbia University will be the source of an N.Y.U. T-Shirt.” This per se approach (as I’ll call it) is forwarded by Penn State here; and, if adopted, it would entitle the University to its motion to dismiss as there can be no doubt that Vintage Brand’s customers are buying its Penn State products *because of the associations they create with the University*.

Id. at 107-108 (emphases added; footnotes omitted). The court added, however: “*still more have rejected* this per se approach—even if they ultimately found that a bona fide mark had been infringed. Instead, as these courts have emphasized, trademark law requires *more than a mental association between the trademark and trademark holder*. As they see it, the consumer *must instead believe that the trademark indicates that the trademark holder is the source, sponsor, or is otherwise affiliated with the good—a question of fact*,” *id.* at 108 (emphases added; footnote omitted), although “many courts have still not squarely addressed the question. And that list includes the Supreme Court and the United States Court of Appeals for the Third Circuit.” *Id.*

Penn State I then addressed “*Champion Products v. University of Pittsburgh*[,] [which] migrated back and forth between the Western District of Pennsylvania and the Third Circuit.” *Id.* First: “the district court . . . reject[ed] the *Boston Hockey* approach. It found that there was no likelihood of confusion as to the good’s source, origin, authorization, or sponsorship; that the marks served the *solely functional purpose of ‘allow[ing] the consumer to show his [] allegiance to Pitt’*;

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and[,] finally[,] that apparel with Pitt’s mark did not *primarily* serve a *secondary purpose of ‘identify[ing] the source of the product rather than the product itself.’* [*Inwood Labs.*, 456 U.S. at 851, n.11][.]” *Id.* at 110-111, quoting *University of Pittsburgh v. Champion Prods. Inc.*, 566 F. Supp. 711, 721 (W.D. Pa. 1983), *order vacated* (3d Cir. Feb. 2, 1984) (due to “a consent decree that was included in the parties’ settlement agreement,” *id.* at 111 (emphases added; footnote omitted)).

Penn State I also criticized the reasoning of the Trademark Trial and Appeals Board:

I find the analysis offered by the Trademark Trial and Appeals Board in its eligibility cases unconvincing. In the university context, these revolve around *In re Olin Corp.*[.] [181 U.S.P.Q. 182, 1973 WL 19761 (T.T.A.B. 1973)][.] There, in explaining why a New York University-branded shirt would identify the university as the sponsor or authorizer, the Board reasoned, “[i]t is not imaginable that Columbia University will be the source of an N.Y.U. T-shirt.” [*In re Olin Corp.*, 1973 WL 19761 at *1] But this play on an intercollegiate rivalry distracts from an error in reasoning: *you cannot determine whether consumers believe an entity is the source or secondary source of a good by crossing out one entity that consumers obviously believe is not.* The conclusion that purchasers will think that N.Y.U. sponsored or authorized the shirt *does not necessarily follow from the statement that no purchaser will think that Columbia University is the source.* There’s a gulf of other possibilities.

Penn State I, 614 F. Supp. 3d at 111 (emphases added). Likewise, the fact that one would not expect the Cowboys (or Major League Baseball) to sponsor Steeler merchandise does not leave the Steelers, or the NFL, as the only conceivable sponsors of that merchandise; in the same vein, it would be unlikely for Candidate Smith, or his political party, to be the source of an advertisement supporting his opponent, Candidate Jones, but there could, of course, be various sources for such an advertisement other than Candidate Jones or his political party. Accordingly: “[t]he [c]ourt . . . [saw] no reason to perpetuate or resuscitate this per se approach. Whether consumers believe that a university is the source, sponsor, or authorizer of merchandise bearing its marks should—minimally—turn on just that: what the consumers believe. And for that reason, Penn State’s motion to dismiss [¶] Vintage Brand’s counterclaim, [which] contends that three of the University’s marks should be canceled because they are ornamental and fail to function as trademarks[,] [¶] is denied.” *Id.* at 103, 111-112.

Finally, *Penn State I* reasoned: “[t]he circularity is apparent: the law only offers protection if there’s belief [that a] product can bear the name of an entertainer, cartoon character, or some other famous person [only if] permission is given for its use , yet the belief comes from consumers’ (mis)conception about the law. It would seem perverse to award market exclusivity based on a *fake-it-until-you-make-it approach*. If consumers’ confusion stems from their *incorrect belief* that goods bearing Penn State’s emblem *must be licensed*, shouldn’t that belief be corrected, not

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perpetuated?” *Id.* at 114 (emphases added).

As did *Plasticolor* with respect to that court’s New York Mets example, *University of Pittsburgh, supra*, found that, “[t]he Pitt insignia, as used by Champion [to be] prominently emblazoned on soft goods, are functional,” *Univ. of Pitt.*, 566 F. Supp. at 716, because: “[t]hese insignia perform the function of *allowing the wearer to express identity, affiliation, or allegiance to Pitt*[;] [t]his functional feature is an *essential feature* of the product[;] [and][,] [t]he product *could not perform this function unless it bore the Pitt insignia*.” *Id.* (emphases added). Accordingly, the court found that, “[t]he Pitt insignia prominently emblazoned on the Champion Pitt-insignia soft goods is *therefore essential to the use or purpose of the articles*,” *id.* (emphasis added), and added: “‘with negligible exception, a consumer does not desire a “Champion” T-shirt, he . . . desires a “Pitt” T-shirt. The entire impetus for the sale is the consumer’s desire to *identify with Pitt* or, perhaps more realistically, *with Pitt’s athletic programs*.’” *Id.*, quoting *University of Pittsburgh v. Champion Products Inc.*, 686 F.2d 1040, 1047 (3d Cir. 1982) (emphases added). Just as *Univ. of Pitt.* found that the Pitt insignia was functional under the criteria that determine utilitarian functionality (although, to be sure, the doctrine of aesthetic functionality had not yet been developed), the NFL Trademarks on NFL merchandise are functional in the utilitarian sense (as discussed at p.8, *supra*).

Univ. of Pitt. also expressed its disagreement with, the ‘association’ rationale of *Boston Hockey*:

We have considerable sympathy for the . . . University of Pittsburgh. The notion that a university’s name and insignia are its own property, to do with as it chooses, has *a certain common-sense appeal*. An examination of the law and the facts in this case has convinced us, however, that neither Congress, nor the Pennsylvania Legislature, nor the common law has created the property right that Pitt asserts here. We believe that were we to rule in favor of Pitt, we would be creating a *new substantive right in an area of the law in which Congress and the states have legislated extensively*. The relief sought by Pitt is *not minor*; it amounts to a *judicially created, perpetual monopoly on a product, Pitt-insignia soft goods, which many people wish to purchase*.

Id. at 712 (emphases added).

In *Pennsylvania State University v. Vintage Brand, LLC*, 715 F. Supp. 3d 602 (M.D. Pa. 2024) (“*Penn State IP*”), “Penn State University . . . challenge[d] Vintage Brand’s use of . . . historical sports images . . . on the goods that it produces, as many of those images incorporate[d] in some form one or more of Penn State’s trademarks,” *id.* at 613, even though “the images [were] visually distinct from those trademarks,” *id.*, and even though “Vintage Brand provide[d] numerous disclaimers on its website that disavow[ed] affiliation with any university.” *Id.* The court held that, “[t]hese facts mean that many of Penn State’s claims fail[,], [but] the existence of dueling facts

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regarding likelihood of confusion mean[s] that Vintage Brand’s trademark[-]infringement claim must proceed to trial.” *Id.* The likelihood-of-confusion issue would have been moot *if* the court had ruled that, as a matter of law, Penn State’s marks were functional, but, instead, the court found that, “it *cannot be said, as a matter of law*, that Penn State’s exclusive use and control of its marks would put Vintage Brand at a *significant non-reputation related disadvantage*,” *id.* at 647 (emphases added), explaining:

It is not necessary for Vintage Brand to use the specific Penn State Marks to compete in the athletics[-]apparel marketplace or even the Penn State[-]apparel marketplace. For example, Vintage Brand could use *non-trademarked Penn State historical images* that omit the Penn State Marks. Or Vintage Brand could use *its own creative language* to attempt to entice Penn State supporters to purchase its goods. Vintage Brand could even seek to use *non-protected color schemes* to invoke Penn State in the minds of consumers without infringing upon any trademark. For instance, many alumni and supporters of Syracuse University or Bucknell University would undoubtedly associate a bright orange and navy blue necktie with their favored [sic] university—and likely purchase such goods—even if that tie *lacked any marks that explicitly associated it with those universities*.

Id. at 647-648 (emphases added). *See also id.* at 647, n.308 (“[f]or example, companies are prohibited from using the term ‘Super Bowl’ without authorization; many creative companies skirt this prohibition by using terms such as ‘the Big Game’—a reference that any fan of the National Football League instantly recognizes.”). However, the court ruled: “[a]lthough prohibiting Vintage Brand from using the Penn State Marks would *undoubtedly place Vintage Brand at a disadvantage* in trying to win over Penn State supporters, the evidence is *simply insufficient at this stage* to describe that disadvantage as *significant*. Consequently, there remains a genuine issue of material fact as to *whether the marks are aesthetically functional*, and [Vintage Brand’s request for] summary judgment on that ground [(see *id.* at 638)] will be denied.” *Id.* at 648 (emphases added) (according to PACER, “[j]ury [s]election [is] scheduled for 11/12/2024”).

It would be unrealistic to expect that the ability to sell the types of non-trademark-bearing merchandise that the court suggested as possibly enabling Vintage Band to be sufficiently competitive would enable Mr. Doe to be sufficiently competitive in appealing to NFL fans. Of course, *some* fans would be happy to purchase merchandise that enables them “to identify with their favorite Member Clubs” without the help of NFL Marks, but it is beyond doubt that if Mr. Doe were limited to selling such merchandise, he would be “at a significant non-reputation related disadvantage,” as discussed at pp.8-9, *supra* (as to the court’s ‘Super Bowl vs. the Big Game’ example, it might well suffice, for instance, for a restaurant to advertise its showing of “the Big Game,” but few NFL fans wishing to purchase merchandise relating to the NFL finale would give nearly as much (let alone equal) consideration to merchandise referring to “the Big Game” as they would to that which refers to the

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“Super Bowl.”).

Penn State II concluded:

As a final note, the [c]ourt cannot ignore the *practical impact* of any ruling that finds [that] a university’s marks are aesthetically functional because consumers wear goods bearing those marks only to express support for the institution itself. This would *essentially render those marks wholly unprotectable*, even if use of the marks would lead to *confusion regarding the source or sponsorship of the product*. Such a conclusion would stray dangerously close to the polar opposite of the per se approach rejected by this [c]ourt [in *Penn State I*, *i.e.*, “the per se approach utilized by the Trademark Trial and Appeal Board [], wherein the use of a university’s marks will always identify that university as a sponsor of the physical goods,” *id.* at 641) (footnote omitted)], and would mean that no trademark for universities would ever be valid for tangible goods. That is a conclusion that the [c]ourt cannot adopt.

Id. at 648 (emphases added). However, as set forth herein, a trademark is, regardless of a likelihood of confusion, free to be copied in a particular context if such copying is functional in either the utilitarian or aesthetic sense; and, in the merchandise context, NFL Trademarks are clearly functional in each of those senses.

Please contact me on or before November 18, 2024, to discuss the possibility of forging an agreement between NFLP and Mr. Doe that would enable him to sell NFL merchandise without fear of litigation.

Sincerely,

[s/ Todd C. Bank]

Todd C. Bank

EXHIBIT “D”

Letter from NFL Properties LLC to Todd C. Bank

November 18, 2024



NATIONAL FOOTBALL LEAGUE

November 18, 2024

VIA EMAIL

Todd C. Bank, Attorney At Law, P.C.
119-40 Union Turnpike
Fourth Floor
Kew Gardens, NY 11415
tbank@toddbanklaw.com

Re: Proposed Unauthorized Use of NFL Marks

Dear Mr. Bank:

I write on behalf of NFL Properties LLC (“NFLP”) in response to your November 1, 2024, to Jeff Pash on behalf of your unidentified “John Doe” client. As you know, NFLP is the authorized representative of the National Football League (“NFL”) and its thirty-two member clubs (“Member Clubs”) for the licensing and protection of the names, logos, color combinations, uniform trade dress, slogans and other identifying marks and indicia of the NFL and its Member Clubs.

In your letter, you explain that your client “wishes to sell unlicensed NFL merchandise” bearing “NFL Marks.”¹ You argue that “Mr. Doe’s sale of unlicensed NFL merchandise would not constitute either trademark infringement or dilution” because such use of NFL Marks would be “‘functional’ with the meaning of trademark law....” Nevertheless, you also seek to “discuss the possibility of forging an agreement between NFLP and Mr. Doe that would enable him to sell NFL merchandise without fear of litigation.”

Your assertion that the unauthorized use of NFL Marks on merchandise is permissible as functional, and thus does not require a license from NFLP or the relevant Member Club, is incorrect. The NFL Marks are well-known source indicators that do not have any non-trademark function, and use of those marks on products connotes affiliation with or endorsement by the NFL and/or its Member Clubs. Indeed, this is reflected in several of the cases cited in your letter (as well as others). *See, e.g., Savannah College of Art & Design, Inc. v. Sportswear, Inc.*, 872 F.3d 1256 (11th Cir. 2017); *Bd. of Supervisors v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008); *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062 (9th Cir. 2006); *Nat’l Football League Props., Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651 (W.D. Wash. 1982).

If your client engages in the unauthorized use of NFL Marks, or any marks confusingly similar thereto, such use will constitute trademark infringement, dilution, and/or unfair competition, and also

¹ In your letter, “NFL Marks” are defined as (1) “an NFL team’s color patterns and overall design except for an NFL, or NFL team’s, logo or insignia, *i.e.*, a trademark in the form of a trade dress” and (2) “trademark[s] in the form of an NFL, or NFL team’s, logo or insignia, *i.e.*, a ‘customary’ trademark.” Solely for the purposes of responding to your correspondence, this letter uses the same definition of NFL Marks.

Todd C. Bank, Attorney At Law, P.C.

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will misappropriate the goodwill and reputation of the NFL and/or its Member Clubs. *See, e.g., Johnny Blastoff, Inc. v. Los Angeles Rams Football Co.*, 188 F.3d 427 (7th Cir. 1999); *Indianapolis Colts, Inc. v. Met. Baltimore Football Club Ltd. P'ship*, 34 F.3d 410 (7th Cir. 1994); *Dallas Cowboys Football Club, Ltd. v. America's Team Props., Inc.*, 616 F. Supp. 2d 622 (N.D. Tex. 2009); *Nat'l Football League Props.*, 532 F. Supp. 651. NFLP reserves the right to take appropriate action to protect the intellectual property rights of NFL and its Member Clubs, including by contacting your client's web host company and any other online accounts (including social media accounts) requesting that any infringing uses of NFL Marks be removed. Furthermore, having fully informed you of our rights, NFLP will treat any unauthorized use of the NFL Marks by your client as intentional and willful, which would entitle NFLP to enhanced damages and reimbursement of its attorneys' fees.

If your client is interested in being considered for a license from NFLP, information about that process may be found at <https://businessapps.nfl.net/NFLConsProd/Welcome/CpPrequalify.htm>.

Nothing in this letter shall be construed as a waiver or relinquishment of any rights or remedies of the NFL, NFLP or its Member Clubs, all of which are expressly reserved.

Sincerely,

A handwritten signature in black ink, appearing to read "Bonnie L. Jarrett". The signature is fluid and cursive, with the first name "Bonnie" being more prominent.

Bonnie L. Jarrett

Senior Counsel

Email: Bonnie.Jarrett@NFL.com