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What’s in a Name, Brother—Profit or Publicity: An Analysis of Trademarking Ring Names in Professional Wrestling

Alissa M. Harrington

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WHAT’S IN A NAME, BROTHER—PROFIT OR PUBLICITY: AN ANALYSIS OF TRADEMARKING RING NAMES IN PROFESSIONAL WRESTLING
ALISSA M. HARRINGTON

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I. INTRODUCTION: ENTER THE WRESTLERS

The bell tolls. The stadium goes dark. Every cell phone camera glows eerily, pointed at the empty space where he is about to appear. He appears in smoke and fire as the infamous first bars of Chopin’s funeral march are met with a roaring crowd. Mark William Calaway appears to step into the ring as his wrestling persona—the Undertaker. It is unlikely anyone but the most die-hard professional wrestling fans would care if Mark William Calaway was going to show up at an event. But many a child of the 90s would shiver if the Undertaker were coming to dinner.

Ring names in professional wrestling are the calling cards by which fans and the general public know the athletes who perform in the ring. Children ask for Seth Rollins action figures, Roman Reigns t-
shirts, and Luke Harper\(^7\) standees. They would not know what to do with Colby Lopez\(^8\), Leati “Joe” Anoa’i\(^9\), and Jon Huber\(^10\) merchandise. But do these ring names rise to the level of personal names for purposes of barring trademark registration without permission from the individual? Or are the ring names representing fictitious characters that are portrayed by wrestlers? The United States Patent and Trademark Office (“USPTO”) seems to be unclear: trademark requests from World Wrestling Entertainment (“WWE”) for marks relating to the names of wrestlers have received inconsistent treatment—some require the signatures of the real person whose ring name is at issue, while others pass by without comment.

This article sets out to answer the question—how should the USPTO and courts treat the ring names of wrestlers? Specifically, this article looks at several examples showcasing the variety of situations that can arise with wrestling names—names created by the company, names based on or identical to the real name of the wrestler, names used by more than one person as the same character, and names used prior to the individual’s association with the company—then explores the competing interests of the company and the individual in name-based trademark law, and concludes with suggestions on how each situation should be treated moving forward.

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II. LAYING DOWN THE LAW: TRADEMARKS AND NAMES

A. Lanham Act and Names

The Lanham Act prohibits the use of a name “identifying a particular living individual except by his written consent.”\(^{11}\) Case law has clarified that the name must also “identify and distinguish the [product] and not merely the individual or group.”\(^{12}\) The same is true of character names—the name must service to identify the source, not just the character.\(^{13}\) In other words, character names and other names are descriptive marks that will only become registrable if the mark gains secondary meaning. Secondary meaning, in this sense, would be the use of the name in a way that leads to the public associating the name with a particular product or service.\(^{14}\) Separately, the Lanham Act bars registration of marks that are “merely a surname.”\(^{15}\)

Of course, the more interesting question becomes—what is a name that identifies a particular living individual, and when does it serve to identify the source of the product and not just the individual or character? Where is the line between the use of a name merely to identify an individual who is found in an entertainment setting and the use of a name as an identifier of the service of entertainment or the source of a product of the company? The courts and the USPTO have approached those questions differently. Performers have sometimes been granted the ability to trademark their own names\(^{16}\) while at other times, performers have been unable to use their names as trademarks.\(^{17}\)

B. TMEP—Trademark Manual of Examining Procedure on Names

The Trademark Manual of Examining Procedure (TMEP) controls how the examiners of the USPTO proceed in the registration of trademarks.\(^{18}\) Trademarks arising from names are subject to a variety of

\(^{12}\) TMEP § 1301.02(b) (Oct. 2015).
\(^{13}\) Id.
\(^{15}\) 15 U.S.C § 1052(c)(4).
\(^{18}\) TMEP Introduction (Oct. 2015).
different inquiries according to the TMEP. Examiners are asked to determine if the name is barred as “merely a surname,” if the name has obtained secondary meaning, and if the name is a name that identifies a person or a fictitious character to determine if consent would be required for registration. Names identifying living persons require the consent of the person, while names of fictitious characters do not.

If a name is that of a person, which includes not just a legal name, the following is provided as guidance:

First Name, Pseudonym, Stage Name, Surname, Nickname, or Title. If the mark comprises a first name, pseudonym, stage name, nickname, surname, or title (e.g., ‘Mrs. Johnson’ or ‘Aunt Sally’), the examining attorney must determine whether there is evidence that the name identifies an individual who is generally known or is publicly connected with the business in which the mark is used and, as a result, the relevant public would perceive the name as identifying a particular living individual.

In contrast, fictitious character names do not require the consent of any individual:

Fictitious Character. The examining attorney should not make an inquiry if it is clear from the record, or from the examining attorney’s research, that the matter identifies a fictitious character. For example, no inquiry is necessary as to whether ‘Alfred E. Neuman,’ ‘Betty Crocker,’ or ‘Aunt Jemima’ is the name of a particular living individual because they are names of well-known fictitious characters. Likewise, no inquiry is necessary as to a design that is obviously that of a cartoon character.

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19 TMEP §1301; TMEP § 1206.
20 TMEP § 1301.
21 Id.
22 TMEP § 1206.
23 Id.
24 TMEP § 1206.03 (Oct. 2015)
25 Id.
Comparing the two standards, it is clear that the requirements for registration depend heavily on whether or not the examiner considers a wrestler’s ring name to be that of an identifiable person or a fictitious character. Mainly at issue here is whether or not the consent of the individual must be given before registration is granted by the USPTO.

Regardless of whether the ring name is determined to be an identifier of a living person or a fictitious character, the examiner must also determine if the name has obtained secondary meaning as an indicator of the source of the product.26 “The name of a character or person is registrable as a service mark if the record shows that it is used in a manner that would be perceived by purchasers as identifying the services in addition to the character or person.”27

C. TMEP—Authorities for Names as Trademarks

The TMEP lists a number of cases as precedent in deciding how to address the issue of names as trademarks,28 and may be used to help the examiners decide whether to issue a trademark registration.29 The cases provide a framework that is helpful to understand why the USPTO’s decisions have varied on what type of rights are available and if permission is required to register wrestler’s ring names.

1. In re Lee Trevino30

Lee Trevino, famed PGA golfer31 perhaps better known in some circles for his cameo in the Adam Sandler film Happy Gilmore,32 attempted to register his name as a service mark of Lee Trevino Enterprises, Inc. for promoting goods and services.33 The registration was refused by the examiner because the specimens filed showed “LEE TREVINO” being used to identify Lee Trevino as an individual

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26 TMEP § 1301; see also TMEP § 1212.
27 TMEP § 1301.02(b).
28 TMEP § 1206; TMEP § 1301.
29 4 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 15.11 (2015).
performing services, instead of the source of the services as Lee Trevino Enterprises, Inc.\textsuperscript{34}

The applicant appealed citing nineteen instances where a service mark registration was granted for a mark containing or wholly comprised of the name of a famous individual.\textsuperscript{35} The board pointed out the difference between the nineteen instances cited by the applicant and the “LEE TREVINO” mark, mainly that the specimens filed with the applicant must “demonstrate use of the name in question to identify goods sold or transported in commerce or services rendered by the applicant corporation as distinguished from use merely to identify the particular individual who endorses the goods or performs the services set forth in the application.”\textsuperscript{36} The specimens in the application were posters and other materials listing Lee Trevino’s accomplishments, the “availability of Lee Trevino, the individual, for endorsements, exhibitions of golf, and sales meetings,” endorsements by Lee Trevino, and, subsequent to the initial application, documents showing Lee Trevino as a consultant.\textsuperscript{37}

The specimens, according to the board, represented examples of Lee Trevino as a person who endorsed products, rather than as an indicator of the Lee Trevino Enterprises, Inc. brand.\textsuperscript{38} The board affirmed the registration refusal.\textsuperscript{39}

2. \textit{In re Burger King Corp.}\textsuperscript{40}—\textbf{BURGER KING}

Burger King Corp. applied to register the “fanciful figure” of a king as a service mark for restaurant and carry-out food services.\textsuperscript{41} At issue was whether or not the depicted king was a service mark or

\begin{footnotesize}
\begin{enumerate}
\item Id.
\item Id. ("including ‘ARTHUR MURRAY’ for instruction in dancing, ‘BILLY GRAHAM’ for religious educational services, ‘EVELYN WOOD’ for conducting courses of instruction in rapid and perceptive reading techniques, ‘DOROTHY CARNEGIE’ for educational services, ‘AL HIRT’S’ for restaurant services, ‘MICKEY MANTLE’S’ for restaurant services, ‘EDDY ARNOLD’S’ for restaurant services, ‘ROY ROGERS’ for restaurant services, and ‘COLONEL SANDERS INN’ for hotel and motel services.").
\item Id. at 254.
\item Id.
\item Id.
\item In re Burger King Corp., 183 U.S.P.Q. 698 (T.T.A.B. 1974).
\end{enumerate}
\end{footnotesize}
merely a character in advertising the products. The registration application was refused, and the applicant appealed.

The applicant argued for a “liberal view” of the registration statute, which would allow the design of the burger king to be used as a service mark in addition to the name “BURGER KING.” In response, the board upheld the refusal and ruled that the fanciful design of the king did not rise to the level of identifying the brand, but rather only identified an advertising character.

3. In re Steak & Ale Restaurants—PRINCE CHARLES

This textbook classic involves the American steakhouse—Steak & Ale Restaurants—attempt to register “PRINCE CHARLES” as a trademark for fresh and cooked meat. The examiner refused the registration under 2(c) of the Lanham Act because “PRINCE CHARLES” consists of or compromises a particular living individual. Namely, Charles Philip Arthur George, the Prince of Wales. Prince Charles, as he is most often known, is a member of the English royal family.

The examiner based the registration refusal on the belief that “PRINCE CHARLES” is the name of this British Prince Charles. The applicant appealed to the Trademark Trial and Appeal Board (T.T.A.B.) arguing that the name represented multiple individuals, including another member of the English royal family and a member of the Swedish royalty. Alternatively, the applicant argued that “PRINCE CHARLES” is a historical title used to identify multiple

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42 Id. 43 Id. 44 Id. at 700. 45 Id. 46 Id. 47 Id. 48 Id. at 447. 49 Id. 50 Id. 51 In re Steak & Ale Rests., Inc., 185 U.S.P.Q. 447, 448 (T.T.A.B. 1975). 52 Id. at 447. 53 Id. 54 The Prince of Wales Biography, THE PRINCE OF WALES AND DUCHESS OF CORNWALL, http://www.princeofwales.gov.uk/the-prince-of-wales/biography (last visited May 14, 2016). He is also known by a number of other titles, including the Duke of Cornwall, Duke of Rothesay, Earl of Carrick, Baron Renfrew, Lord of the Isles, and Prince and Great Steward of Scotland. Id. 55 Id. 56 Id. 57 In re Steak & Ale Rests., Inc., 185 U.S.P.Q. at 447. 58 Id.
members of various royal families. The T.T.A.B. did not agree with any of the applicant’s arguments. The board responded to the three arguments in order. First, even if more than one person has a name, it “does not make any one of them any less of a particular living individual.” Second, the board used similar logic to address the argument that the existence of historical figures lacked probative value. “Thus, the existence in the past of one or more individuals with a name or a combination of a title and a name such as that herein involved cannot negate the proposition that a contemporary with the same or a similar name or title is a particular living individual.” Finally, the board addressed the title argument by clarifying that given names are not the only names barred under 2(c). A title or combination of title and name could be used as a nickname, and thus, would be barred.

The statute uses the words ‘a name’ and not the words ‘the name.’ Hence ‘name’ in section 2(c) is not restricted to the full name of an individual but refers to any name regardless of whether it is a full name or a surname or given name, or even a nickname, which identifies a particular living individual.

On these bases, the board upheld the registration refusal.

4. In re Carson—JOHNNY CARSON

John W. Carson took the stage as the host of The Tonight Show in 1962, beginning a thirty-year career as the King of Late Night

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53 Id.
54 Id.
55 Id. at 447–48.
56 Id. at 447.
57 Id. at 448.
58 Id.
59 Id.
60 Id.
61 Id. (quoting Reed v. Bakers Eng’g & Equip. Co., 100 U.S.P.Q. 196 (PTO 1954)).
62 Id.
Johnny Carson applied to trademark “JOHNNY CARSON” for entertainment services, including “monologues, comedy routines and the hosting of guest appearances of others.” The examiner refused the registration based on the ground that “JOHNNY CARSON” identified the individual John W. Carson, rather than as a mark to identify services rendered by the applicant. The examiner suggested “THE JOHNNY CARSON SHOW” as an alternative mark, but Carson refused and appealed the registration refusal to the T.T.A.B.

Carson argued “JOHNNY CARSON” acted both as an identifier of an individual and as the identifier of the source of services performed by the same individual. Additionally, the applicant argued the word “show” acted as a generic description of the services rendered by the individual, and no additional distinctiveness would be added to the mark by adding the word to the mark “JOHNNY CARSON.”

The specimens submitted with the appeal and the original application included numerous posters, newspaper copy, and other advertisements. One specimen was a newspaper page showing a picture of Carson with the words: “JOHNNY CARSON is in the Congo Room at Del Webb’s hotel Sahara with Bette Midler.” The board found that this specimen used the mark simply as an identifier of the individual, not as a source identifier. In contrast, the board found that many of the other specimens showed the use of the mark as an indicator of source of entertainment services. Specifically, the board calls out the advertisements using the mark in conjunction with the words “IN CONCERT” or “3 BIG PERFORMANCES AT THE MUSIC HALL!” and information on how to obtain tickets to the advertised performances, as examples of how the mark is used as an indicator of source. The board additionally recognizes the specimens containing

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65 In re Carson, 197 U.S.P.Q. at 554.
66 Id.
67 Id.
68 Id. at 555.
69 Id. at 554.
70 Id. at 555.
71 Id. at 555–56.
ticket information and “THE JOHNNY CARSON SHOW” as illustrative of how the mark alone serves as an indicator of services, without the need for the additional words describing the service (“the show”).

The T.T.A.B. took the time to distinguish the “JOHNNY CARSON” mark from the refused mark “LEE TREVINO” by noting that “LEE TREVINO” was never used in the specimens provided as a service mark. Instead, the specimens showed three uses: the mark used as a “textual reference to Lee Trevino as an individual” in combination with the identification of services; the mark used with “services not listed in the identification of goods set forth in the application;” and the mark not used in a service mark manner with no reference to services. The board held that applications should be determined based on the specimens in the record. The record for Carson supported the registration of the mark, and the board reversed the examiner’s registration refusal.

5. In re Whataburger

Whataburger attempted to register the image of a hippopotamus with the name “WHAT-APOTAMUS” directly below the image on an iron-on patch as a service mark for restaurant services. The applicant also filed a poster displayed at the cashier counter depicting a group of different animals about to consume food and drink with the words “Your Whatapatch Zoo is here for you” as a specimen. Patches were distributed without charge to customers with children as the main recipients. The application was refused because the mark did not identify the restaurant services of the applicant.

On appeal, the T.T.A.B. upheld the refusal based on the finding that the characters were part of a collect-them-all advertising

75 Id. at 556.
76 Id. at 429–30.
77 Id. at 429.
character gallery rather than an indicator of source. The board found that the animals were a “promotional gambit” more in line with giving away toy balloons emblazoned with familiar nursery rhyme characters than with something the purchasers would use to indicate the source of hamburgers. In refusing the registration, the board held “[n]ot only must the matter presented for registration be intended primarily to indicate origin, but as previously indicated, it must also be of such a nature that purchasers would be likely to consider that it indicated such origin.”

6. In Re Fla. Cypress Gardens Inc.—CORKY THE CLOWN

Everybody loves (or hates) a clown. The T.T.A.B. is no exception. Cypress Gardens Inc. applied for a service mark in “CORKY THE CLOWN” for entertainment services, including live performances by a clown. The examiner refused the registration on two grounds: (1) the mark identifies a character rather than a service and (2) the mark is used “inconspicuously as part of informational textual material” rather than as a service mark. The applicant appealed, and the T.T.A.B. reversed the registration refusal in favor of Cypress Gardens.

“CORKY THE CLOWN” appeared on handbills alongside other acts advertising the attractions at Cypress Gardens in the specimens for the application. The T.T.A.B. found that “CORKY THE CLOWN” is the name of a character played by one or more people rather than any type of name for a living individual. As such, the board looked to the previous case of In re Folk and “THE LOLLIPOP PRINCESS” for guidance. Lin Folk sought to trademark the name of the character she portrayed when she told children’s stories

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85 Id. at 430–31.
86 Id. at 431.
87 Id.
89 GARY LEWIS & THE PLAYBOYS, EVERYBODY LOVES A CLOWN (Liberty Records 1965).
91 Id.
92 Id.
93 Id.
94 Id.
95 Id. at 290.
on the radio and in-person.96 The T.T.A.B. also overturned the registration refusal of the examiner in Folk, holding, “There can be no question on the record herein but that ‘THE LOLLIPOP PRINCESS’ identifies and distinguishes the services performed by applicant.”97

In Cypress Gardens, the board cited the holding in Folk to support its decision to allow the registration of “CORKY THE CLOWN” by arguing that the difference in medium—radio vs. only in-person performances—is not sufficient to break down the analogy.98 In both cases, the service mark identified the character as well as the act.99 The board continued to say that they find no reason why the name of the act would not be as registerable as the name of Cypress Gardens.100 “In fact, this situation is somewhat analogous to the registration of marks which identify a particular feature, such as an ingredient, a finish, etc., of goods.”101

Addressing the examiner’s second reason for refusal, the board shortly stated that there is no requirement that a mark be conspicuous “[s]o long as it is used in such a manner as to be readily recognizable as a trademark.”102 Since neither of the examiner’s reasons for registration refusal were upheld, the board overruled the examiner and allowed registration of the mark.103

7. In re Mancino104—BOOM BOOM

Raymond M. “Boom Boom Mancini” Mancino applied to register the service mark “BOOM BOOM” for “entertainment services, namely, conducting boxing exhibitions and matches.”105 The applicant submitted specimens of the cover of boxing match programs, leaflets, and newspaper articles.106 Specimens showed the applicant’s ring record, nickname, and participation in boxing matches.107 The examiner

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96 Id. at 214.
97 Id.
99 Id. at 292.
100 Id.
101 Id.
102 Id.
103 Id.
105 Id. (citing U.S. Trademark Application Serial No. 327,710 (filed Sept. 14, 1981)).
106 Id. at 1047–48.
107 Id.
found the specimens showed the mark was used only to identify the applicant as a participant rather than as an identifier of the source of boxing services. The T.T.A.B. agreed and upheld the refusal of registration, holding that people would see the words “BOOM BOOM” in connection with the applicant merely as his boxing nickname and not as the identifier of any source of services.

8. In re Sauer—BO BALL

In 1989, Debbie Sauer applied for a mark of “BO BALL” on “an oblong shaped ball made of white leather with red stitching at the seams.” The mark appears to be a hybrid of a football and a baseball. The registration was refused based on a violation of 2(a) and 2(c) because the allusion to football and baseball with the name “Bo” suggested a false connection with Bo Jackson, and the mark is the use of Jackson’s name without his consent. Bo Jackson, as the examining attorney showed, “is a famous athlete who has played both professional football and baseball.” The applicant appealed, arguing that other celebrities have the first name “Bo,” therefore there would not be an automatic connection to Bo Jackson.

The board confirmed the examiner’s use of a four-part test to determine if a mark falsely suggests a connection with an individual in violation of 2(a). First, the “mark must be shown to be the same or a close approximation of the person’s previously used name or identity.” Second, “[i]t must be established that the mark (or part of it) would be recognized as such.” Third, it must be established that “the person in question is not connected with the goods or services.” And, finally, “the person’s name or identity must be of sufficient fame that when it is used as part or all of the mark on applicant’s goods, a

108 Id.
109 Id.
111 Id.
112 U.S. Trademark Application Serial No. 73,822,435 (filed Aug. 30, 1989).
114 Id. at 1074.
115 Id.
116 Id. at 1073.
117 Id.
118 Id.
119 Id.
connection with that person is likely to be made by someone considering purchasing the goods.\textsuperscript{120}

All four parts of the test were met, according to the board.\textsuperscript{121} Bo Jackson is widely known as “Bo” and has been known as such since childhood.\textsuperscript{122} As a professional athlete who excels at both football and baseball, the connection of “Bo” with the word “ball” on a football-baseball hybrid would be recognized as identifying Jackson.\textsuperscript{123} There is no established connection between the applicant and Jackson.\textsuperscript{124} Finally, specimens including Cheerios boxes, magazines, figurines, trading cards, and other materials establish that Bo Jackson “has achieved great fame and notoriety, so that when his nickname is used . . . purchasers will likely make a connection between him and the applicant’s products.”\textsuperscript{125} The board upheld the refusal based on 2(a) as well as on the basis of 2(c).\textsuperscript{126}

The board also laid out the test for a refusal under 2(c).\textsuperscript{127}

Mainly, that without the consent of an individual, a name that identifies a living individual may not be registered as a mark.\textsuperscript{128}

A name is deemed to ‘identify’ a particular living individual, for purposes of Section 2(c), only if the individual bearing the name in question will be associated with the mark as used on the goods, either because that person is so well known that the public would reasonably assume the connection, or because the individual is publicly connected with the business in which the mark is used.”\textsuperscript{129}
Again, the board found that the “BO BALL” mark satisfies the test and also confirms the refusal of the registration under 2(c).  

9. *In re Hoefflin*—OBAMA PAJAMA, OBAMA BAHAMA PAJAMAS, BARACK’S JOCKS DRESS TO THE LEFT

The applicant applied for three separate marks for pajamas and undergarments, all of which were denied registration based on 2(c) and the connection of the marks to President Barack Obama. All three cases were appealed by the applicant, and given the similarities between the cases, the T.T.A.B. combined them into a single decision.

The applicant argued the refusals under 2(c) were inappropriate because the mark is used for a product (pajamas) not connected to Barack Obama, the mark did not use the entire name of Barack Obama, and the mark only coincidentally refers to the forty-fourth president. In upholding the registration refusals, the board refined some of its earlier holdings.

First, the board clarified that an individual could be identified by a mark either because the person is connected to the product or because the individual is famous enough that a connection would be made absent a connection between the person and the product. The board also presented a connection between the bar in 2(c) and the right to publicity. “This provision is intended to protect the intellectual

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130 Id.
132 Id.
133 Id. at 1175 (“Inasmuch as all three of these appeals involve common questions of law and fact, and each has been treated in substantially the same manner by the applicant and by the Trademark Examining Attorney, we have consolidated these three separate appeals and are issuing a single decision herein.”).
134 Id. at 1175–76.
135 Id. at 1175–76 (citation omitted) (“In determining whether a particular living person bearing the ‘name’ would be associated with the mark as being used on the goods, we must consider (1) if the person is so well known that the public would reasonably assume the connection, or (2) if the individual is publicly connected with the business in which the mark is being used.”).
136 Id. at 1176.
property right of privacy and publicity that a living person has in his/her identity.”

In the case at hand, the examining attorney presented a wide range of sources indicating the fame of Barack Obama, including an article about “Obamafication,” the practice of using Obama’s name as part of made up words either for political or merchandising goals. The board found the evidence presented “the obvious” to support a finding that Barack Obama is famous enough that he need not be connected to the pajama industry for any of the marks to be identified with him.

Second, the board addressed the issue of coincidence in using the name Obama. While 2(c) does not protect an individual who coincidentally shares a name with an applied-for mark, the board found that the evidence showed the purchasing public would make such an association. Furthermore, the board pointed out that while other presidential names such as “Bill,” “George,” “Ronald,” and “Jimmy” had been successfully used in registered marks, the names were also “consistently among the most popular male names in the country.”

Given the unusual nature of “Barack,” said the board, it is distinguishable from the highly common names of other former presidents.

Third, the board quickly clarified that full, given names were not the only names offered protection under 2(c). “Rather, this statutory sub-section operates to bar the registration of marks containing not only full names, but also surnames, shortened names, nicknames, etc., so long as the name in question does, in fact, ‘identify’ a particular living individual.” And for all of the reasons discussed, the board upheld

137 Id. (citing 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §§ 10.07, 28.1 and 28.46 (4th ed. 2010)).
138 In re Hoefflin, 97 U.S.P.Q.2d 1174, 1176 (T.T.A.B. 2010). The examining attorney also presented evidence from the online Urban Dictionary entry for “Obamapajamas” and noting the inherent rhyming scheme to Obama Pajama. See id.
139 Id. at 1177.
140 Id. at 1176 (“Of course, the fact that applicant filed these three particular applications together just weeks before President Obama’s historical swearing-in would seem to belie this representation.”).
141 Id.
142 Id. at 1177–78.
143 Id. at 1177 (citing In re Sauer, 27 U.S.P.Q.2d 1073, 1074 (T.T.A.B. 1993)).
the refusal of registration for all three marks, absent the consent of the Forty-Fourth President, Barack Obama.144

10. In re Morrison & Foerster LLP145—FRANKNDODD

Former Congressman Barney Frank and Former Senator Chris Dodd are the namesakes and “co-architects” of the Dodd-Frank Wall Street Reform and Consumer Protection Act.146 The applicant wished to register “FRANKNDODD” as a service mark for legal and legislative update services.147 Based on the association with the former Congressman and former Senator, the examining attorney refused the registration under 2(c).148

The board overturned the refusal on the grounds that the name “Dodd-Frank” is publicly connected with the legislation, not the individuals.149 “FRANKNDODD” is a reversal of the name order from the legislation in order to create an allusion to Mary Shelley’s Frankenstein, since the bill was pieced together from fifteen separate laws and the allusion had already been made by the media.150 The board also distinguishes the case at hand from In re Hoefflin by pointing out that, unlike Obama in “OBAMAJAMAJAMA,” “FRANKNDODD” is the name of a statute and also a commentary on said legislation rather than just the names of individuals.151 In overturning the registration refusal, the board found that the mark “would be understood by the relevant consuming public as referencing

146 Id. at 1424; Dodd-Frank Wall Street Reform and Consumer Protection Act, U.S. Commodity Futures Trading Commission (Jan. 5 2010), http://www.cftc.gov/idc/groups/public/@swaps/documents/file/hr4173_enrolledbill.pdf.
148 Id. at 1423–24.
149 Id. at 1427–28.
150 Id. The author would note that the T.T.A.B. misidentifies the character “Frankenstein” as the monster who is put together with the parts of numerous people in Frankenstein rather than the name of the doctor. Of course, as has been pointed out by numerous online sources, “Knowledge is knowing Frankenstein isn’t the monster; wisdom is knowing Frankenstein is the monster.” Brian McGackin, Culling the Classics: Frankenstein, Lit Reactor (Oct. 31, 2014) https://litreactor.com/columns/culling-the-classics-frankenstein.
and commenting on the Dodd-Frank Act rather than as specifically identifying Congressman Barney Frank and Senator Chris Dodd.”

III. Dividing Up the Roster: Categories of Names and Examples of Wrestler Trademark Proceedings

All of the cases cited in the TMEP leave wrestler names—arguably nicknames, stage names, character names, given names, or names identifying individuals—up for interpretation, depending on what category an examiner chooses to use in classifying the mark. Further complicating the analysis, it is not always clear if the name of a wrestler is a given name or a name previously used before joining the entity seeking to register the trademark. Since there is scant case law on the subject of wrestlers’ names, it is up to balancing competing analogies to figure out what should apply. The various decisions by the USPTO show that there is not a universally accepted criteria to determine if wrestlers’ names (whether they are based on real names or not) should require the consent of the wrestler or if the wrestling promoter registering the wrestler’s name as a mark is distinguishable as the source of the product or service.

152 Id.
153 The Ultimate Warrior cases: Warrior v. Titan Sports, Inc., No: CV96-15377 (Ariz. Sup. Ct. 1997) (trademark case); Titan Sports, Inc. v. Hellwig, 1999 U.S. Dist. LEXIS 10523 (D. Conn. Apr. 26, 1999) (subsequent character copyright case mentioning details of earlier trademark case not found in the record otherwise) provides an example of how a state court ruled on a very specific issue—the ownership of a trademark of the name “Warrior.” In that case, Mr. Hellwig entered the WWF (now WWE) with his given name—James Brian Hellwig. Warrior v. Titan Sports, Inc., No: CV96-15377 (Ariz. Sup. Ct. 1997). He had already worked as the Dingo Warrior for a year in another wrestling federation—World Class Championship Wrestling—before joining the WWF performing under the name “Dingo Warrior.” Id. His contract, as stated in the lawsuit, specifically addressed the issue of intellectual property in the character name. Id. However, Hellwig claimed that he was the one who made the change to the Ultimate Warrior name that would eventually make him a household name. Id. In 1993, he legally changed his name to the one-word Warrior (and his children’s surnames to Warrior). Id. While an interesting case, it is difficult to gather much precedent from the case. Not only were the lawsuits decided in state court, but the combination of the timing of the legal name change, the character’s creation, and the contract terms make the case only good for general principles, which will be discussed later on.

154 The most common source of the product or service is usually the WWE. “The WWE has dominated its market and has established its brand in the minds of the American public.” Sungick Min et. al., An Empirical Analysis of the Effectiveness of World Wrestling Entertainment Marketing Strategies, SPORT J. (Feb. 6, 2014).
The purpose of professional wrestling, particularly the WWE, is to sell entertainment. The entertainment provided by the world-class athletes employed by WWE is based on the storylines and characters. One perspective says the wrestlers become “akin to literary characters or characters in a play individually spinning their author’s character conception.” The company follows this perspective, saying “[o]ur creative team develops compelling and complex characters and weaves them into dynamic storylines that combine physical and emotional elements.” In order to draw a profit from these characters and stories, WWE not only provides live events, televised events, consumer products, and productions, but also licenses the rights to “substantially all of the [their] characters.”

Wrestling ring names are more than names, they represent identities. Ring names convey an alter ego for the athlete, an identity that extends beyond the ring and into the real world. The line between the characters gets blurred even further when the wrestlers are often asked to adhere to a code of conduct that suggests the reality of the show into real life. Conversely, the private lives of wrestlers can also enter the ring. Romantic entanglements behind the scenes show up

156 Id. at 422. 157 Id. at 419. 158 Company Overview, WWE.COM, http://corporate.wwe.com/company/overview (last visited May 14, 2016). 159 Id. 160 See Philip Frazer, Top 15 Times Wrestling Got Real, SPORTSTER (Dec. 12, 2014), http://www.thesportster.com/wrestling/top-15-times-wrestling-got-real/?view=all (“Once upon a time kayfabe—the act of portraying staged events as real—was an unbreakable tangent, used to try and get the audience as invested as possible in the clashes of heroes and villains.”); see also David Shoemaker, Grantland Dictionary: Pro Wrestling Edition, GRANTLAND.COM (Aug. 13, 2014), http://grantland.com/features/grantland-dictionary-pro-wrestling-edition/ (“kayfabe (n.; adj.) — The code of secrecy that undergirds the pro wrestling industry by which the secret of its unreality is protected. Keeping kayfabe is the act of staying in character before, during, and after shows so as to maintain the illusion. As an adjective, it separates real from fake, as in, “He’s not my real brother, he’s just my kayfabe brother.” The term comes from carnie slang (possibly a variation on Pig Latin) for “be fake” or “keep secret.”). 161 Dave Meltzer, WRESTLING OBSERVER NEWSL. (April 18, 2011) (article on file with author) ("The Edge/Lita/Matt Hardy angle started out as legit, and after an incident in real life where Edge’s car was defaced (not an angle) while on the road in the Carolinas,
on TV. Drug and alcohol problems in real life turn into redemption stories. Deaths of loved ones become reasons to hire people. Pets and tragedies are dragged into the ring. Even lawsuits and government investigations have been dramatized into scripted angles. With the close connections between real life and what happens for entertainment, a wrestler’s name is possibly not just a character.

The names of professional wrestlers come from a variety of sources—some use their real names or a variation on their real name,
some use a name from previous wrestling experience, some use a name portrayed by more than one person, or, most commonly in the modern era, the company creates the characters. Each source creates specific challenges when trying to identify who should own trademark rights, if any are available, to the name.

The next section of this article looks at examples of each of four origins for wrestling names that WWE has trademarked in the past fifteen years: real names, names from previous wrestling experience, names represented by more than one person, and names solely created by the company. At least one example of a trademark application and the correspondence between WWE and the USPTO is discussed, as well as a short analysis of the laws mentioned by both sides in their correspondence.

A. Real Names Are Easy: John Cena

John Cena was born John Felix Anthony Cena. He started his televised WWE career on June 27, 2002 on WWE Smackdown. On October 28, 2003, WWE filed an application to register “JOHN CENA” as a service mark for entertainment wrestling performances and wrestling news. On April 28, 2014, the USPTO replied noting that “JOHN CENA” was a name identifying an individual and therefore barred from registration without the consent of the individual. WWE replied on October 19, 2004, with the signed consent of John Cena,

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168 Rey Mysterio, Chris Jericho, Hulk Hogan, Sting, Lance Storm, Ultimo Dragon, Ricky Steamboat, Ric Flair, etc. are all examples. See infra Part III A.
170 The “bookers” would traditionally be the ones who would create the characters. Bookers are the people who would book the talent and decide who would win and lose the matches. supra note 160.
172 WWE Smackdown, (Titan Entertainment broadcast June 27, 2002).
173 JOHN CENA, U.S. Registration No. 2957043 (Application).
174 Id. (Priority Action).
On May 31, 2005, the registration was granted for “JOHN CENA.” 176 While WWE did not include John Cena’s consent in the original application, the company submitted it without further comment on the record. Given the trademark sought is the first name and surname of John Cena, the case law seems to present an easy solution—get the consent of the individual and get the mark registered.

B. Previous Wrestling: Rey Mysterio 178

The 27-year-old Óscar Gutiérrez had already been flying from the turnbuckles for over a decade in Mexico 179 by the time he literally exploded onto the scene accompanied by fireworks to debut on WWE Smackdown on July 25, 2002. 180 Óscar is the nephew of Miguel Ángel López Diaz, more widely known as the luchador and trainer Rey Misterio Sr. 181 Diaz premiered in 1976 as Rey Misterio (King Mystery) and went on to train other wrestlers, including his nephew Óscar. 182

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175 Id. (Response to Office Action).
176 Id. (Registration).
178 This article does not talk about the end of Rey Mysterio’s career with the WWE and the possible international trademark issues. Rumors flew about possible contract issues between Rey Mysterio and WWE over the use of the name, since it was used with only a slightly altered spelling of the addition of “Jr.” for many years prior to his time in the WWE when wrestling in Mexico and Japan. David Meltzer, WRESTLER OBSERVER NEWSL. (Mar. 9, 2015) (article on file with author) (“Over the past year there were a number of issues back-and-forth which neither side went public with, due to wanting a quiet resolution that would allow Mysterio to do what he wanted. There were threats about usage of the Rey Mysterio name, although he’d have almost surely won that in court because he had started using the name Rey Misterio Jr., in AAA back in 1992 and used it on major shows including PPV in the U.S. as well as in Japan before coming to ECW and WCW (the intellectual property of both that WWE currently owns). But such a legal fight could be long and costly. There were also issues both sides could have used, regarding drug testing failures by Mysterio and alleged racial remarks within the WWE that had been talked about that were one of the reasons of the quick resolution and dropping of the non-compete in the Jose Alberto Rodriguez (Del Rio) case.”).
180 WWE SMACKDOWN (Titan Entertainment broadcast July 25, 2002).
182 Id.
Óscar made his professional debut at age fourteen in 1989 as Colibri (Hummingbird). Two years later in 1991, his uncle ceremoniously gave Oscar a luchador mask and the name Rey Misterio, Jr. The sixteen-year-old continued to wrestle in Mexico, Japan, and eventually made the jump to World Championship Wrestling (WCW) in the United States. By the time Rey Mysterio climbed in the ring for WWE, fans were already holding up “Rey Mysterio, Jr.” signs as the announcer Michael Cole hailed him as “the most celebrated luchador to invade the U.S. since Mil Mascaras.”

On December 2, 2002, the WWE filed an intent to use application for the mark REY MYSTERIO in connection with entertainment services, mainly wrestling exhibitions. As expected, on July 16, 2003, the USPTO file shows a notice of publication stating, “The mark of the application appears to be entitled to registration.” On August 5, 2003, the mark was published in the Official Gazette. The mark continued to follow the normal course of registration when the WWE amended the application to show use on April 27, 2004. The amendment alleges the mark’s use in commerce beginning on July 25, 2002, the day Rey Mysterio premiered on Smackdown.

Nearly two years later, on March 12, 2004, the WWE applied for an intent to use registration for REY MYSTERIO on action figures and other toys. A few months later, on July 19, 2004, the trademark examiner sent a notice to WWE in regards to the entertainment service mark saying “Does Not Function as Service Mark—Personal Name.” The action claimed that the “Rey Mysterio is clearly the name of the

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184 Id.
185 Id.
186 WWE SMACKDOWN (Titan Entertainment broadcast July 25, 2002). Mil Mascaras (Spanish for 1,000 masks) is considered to be one of the most internationally successful luchadores with a career spanning back to the mid-1960s. See Mil Máscaras Bio, WWE.COM, www.wwe.com/superstars/mil-mascaras (last visited May 14, 2016). Entertainingly, he is the uncle of current WWE wrestler Alberto Del Rio. Id.
187 REY MYSTERIO, Registration No. 2972939 (Application).
188 Id. (Notice of Publication).
189 Id.
190 Id. (Amendment to Alleged Use).
191 Id.
192 Milner, supra note 179.
193 REY MYSTERIO, Registration No. 3124385 (Application).
194 REY MYSTERIO, Registration No. 2972939 (Office Action Outgoing).
wrestler in [the specimen]” and will be refused registration unless there is a showing of secondary meaning.195 A month later, the USPTO also sent a correspondence on the toy mark application noting that Rey Mysterio was the name of an individual and written consent was required to use the name.196

In January of 2005, WWE responded to the entertainment mark action with a response arguing that Rey Mysterio was the name of a character, akin to “PETER PAN, Registration No. 1,831,779, SUPERMAN, Registration No. 1,181,536, BATMAN, Registration No. 1,652,640, BARNEY, Registration No. 1,860,039, TWEETY, Registration No. 1,869,692.”197 The response also notes that a number of WWE wrestlers’ names had already been granted registration, such as THE ROCK, THE UNDERTAKER, EDGE, and LITA.198 Several months later, WWE responded to the toy trademark on March 25, 2005, with the written consent of Óscar Gutierrez to the registration of REY MYSTERIO by the WWE.199 By doing so, the WWE provided written consent for both trademark applications, and both were granted in short order.200

The case of Rey shows one of the points of tension within the law: should the USPTO require the consent of a performer who plays a character whose name predates the performer’s contract with the trademark applicant and is widely associated with the individual? Or should the USPTO leave well enough alone and allow the WWE to register the trademark of any character on its roster, given the close association between the characters and the company? The attorney for WWE points to a variety of character trademarks in her response, suggesting that we should use the analogy of characters in works of literature, television, or film to make the decision about how to treat the marks that are previously associated with a performer.201 Certainly, there are similarities between a character like Barney and wrestlers. Both appear in taped television performances portraying characters in storylines written by other people. Both are providing an entertainment

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195 Id.
196 REY MYSTERIO, Registration No. 3124385. (Office Action Outgoing).
197 REY MYSTERIO, Registration No. 78198695. (Response to Office Action).
198 Id.
199 Id.
200 Id.
201 Id.
202 REY MYSTERIO, Registration No. 3124385; REY MYSTERIO, Registration No. 2972939.
203 REY MYSTERIO, Registration No. 78198695. (Response to Office Action).
service. But there are also differences. For one thing, Barney was created by Lyons Partnership.\textsuperscript{202} Although WWE claims in its response “the mark is a fictitious character name, created by Applicant,”\textsuperscript{203} it is questionable whether or not the small changes in the name (the removal of “Jr.” and the changing of the spelling, though not the sound, from Misterio to Mysterio) would stand up to much scrutiny.\textsuperscript{204} Of course, since both Rey Misterio and Rey Misterio Jr. had operated primarily in Mexico\textsuperscript{205}, there was not a prior trademark registration for either name. It would still be uncertain how the USPTO would rule in a case where the previously used name was used in the United States without registration. Perhaps, more importantly, this should serve as a warning to professional wrestlers to register their names as service marks and trademarks in the United States before entering into a contract with the WWE if the wrestlers want to ensure their consent is necessary for WWE to transfer the mark.

C. More Than One Person Under a Mask: the Sin Caras\textsuperscript{206}

In 2011, the WWE applied to register the mark “SIN CARA” in four categories: wrestling entertainment,\textsuperscript{207} clothing,\textsuperscript{208} toys,\textsuperscript{209} and

\begin{footnotesize}
\begin{thebibliography}{99}
\bibitem{202} BARNEY, Registration No. 1860039.
\bibitem{203} REY MYSTERIO, Registration No. 2972939.
\bibitem{204} LALONDE, supra note 29, at §1.3 (“The applicant may be able to argue that the trademarks are dissimilar in sound, appearance and meaning . . . .”).
\bibitem{205} See Rey Mysterio Jr. Profile, supra note 183.
\bibitem{206} This article will not address the more interesting international issue with the Sin Cara trademark. WWE did not register the trademark in the United States or in Mexico in time to block the registration of the name mark and the design of the mask in Mexico. David Meltzer, WRESTLING OBSERVER NEWSL., Jun. 6, 2011, at 6 (article on file with author) (“WWE forgot to trademark the name Sin Cara, so when CMLL found this out, as a nuisance, they trademarked the name Sin Cara for use in Mexico.”). Another theory is that CMLL was attempting to block the first man behind the Sin Cara mask from using the name Sin Cara or his signature mask if he were to return to Mexico after leaving the WWE. David Bixenspan, CMLL trademarks Sin Cara name/mask in Mexico to block a post-WWE run, CageSideSeats.COM (Jun. 15, 2011, 7:42 PM), http://www.cagesideseats.com/2011/6/15/2226054/cmll-trademarks-sin-cara-name-mask-in-mexico-to-block-a-post-wwe-run (“The idea is that if he eventually leaves WWE and comes back to work full time in Mexico, not only could he not be Mistico in other companies like AAA, but he couldn’t be Sin Cara, either.”).
\bibitem{207} SIN CARA, Registration No. 4440573.
\bibitem{208} SIN CARA, Registration No. 85353048.
\bibitem{209} SIN CARA, Registration No. 85353056.
\end{thebibliography}
\end{footnotesize}
paper products. Sin Cara debuted on television as a masked luchador on April 4, 2011. Under the mask that night was Luis Ignacio Urive Alvirde. Alvirde already had a career as a luchador in Mexico under the name Mistico but took over the Sin Cara name when he moved to the WWE. Quickly, though, Jorge Arias also started to wrestle as Sin Cara when Alvirde was suspended for violating the WWE wellness policy. Both men wrestled as Sin Cara, eventually with two different colored masks, and even competed against each other over the name with Alvirde winning the right to compete under the name. After several rocky years though, Alvirde left the company and Arias ended up as Sin Cara in the WWE by 2014. Sin Cara is still listed on the WWE website with the accomplishments of both Alvirde and Arias listed in the Sin Cara Bio.

At the same time that the two men portrayed the character, the four trademark intent to use applications moved through the USPTO. All four applications received the same concern from the examining attorney: that “SIN CARA” was a stage name for Luis Ignacio Urive Alvirde. The responses from WWE varied slightly: most just denied that it was a stage name identifying an individual, while the response in

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210 SIN CARA, Registration No. 85353064.
213 Id.
217 Sin Cara, supra note 216.
218 SIN CARA, Registration No. 4440573; SIN CARA, Registration No. 85353048; SIN CARA, Registration No. 85353056; SIN CARA, Registration No. 85353064.
219 SIN CARA, Registration No. 4440573 (Offc Action Outgoing); SIN CARA, Registration No. 85353048 (Offc Action Outgoing); SIN CARA, Registration No. 85353056 (Offc Action Outgoing); SIN CARA, Registration No. 85353064 (Offc Action Outgoing).
the entertainment services mark file included the addition, “The mark represents a stage name that is owned by Applicant.”220 The examining attorney did not initially accept the response but did eventually move the application forward without the need for anyone’s written consent.221

The record does not provide a great deal of insight into the thinking of either the examining attorney or the WWE attorney in this case. It appears the examining attorney believed the mark to be a stage name; WWE said no; the examining attorney disagreed; and then, somehow, the two came to an understanding.222 The scant information makes it hard to determine what law either is depending on, other than the standard recitations to 2(c) of the Lanham Act and the TMEP 1206 and 1301.223 More importantly, it can be inferred from the initial issue presented and eventual registration of the mark that the examiner was convinced that SIN CARA did not identify an individual as a stage name.224 Without more in the record, it is nearly impossible to figure out which facts in the case changed the examiner’s mind. Was it the entrance of Arias under the mask of Sin Cara on television during the time the application was pending? Was it the recognition of Sin Cara as a character rather than a stage name? Or was it something else entirely?

Working from analogy, it seems the most logical comparison to the earlier case law would be to In re Florida Cypress Gardens.225 The character of Corky the Clown, at issue in Cypress Gardens, was a character who was portrayed by one or multiple people, in live entertainment, and acted as an identifier of entertainment services for Cypress Gardens.226 Sin Cara, it seems from the record, is also a character portrayed by multiple people, in live entertainment, and acting as an identifier of wrestling entertainment services for WWE.227

Given the similarities, it would seem that the type of precedent set by Cypress Gardens should lead to a similar outcome under the current law of registration without consent for future characters portrayed by more than one individual.

220 SIN CARA, Registration No. 4440573 (Response to Office Action).
221 SIN CARA, Registration No. 4440573.
222 See id.
223 Id. (Outgoing Office Action).
224 See id.
226 Id. at *5.
227 SIN CARA, Registration No. 4440573.
D. Company Men

1. Man? Men? Lunatic Fringe aka Dean Ambrose aka Jonathan Good

On June 18, 2013, WWE filed an application to register the trademark DEAN AMBROSE in entertainment services. The application came approximately seven months after the November 18, 2012, debut of Dean Ambrose at the pay-per-view Survivor Series. Jonathan “Jon” Good had been wrestling under the name Dean Ambrose since he started in the WWE developmental league in 2011. On September 18, 2013, the examiner noted a phone conversation with the applicant’s attorney and made the note “The name DEAN AMBROSE is a fictitious ring name owned solely by the applicant to refer to a particular character in the WWE storylines. The name does not refer to a living individual.” The examiner then amended the record to note “[t]he name DEAN AMBROSE does not identify a living individual.” Without any more issues or drama, the registration was granted on January 21, 2014.

The drama returned, however, when on August 19, 2014, WWE filed an intent to use application for the mark LUNATIC FRINGE. The application proceeded normally with the specimen for use offered on September 10, 2015. The specimen shows a still from a video with three men and a referee in the middle of a wrestling ring with the headline “Dean Ambrose v. Sheamus & Kane—2-on-1 Handicap Match: Smackdown, June 18, 2015 (2:24)” and the caption “The Lunatic Fringe battles the Corporate Demon & The Celtic Warrior.” On September 19, 2015, the examiner sent an Office Action saying LUNATIC FRINGE was the name of a living individual, DEAN AMBROSE, Registration No. 4470627. See WWE Survivor Series (Titan Entertainment broadcast Nov. 18, 2012), available at https://www.youtube.com/watch?v=AuDUiOh_mr8. Dean Ambrose, WIKIPEDIA, https://en.wikipedia.org/wiki/Dean_Ambrose#WWE (last visited May 14, 2016). DEAN AMBROSE, Registration No. 4470627 (Notation to the file). Id. (Examiners Amendment). Id. (Registration Certificate). LUNATIC FRINGE, Serial No. 86,370,179 (Application). Id. (Specimen). Id.
namely Dean Ambrose. The examiner goes on to quote the two-part test found in a number of cases, including the previously discussed In re Hoefflin. The examiner continues by saying that since LUNATIC FRINGE is obviously the nickname or stage name of a wrestler and the industry the service mark is to be used for is wrestling, there is sufficient connection between the individual and the industry to require the consent of the individual pictured in the specimen. To date, the WWE has not offered a response.

The facts here seem somewhat straightforward. The WWE has already registered DEAN AMBROSE and is now registering a secondary nickname for the wrestling persona, LUNATIC FRINGE. It is unclear if the change in perspective from the registration of DEAN AMBROSE to the LUNATIC FRINGE specimen has to do with a sudden realization on the part of the examiner that wrestlers are people or a change in policy. If the policy did change between the 2014 registration of DEAN AMBROSE and the 2015 examination of the specimen of use for LUNATIC FRINGE, it was outside of the updates to the TMEP in April 2014 and July 2015. The only updates to the relevant sections—1206 and 1301—were stylistic updates and a single update to the case citations.

Perhaps the difference has more to do with the previously mentioned questions on how to handle a wrestler’s name. It is clear from the correspondence with the USTPO on the DEAN AMBROSE and LUNATIC FRINGE marks that some examiners are more easily swayed that a wrestler’s ring name is a character name of the WWE, while others insist it is the stage name of a wrestler, requiring the signature of the wrestler before it can be registered.

237 Id. (Office Action Outgoing).
239 LUNATIC FRINGE, Serial No. 86,370,179 (Office Action Outgoing).
240 See id.
241 See TMEP at Change Summary.
242 Id.
243 LUNATIC FRINGE, Serial No. 86,370,179; DEAN AMBROSE, Registration No. 4470627.
2. Gone and Abandoned: Val Venis

Sean Allen Morley has a long and storied wrestling career, spanning multiple decades, federations, and ring names.244 After returning to the ring name of Val Venis in 2003,245 he was released from his WWE contract.246 In his waning years, the WWE sought to register VAL VENIS as a mark for wrestling entertainment services. On June 11, 2007, the USPTO sent an outgoing office action stating that the mark is a name that identifies a particular individual.247 The response from WWE was the same as has been seen in other cases, the simple statement that the mark does not identify a particular living individual.248 On January 14, 2008, the USPTO issued a final office action containing pointed language about the applicant’s denial that the mark VAL VENIS simply does not identify a particular living individual.249

The examining attorney is at a loss to understand how the applicant can aver, through a signed verification, that the name in the trademark does NOT identify a particular living individual when said individual is a professional wrestler, who has wrestled for the applicant. The trademark examining attorney refers to the excerpted materials from the Google® search engine in which “VAL VENIS” appeared in reference to “WRESTLING” in approximately 137,000 stories.251

The examiner presented a distinctly different perspective on the question of whether ring names are characters or are nicknames or stage names of living individuals.

245 Id. Val Venis originally debuted on WWE television on May 18, 1998. Id.
248 Id.
249 Id.
250 Id.
251 Id.
The WWE did send in a request for reconsideration.\textsuperscript{252} In return, the examiner sent back a denial of the reconsideration along with an additional fifty-nine attachments showing various references to the real names of wrestlers and the use of ring names along to identify wrestlers.\textsuperscript{253} Again, this examiner showed a particular flare in his response to the WWE denying the reconsideration and affirming the original final action.

Although the applicant avers that the mark is a character name that can be used by more than one actor, at the applicant’s choosing, there is no evidence that any wrestler’s stage name is passed along to a successor. In fact, while a plethora of websites exist about professional wrestlers, and their stage names, the trademark examining attorney was unable to discover any evidence that it is the practice of professional wrestlers to take over the stage name of another. See attached evidence from Google® and Ask Jeeves®. Accordingly, while the applicant’s argument is rejected as it is unsupported by any evidence and appears to be contrary to manner in which stage names are used by professional wrestlers.\textsuperscript{254}

The WWE did not appeal the finding or respond to the USPTO on this matter. Instead, the USPTO sent the notice of abandonment to the applicant on December 16, 2008.\textsuperscript{255} It could be inferred from the timing of the abandonment that WWE might have chosen to pursue and fight the findings of the examiner, had Val Venis not been close to the end of his career at WWE.

Even if WWE did not respond to the examining attorney, we can still glean some information from the attorney’s writing. The response of the examiner represents a departure from the other cases in that it shows the examiner clearly stating that the ring name of a wrestler should be considered as a stage name, rather than as a character name.\textsuperscript{256} The examiner points out that he or she is “at a loss”...
to understand how someone who has wrestled under a name for over a
decade could deny that the ring name of the wrestler identifies the
living person of the wrestler. In contrast to the other applications
discussed, where the examiner takes the simple rejection that the mark
identifies a living individual or allows for the argument that a ring
name is more akin to a character name, this examiner does not buy it.

Underneath the argument of the examiner is also a number of
unspoken assumptions. First, the examiner assumes that the ring name
or stage name of the wrestler must be used by the public to identify the
person who is employed by WWE as the wrestler because a name is
generally only used by one wrestler. The assumption is not without
support or merit. In the second correspondence, the examining attorney
did provide comprehensive lists of individuals who only use one
wrestling name. Given the list the examiner provides, it would be
easy to assume a one-to-one identification of wrestlers to their names.

Second, the examining attorney consistently uses the word
“stage name” when referring to the character or ring name of the
wrestler. When this one-to-one association exists, stage names may
be a good analogy for ring names in some cases. Like the stage name
LOLLIPOP PRINCESS in In re Folk, wrestler ring names are
generally used consistently by one person to identify themselves to an
audience. Stage names are put in the category of “first names,
surnames, shortened names, pseudonyms, stage names, titles, or
nicknames” in TMEP 1206. Individuals who use stage names are
entitled to protection from unwanted registration of the stage name

As the examples discussed in this article show, however, it is
not a hard and fast rule that only one person plays a character. On
this point, the examiner is clearly missing some of the facts. Given the
type of research the examiner provides in his attachments, it does not

257 Id.
258 Id. (Attachments to Reconsideration Letter).
259 Stage name is defined as “the name, different from his or her real name, that an actor
or performer is publicly known by.” Stage Name, CAMBRIDGE DICTIONARIES ONLINE,
http://dictionary.cambridge.org/us/dictionary/english/stage-name (last visited May 14,
2016).
261 TMEP 1206.01 (Oct. 2015).
262 TMEP 1206.
appear that the examiner knew how to search for exceptions.\textsuperscript{265} The examiner searches for ‘‘wrestler’s successor’ + ‘ring name’’ and comes up with no results.\textsuperscript{266} It seems the examiner might be able to take a lesson away from this—sometimes people in the industry are able to find information more readily than a trademark examiner.

The lesson for WWE and the general public attempting to register a ring name as a service mark is that the examiners at the USPTO do not appear to be in agreement on how to treat the requests. With various outcomes for ring names that seem to defy easy categorization, the USPTO should push toward consistency in a few areas where consistency does not currently exist—whether to treat ring names not based on the given name of the wrestler as personal names identifying individuals or to treat them as character names. In the next section, I offer a model that would provide consistency and serve the needs of both the company and the individual wrestlers.

IV. THE AUTHORITY VS. THE WRESTLERS—COMPETING INTERESTS IN TRADEMARK PROTECTION AND A POSSIBLE MODEL TO MOVE FORWARD

A. The Company Line: Economic Incentives to Continue to Create

Wrestlers in the WWE are employed as independent contractors by WWE.\textsuperscript{267} The company must invest in order to develop the storylines and promotions.\textsuperscript{268} The company provides writers, infrastructure, venues, and overhead necessary to create live wrestling events.\textsuperscript{269} As such, the company has an economic interest in the intellectual property of its card of wrestlers.\textsuperscript{270} To provide an arena—both literally and figuratively—for the wrestlers to practice their craft,

\begin{itemize}
\item \textsuperscript{265} U.S. Trademark Application Serial No. 77,142,336 (filed Mar. 28, 2007) (Attachments to Reconsideration Letter).
\item \textsuperscript{266} Id.
\item \textsuperscript{267} David Cowley, Employees vs. Independent Contractors and Professional Wrestling, 53 U. LOUISVILLE L. REV. 143, 148 (2014) (“Yet the WWE circumvents providing almost all benefits by ingeniously classifying their wrestlers as independent contractors rather than employees, despite the resemblance to a classic employer-employee arrangement.”).
\item \textsuperscript{268} Daniel Bilsky, From Parts Unknown: WWE v. Jim Hellwig in the Ultimate Battle for Character Copyright, 19 MARQ. SPORTS L. REV. 419, 436 (2009).
\item \textsuperscript{269} Id. at 435.
\item \textsuperscript{270} Id. at 436.
\end{itemize}
the company should be able to register the trademarks for which they helped to create.

The case of CORKY THE CLOWN most resembles these situations. As such, when the company creates the ring name of the wrestlers, the company should be able to register the ring name as a trademark or service mark without the consent of the individual who portrays the character in the ring. Like the names of the individual performances and performers in Cypress Gardens, the ring names of the wrestlers act as “registration of marks which identify a particular feature” from the larger entertainment company.

B. Everybody Roots for the Face: Independent Contractors and Right to Publicity

Wrestlers who work for WWE are treated by the company as independent contractors. The wrestlers lack many of the protections of the classic employer-employee relationship. “[T]he wrestlers are unable to bargain collectively through a union, and the company is absolved from providing health insurance, Social Security and Medicare contributions, and unemployment insurance.” It should be noted that “[i]n many respects, the WWE takes good, if not exceptional, care of its talent.” Still, most of the 140–150 wrestlers on the roster are not necessarily in a place to bargain. The contracts are generally standard contracts and contain a provision assigning the rights of the name and likeness of the wrestler to the company. The contractors, therefore, do not leave much room for the protection of the wrestler as a celebrity after leaving the employment of the company.

272 Id.
275 Id.
276 Id.
277 Id. at 150.
278 Id. at 149.
The wrestlers may also have some additional protections at the state level through the right of publicity. The right of publicity is the right of individuals to protect “any symbol that the public associates primarily with the plaintiff, including names and nicknames, visual images, vocal likeness and other ‘signature’ symbols.” The right protects the “commercial exploitation” of people’s identities through state-level actions either in statute or at least at common law. Notably, celebrities from Muhammad Ali to Johnny Carson have been able to stop others from not only using their given names but also from using their nicknames and stage names. An actor can even become so inextricably linked with their character that the character may be indistinguishable by the public from the actor.

The Supreme Court in Zacchini v. Scripps-Howard Broadcasting Co. argued the purpose of the right is to both prevent unjust enrichment and to provide an economic incentive (protection) for performances. Importantly, the right to publicity is usually treated as a form of property in that it can be assigned or contracted to another. Given the contracts of the WWE, the wrestler is likely contracting the rights of publicity to the company as well. If the wrestlers are not careful, they may be signing away more than they know.

C. You Get What You Brought In: A Model Based on Prior Identification

Based on the case law, analysis of some example cases, and needs of both parties, the USPTO should create a standard for the registration of wrestling ring names as marks that both provides some

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280 LALONDE, supra note 29, at § 2B.02.
281 4-57 INTELLECTUAL PROPERTY COUNSELING & LITIGATION § 57.07 (2015).
284 LALONDE, supra note 29, at § 2B.02.
285 McFarland v. Miller, 14 F.3d at 912 (3d Cir, 1994) (“We also hold that there is evidence on this record which shows that the name Spanky McFarland has become so identified with McFarland that it could be considered his own name or the name of a character so associated with him as to be indistinguishable from him in public perception.”).
287 LALONDE, supra note 29, at § 2B.05.
consistency and balances the needs of the company with those of the wrestlers. In order to provide consistency, the USPTO should treat the wrestling ring name marks in two categories: (1) names directly related or identical to the real world name of the wrestler or the name commonly used by the wrestler before contracting with the trademark applicant; and (2) names created by the company.

For the first category, the USPTO should treat the names as “identifying a particular living individual.” Names you bring in should be treated as names—both your own and ones used before as stage names in a professional capacity. Not only would this allow the wrestlers a choice in bargaining, albeit a fairly weak one, it would still allow names brought to the company to be treated as assets in a contract negotiation. The USPTO should use the same principles expressed in the cases involving non-character names to determine how far to extend the protection.

For the second category, the USPTO should treat created characters names as just that—names of characters. As such, the USPTO should not require the consent of the wrestler known by the company-created name to register the name as a mark. As mentioned above, the USPTO should turn to In re Cypress Gardens for guidance in these cases, as well as In re Folk.

By applying the two different categories to all wrestling ring name related trademarks, the USPTO would provide consistency and balance to a currently inconsistent area of practice. The examiners and attorneys could get in the ring, run the ropes, take some bumps, and know exactly what the outcome would be every time. Just like the pros.

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291 Shoemaker, supra note 160 (“[B]ump (n.) — A move taken in the ring resulting in a hard fall or landing, or (as a verb) to take such a move. It can also refer to the act of selling.”).