

## Odds May Be In Luka Doncic's Favor To Erase Mom's TM

By **Tiffany Hu**

*Law360 (October 20, 2022, 6:53 PM EDT)* -- Dallas Mavericks star Luka Doncic's fight with his mom over her rights to a trademark bearing his name may help shed light on whether individuals can revoke their consent allowing others to register trademarks, and attorneys told Law360 that Doncic has several arguments in his favor.

Last week, Mirjam Poterbin asked the Trademark Trial and Appeal Board to reject a challenge leveled by her 23-year-old son that seeks to cancel a registration Poterbin owns on her son's name. Doncic had tried to register trademarks using his name, but an examiner rejected the applications in March after citing his mother's registration.

In his cancellation petition last month, Doncic claimed that he consented to Poterbin's applying for the mark "at a very young age" — when he was 19 — but that he had since started his own company and was no longer "affiliated or associated" with his mother or the goods or services in the registration.

Poterbin points out that Doncic expressly authorized her to register the mark, citing a one-sentence statement in 2018 — the year he was drafted in the NBA draft — that he consented to the use and registration of his name by her as a trademark. His later revocation of that consent had very little bearing on the validity of the mark already issued, she said.

Doncic, who hails from Slovenia, made his professional debut at 16 with the Spanish basketball team Real Madrid, before being drafted to the Atlanta Hawks, which quickly traded him to the Mavericks. Last August, Doncic signed a five-year deal with the Mavericks worth over \$215 million.

Counsel for Doncic and Poterbin did not immediately respond to requests for comment.

Trademark law is silent on whether consent can be revoked for cancellation purposes, and the TTAB doesn't appear to have considered the issue before, attorneys told Law360. But Doncic may be able to rely on other arguments to get the board to cancel his mom's rights, they said.

Poterbin "may argue that the silence in the Lanham Act regarding mechanisms to withdraw that consent makes the consent irrevocable and the registration not subject to cancellation, but that does not appear to be supported by the statute or any case law," said J.P. Oleksiuk of Cooley LLP.

For his part, Doncic could tackle the validity of the agreement itself, which "looks pretty bare bones," and whether there was consideration — or a benefit from the deal — to Doncic for giving his mother the

right to use and register the name that would make it a valid agreement, according to University of Richmond law professor Ashley Dobbs.

Generally speaking, the consideration needs to be identified in the written agreement and be "present" consideration, not something that was already given or abstained from prior to signing the agreement, according to Dobbs. For now, it seems that "there could be ways to argue around the lack of consideration in the document itself," she said.

"In discovery, the parties may discover the necessary evidence to cure the issue, but on its face, I don't see where there is a 'bargained-for exchange,'" Dobbs said.

There's also the issue of whether Poterbin was acting solely as Doncic's mother or as his business agent when he agreed to let her register the trademark on his name, said Mark Sommers of Finnegan Henderson Farabow Garrett & Dunner LLP.

If she was helping manage his business, and giving her the right to use and register Doncic's name was part and parcel of managing his business, "then she has a fiduciary duty to do that for the benefit of the business, and not to personally profiteer from it," Sommers told Law360.

And when Doncic shifted his business operations, the goodwill of the mark would have gone to another business, and the registration should have been assigned to him, Sommers added.

If Doncic can show that he or his company isn't connected with the activities of his mother under the trademark, then the basketball player could prevail on his claim that the registration falsely suggests a connection with him, according to Perla M. Kuhn of Fox Rothschild LLP.

"This requirement could easily be met because Doncic has his own business and does not promote or endorse the activities of his mother under his name," Kuhn said, adding that his mom's use and registration of his name as a trademark could also violate his right of publicity.

Doncic is also arguing that Poterbin abandoned the trademark, but he may not fare as well with regard to that claim, some attorneys say. Poterbin's registration on the mark was granted based on a foreign registration, instead of by showing use of the mark in the U.S., according to Virginia Marino of Crowell & Moring LLP.

When trying to cancel those types of registrations, there usually needs to be a consecutive three-year period in which the mark is not used after the date of registration to support the presumption of abandonment, Marino said.

"The trademark registration at issue here registered less than three years ago, so Doncic may have some difficulties supporting his abandonment argument," Marino said.

There have been other trademark disputes involving families of athletes, though they don't appear to be as directly confrontational as the present fight between Doncic and his mom. In August, ABG Shaq LLC — Authentic Brands Group's company tied to Shaquille O'Neal — opposed an application from Shaq's son Shaqir O'Neal to register a trademark on his own name.

Last month, Muhammad Ali Enterprises LLC — another ABG company associated with the famed boxer — filed an opposition against Ali's daughter, Laila Ali, over her trademark application for her name.

Doncic's challenge at the TTAB is still in its early stages, and there may be other agreements between the two or facts over their course of dealing that could ultimately determine whether Doncic can fully retake control of his identity, Cooley's Oleksiuk said.

"This dispute illustrates the ongoing balancing act between viewing trademarks as property rights, protecting consumers from confusion with trademark law, and the general public policy in favor of permitting people to use their own name in business," Oleksiuk said.

The outcome of the case also could significantly impact young adults who are contemplating various name, image and likeness, or NIL, deals, according to Marino of Crowell & Moring. In June 2021, the National Collegiate Athletic Association announced that it would suspend rules forbidding college athletes from being paid for the use of their NIL.

"Those athletes, as well as their families, agents and those companies with whom they are signing endorsement deals, should be paying close attention to this space," Marino said.

--Editing by Robert Rudinger.