LEOPOLDUS LAW

TRADEMARKING YOUR

NAME AND BRAND

How athletes and entertainers turn a name into an asset, register it, and protect it

BRANDON LEOPOLDUS, ESQ.

READ THIS FIRST

YOUR NAME IS AN ASSET. IT DOES TWO JOBS AT ONCE.

Once you are known, your name sells things, and it belongs to you. The law gives you two separate tools to protect those two jobs, and most athletes use neither until someone else has already made money off them.

The first tool is a trademark. It protects a name, logo, or catchphrase you use to sell goods and services, so that when a fan buys the hat, they know it came from you. The second is your right of publicity, your control over the commercial use of your own identity: your name, your face, your likeness, your voice. They overlap, they are not the same, and you want both working for you.

Here is the mistake I watch athletes make. They wait. They wait until the breakout game, the viral moment, the shoe deal, and only then start thinking about protecting the brand, by which point the window has half closed and someone is already selling counterfeit shirts. This guide is about doing it in the right order, early, cheaply, and correctly, so the value of your name lands in your account and not somebody else's.

THE WHOLE GUIDE, IN ONE LINE

BUILD THE RIGHTS. REGISTER THEM. PARK THEM WHERE THEY ARE PROTECTED.

SECTION I

TWO RIGHTS, NOT ONE

KEEP THE TWO TOOLS STRAIGHT; THEY ANSWER DIFFERENT QUESTIONS

A trademark answers "who is the source of this product?" It protects a word, phrase, symbol, or design that identifies your goods or services in the marketplace. Your right of publicity answers "who controls the commercial use of my identity?" It protects the economic value of your name, image, and likeness from being used, without your consent, to somebody else's advantage.

You need both because they cover different ground. A trademark lets you own and enforce the brand you build. Your right of publicity lets you control, and get paid for, the use of you. One protects the brand you create. The other protects the person you already are.

FEATURE	TRADEMARK	RIGHT OF PUBLICITY
WHAT IT PROTECTS	A mark that identifies the source of goods or services	The commercial value of your identity: name, image, likeness, voice
WHERE IT COMES FROM	Federal Lanham Act, plus state law	California statute (Civ. Code § 3344) and the common law
WHAT YOU MUST SHOW	Distinctiveness; a personal name needs secondary meaning	Use of your identity, to another's advantage, without consent, causing injury
HOW LONG IT LASTS	Indefinitely, as long as it is used and renewed	Your life, and descendible for decades after death
DO YOU REGISTER IT?	Yes, at the USPTO, and you should	No registry to hold it; deceased-personality rights are registered with the state
CLASSIC ATHLETE USE	Your logo, catchphrase, or brand name on merchandise	Endorsements and NIL deals; stopping the unauthorized use of your face

SECTION II

WHAT A TRADEMARK ACTUALLY PROTECTS

A SOURCE IDENTIFIER, NOT A FENCE AROUND A WORD

A trademark protects a mark to the extent that mark tells the buying public that a good or service comes from you and not someone else. That single idea explains almost every rule that follows, including why some marks are strong and some are nearly worthless. Marks live on a spectrum of strength. The more distinctive your mark, the more the law will do for you. Pick a strong one when you can.

/ THE SPECTRUM OF STRENGTH

WEAKEST	**GENERIC** The common name for the thing itself. Gets no protection at all.
WEAK	**DESCRIPTIVE** Just describes the thing. Protected only once the public has come to associate it with you: secondary meaning.
MODERATE	**SUGGESTIVE** Hints at the product without describing it outright. Protected without proof of secondary meaning.
STRONGEST	**ARBITRARY OR FANCIFUL** A coined word, or a common word used for something unrelated. The widest protection the law gives.

DID YOU KNOW?

A mark that is primarily merely a surname sits with the descriptive category by default. That matters enormously for athletes, because your own last name is exactly the kind of mark the law treats with suspicion until you prove otherwise. Section III covers how fame fixes that.

SECTION III

THE NAME PROBLEM, AND HOW FAME SOLVES IT

WHY YOUR OWN LAST NAME STARTS OUT AS A WEAK MARK

The law treats a personal name, and especially a surname, like a descriptive term. A mark that is primarily merely a surname is not registrable or protectable on its own. You have to show that it has acquired what the law calls secondary meaning: that when the public hears the name, they think of you as the source, not just of a person who happens to share it. A common surname does not clear that bar until the public connects it to you specifically.

The good news is that fame is exactly what builds secondary meaning. As your name becomes known for what you do, the public starts associating it with you, and that association is the thing the law protects. This is why timing matters so much. The more recognized your name becomes, the stronger your claim to it, and the more valuable it is worth registering and defending.

/ REGISTRATION IS THE MOVE THAT LOCKS IT IN

A federal registration on the Principal Register is prima facie evidence that your mark is valid and that you have the exclusive right to use it. That presumption is worth a great deal the day you have to enforce the mark against someone selling knockoffs. Owning the paper shifts the fight in your favor.

2 FAME BUILDS SECONDARY MEANING. SECONDARY MEANING IS WHAT THE LAW PROTECTS.

SECTION IV

FILE IT RIGHT: CLASSES, GOODS, AND SPECIMENS

WHERE GOOD FILINGS ARE WON AND BAD ONES DIE

You register a mark for specific goods and services, sorted into numbered international classes. You do not register a name in the abstract. You register it for what you actually sell. First, file in the classes that match what you truly do. Second, be careful with the apparel class: it expects you to actually manufacture and sell tagged garments. Claim the ground you actually stand on, and within a class, claim as many legitimate goods and services as the rules allow.

/ SPECIMENS WIN APPLICATIONS

A specimen is your proof that the mark is really used in commerce, and this is where I tell my team to overwhelm the examiner. Do not submit one thin screenshot. Pull everything: the logo on the sponsored-event signage, the mark on your website, the branded posts across your social handles, the activation at the big event. The more real, in-commerce use you show, the more inclined the examiner is to approve you. One move most filers skip: a short cover letter that tells the reviewing attorney who the applicant is and why the name is notable. Small effort, real edge.

/ WORD MARK OR LOGO?

WORD MARK · SECURE FIRST

The name itself. Covers the words however they are styled. The strongest and most flexible protection, and it does the most work when budget is tight.

LOGO

Protects only that specific design. You can use an unregistered logo, but it is far harder to enforce against a copycat. Register it too if the logo matters.

DID YOU KNOW?

You do not have to wait until you are using a mark to claim it. Federal law lets you file based on a bona fide intent to use the mark, staking your priority before the product even ships. Section V shows exactly why that matters.

SECTION V · CASE STUDY

MOVE BEFORE THE BREAKOUT

This is the section athletes learn the hard way. A young receiver has a breakout that nobody, including his own marketing team, saw coming. The demand is there overnight, the shoe offers start, and there is no trademarked logo, no merchandise line, nothing ready to sell. The moment arrives and he cannot monetize it, because the brand infrastructure did not exist yet. The window narrows while the paperwork catches up.

PROBLEM

No trademark filing. No merchandise ready. Demand shows up overnight and the athlete has nothing built to capture it.

THE FIX, IN ADVANCE

Federal law lets you file based on a bona fide intent to use the mark, staking your priority before the product ever ships.

THE MOVE

Lock in the name and the logo, get the merchandise ready to go, and be positioned to capitalize the day the profile jumps. Have it built before you need it. The cheapest and most valuable time to protect a brand is right before the world decides it wants one.

FILE ON INTENT TO USE. NOT ON HINDSIGHT.

SECTION VI

ENFORCING IT: THE CONFUSION QUESTION

A TRADEMARK IS ONLY WORTH WHAT YOU CAN ENFORCE

The core question in any infringement fight is whether the public is likely to be confused about the source of the goods. Courts in this circuit weigh eight factors to decide it. No single factor controls, and the test bends to the facts.

1. The strength of your mark
2. How related the goods are
3. How similar the marks are
4. Any actual confusion
5. The marketing channels used
6. The care a buyer typically uses
7. The other side's intent
8. Likelihood you expand into their lane

Registration widens your options. With a registered mark you sue under the statute for infringement of that registration. Even without a registration, you have a claim for the unauthorized use of a mark that is likely to confuse, but you carry a heavier burden to prove your rights. And if your name becomes truly famous, a separate theory protects it from dilution, even without confusion, though "famous" there is a high bar reserved for the household names.

THE PRACTICAL LESSON

Register early, keep your proof of use, and you turn enforcement from an uphill argument into a presumption in your favor.

SECTION VII

THE OTHER RIGHT: YOUR NAME, IMAGE, AND LIKENESS

THE LEGAL ENGINE UNDER EVERY ENDORSEMENT AND NIL DEAL

Trademark protects the brand you build. Your right of publicity protects the person you already are. In California it comes from two places at once: a statute covering any living person whose name, voice, signature, photograph, or likeness is used for commercial purposes without consent, and a parallel common law right. Together they are the legal engine under every endorsement and NIL deal you sign.

The elements are straightforward: someone used your identity, to their advantage, without your consent, and it caused you injury. That is the claim you hold against an advertiser who runs your face without a deal, and it is the same right you license, for money, when you do sign one. Your publicity right is not just a shield. It is the asset you rent out.

/ IT ALSO OUTLIVES YOU

California protects the publicity rights of deceased personalities, and those rights are descendible and freely transferable for decades after death. This is the lunchbox principle. A star can be gone fifty years and still be on the merchandise, and that money goes somewhere, to whoever holds the rights. If your name will carry value past your playing days, and past your life, this is the right that carries it forward for the people you choose.

7 YOUR PUBLICITY RIGHT IS NOT JUST A SHIELD. IT IS THE ASSET YOU RENT OUT.

SECTION VIII

WHAT YOUR RIGHTS DO NOT COVER

THE HONEST LIMITS, SO YOU DON'T PICK FIGHTS YOU LOSE

Neither of these rights lets you control what people say about you or shut down commentary you dislike. They protect commercial value, not reputation, and not the news.

/ THE NEWS AND SPORTS-ACCOUNT EXEMPTION

The right of publicity yields to free expression. California's own statute exempts uses connected to news, public affairs, or sports accounts, and courts read "public affairs" broadly. When retired ballplayers sued over the use of their names, statistics, and old game footage in historical and informational material, they lost: the public's interest in the history of the game outweighed their claim. You cannot use your publicity right to tax the telling of your own career.

/ EXPRESSIVE WORKS GET BREATHING ROOM

When a work adds significant new creative expression, transforming your likeness into something more than a straight reproduction, the First Amendment protects it, even if it is sold for profit. A literal knockoff made only to cash in on your fame is different, and that you can stop. The line is whether the new work adds real expression or just copies you to sell copies of you. Profit alone does not decide it.

> **The takeaway:** your rights protect the commercial use of your identity, not the story of your career or a genuinely creative reinterpretation of it. Save your enforcement energy for the knockoffs, not the commentary.

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BY THE TIME IT IS WORTH STEALING, YOU WANT IT ALREADY YOURS.

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SECTION IX

HOLD THE RIGHTS IN THE RIGHT PLACE

THIS IS THE POINT THAT TIES THIS GUIDE TO THE REST OF YOUR BUSINESS

Do not hold these valuable rights loose in your own name. Your marks and your publicity rights are intellectual property, and they belong inside the same kind of entity that holds the rest of your off-field business, the LLC or, in time, the trust behind it.

/ THE WHOLE ARCHITECTURE

1

THE ENTITY HOLDS THE INTELLECTUAL PROPERTY

Registering the marks in the entity, and licensing your name and likeness through it, centralizes the asset.

2

THE TRADEMARK AND PUBLICITY RIGHT PROTECT IT

Two separate legal tools, both working for the same asset, both held by the same owner.

3

THE LICENSES TURN IT INTO INCOME

Licensing income channels where your tax and liability planning already lives, inside the entity built to receive it.

4

THE ESTATE PLAN HANDS IT OFF

A clean handoff of that value to your family when the descendible rights matter most, planned in advance rather than discovered after the fact.

THE WHOLE POINT

Build the rights, then park them where they are protected and productive.

SECTION X

WHAT TO DO NEXT

NONE OF THIS IS EXPENSIVE EARLY. ALL OF IT IS EXPENSIVE LATE.

If your name is starting to carry value, here is the order of operations.

- [ ] Decide what you are actually building a brand around: your name, a logo, a catchphrase, a program.
- [ ] Search first. Make sure the mark is clear before you invest in it or file.
- [ ] File the word mark in the classes that match what you truly do, and file on an intent-to-use basis if you are not selling yet.
- [ ] Gather strong specimens of real use, and add a cover letter that tells the examiner who you are.
- [ ] Register the logo too if it matters, and keep your proof of use for the day you enforce.
- [ ] License your name, image, and likeness deliberately, in writing, for every deal.
- [ ] Hold the marks and publicity rights inside your entity, and plan the descendible rights into your estate.

THE ATHLETES WHO OWN THEIR NAME PROTECTED IT BEFORE THE WORLD WANTED IT.

ABOUT THE AUTHOR

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Founder, Leopoldus Law, APC

Brandon Leopoldus umpired professional baseball before he ever practiced law. That path, through Minor League Baseball, an Olympic family, and time on the field at every level of the game, is the lens he brings to every athlete he represents at Leopoldus Law, APC.

100+	25+	3	6	4
ATHLETES ADVISED	SPORTS	LEAGUES LAUNCHED	PRO TEAMS	GOVERNING BODIES

Leopoldus Law is a sports and entertainment boutique in Culver City, California. Brandon and his team register trademarks and structure name, image, and likeness rights for athletes and entertainers, and hold that intellectual property inside the entities and estate plans built to protect it.

He sits on the board of the Sports Lawyers Association and teaches Sports Law at Loyola Law School. The firm works with athletes, entertainers, and the people who advise them. Sports clients only. No exceptions.

A NOTE ON HOW TO USE THIS GUIDE

This guide is educational. It explains how athletes and entertainers commonly protect their names and brands, and it is written to make you a sharper client, not to replace one. It is not legal advice for your situation, and reading it does not make Leopoldus Law your lawyer.

Trademark and publicity law vary by state and change over time, and the right strategy depends on facts this guide cannot know. Search, file, and enforce with your own attorney. If you would like that attorney to be us, reach out.

REACH OUT

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ENDNOTES

1 15 U.S.C. § 1052(e)(4), (f) (a mark that is primarily merely a surname is registrable only on a showing of acquired distinctiveness, that is, secondary meaning).

2 *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 873, 876-77 (9th Cir. 1999) (a mark that is primarily merely a surname is not protectable unless it acquires secondary meaning; federal dilution protection requires that a mark be truly famous, a showing greater than mere distinctiveness).

3 15 U.S.C. § 1057(b) (a certificate of registration on the Principal Register is prima facie evidence of the validity of the mark and of the registrant's exclusive right to use it in commerce).

4 15 U.S.C. § 1051 (application for registration; subsection (a) covers marks already in use, subsection (b) covers a bona fide intent to use a mark).

5 *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (setting out the eight-factor test for likelihood of confusion).

6 15 U.S.C. § 1114 (civil liability for infringement of a registered mark).

7 15 U.S.C. § 1125(a) (false designation of origin; protects unregistered marks against a likelihood of confusion).

8 15 U.S.C. § 1125(c) (dilution of famous marks).

9 Cal. Civ. Code § 3344 (statutory right of publicity for living persons; subdivision (d) exempts uses in connection with any news, public affairs, or sports broadcast or account).

10 *Gionfriddo v. Major League Baseball*, 94 Cal. App. 4th 400, 409, 411, 415 (2001) (stating the elements of common law appropriation and holding that the public interest in news, public affairs, and sports accounts outweighed retired players' right of publicity in their historical names and images).

11 Cal. Civ. Code § 3344.1 (statutory right of publicity for deceased personalities; the right is descendible and freely transferable).

12 *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 391, 404-07 (2001) (California recognizes both a statutory and a common law right of publicity; a work containing significant transformative elements is protected by the First Amendment against a right-of-publicity claim).

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