Two iconic brands – Federer's uncertain hope to obtain the RF logo from Nike

Baker Donelson - USA
Adam S Baldridge, Nicole Berkowitz

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Adam S Baldridge

Nicole Berkowitz

BAKER DONELSON

In March 2018 Roger Federer's 21-year relationship with Nike ended and in June 2018 Federer entered into a $300 million deal with Uniqlo, a Japanese clothing company. Although Nike no longer has a clothing contract with Federer, it still owns the trademark registration for the iconic stylised RF logo in various registries across the world in classes covering clothing and footwear (US Trademark Registration 3,838,371). On 2 July, during a press conference at Wimbledon, Federer suggested that he would one day gain the rights to the RF mark, stating:

> *The RF logo is with Nike at the moment, but it will come to me at some point. I hope rather sooner than later, that Nike can be nice and helpful in the process to bring it over to me. It's also something that was very important for me, for the fans really. Look, it's the process. But the good news is that it will come to me at one point. They are my initials. They are mine. The good thing is it's not theirs forever. In a short period of time, it will come to me.*

From a legal perspective, it is not clear why Federer is so optimistic about recovering the RF mark. Perhaps some provision of his contract with Nike provided him with the right to one day receive such rights. Federer is one of the most famous athletes of all time. He has won more majors than any male tennis player in the so-called 'open era' and he is admired all over the world, not only for his excellence on-court, but also for his humble attitude and family-man persona off-court (FP Staff, *Federer Most Trusted, Respected After Mandela in the World*, FirstPost, 21 September 2011).

Short of a contractual provision, Federer may be attempting to look to his right of publicity for the logo, which includes his initials. However, US jurisdictions are divided over whether foreign individuals such as Federer can claim a right of publicity in the United States. Whether a person's initials are entitled to the same protection as their name may be another issue, as well as whether Federer could satisfy the elements of an actionable claim. However, likely the biggest issue here is whether Federer gave Nike consent in his contract to use his initials when Nike originally developed the RF logo and applied for the trademark registration in 2008. Whether Nike's continued use of the RF logo after the expiration of its agreement with Federer exceeds the scope of Federer's consent would depend on the specific language in the agreement. For example, see:

- *Sharman v C Schmidt & Sons, Inc,* 216 F Supp 401, 405-06 (ED Pa 1963), which considered whether the use of plaintiff's photograph exceeded the authorisation of his release to use the photograph; and
- *Cepeda v Swift & Co*, 415 F2d 1205, 1207-08 (8th Cir 1969), which found that the use of a baseball player's name and likeness in advertising materials affixed to meat products was within the scope of his agreement with Wilson Sporting Goods Company.

Federer may explore arguments relating to trademark law, but such arguments are likely to be unavailing. The law permits the use of a person's name or initials as a trademark when the name or initials function as a source identifier and have obtained secondary meaning (eg, *Experience Hendrix, LLC v Electric Hendrix, LLC*, 2008 WL 3243896, at *4 (WD Wash 7 Aug 2008), *Pirone v MacMillan, Inc*, 894 F2d 579, 583 (2d Cir 1990) and *Stephano Bros v Stamatopoulos*, 238 F 89, 93-94 (2d Cir 1916), discussing the history of trademarking names). Quoting *Abraham Zion Corp v Lebow*, 761 F2d 93, 104 (2d Cir 1985), the decision in *Experience Hendrix* at *4 stated that:

> *Marks acquire secondary meaning when 'the name and the business have become synonymous in the mind of the public, submerging the primary meaning of the term in favor of its meaning as a word identifying that business'.*

Even harder for Federer is the fact that the RF mark achieved incontestable status in 2015, which means that the validity of the mark can be challenged only "on the grounds that it is generic, it has been abandoned, it is fraudulently used by the registrant or it was obtained fraudulently" (*id* at *5).

One additional consideration is copyright protection and ownership of the RF logo. If there is a sufficient amount of minimal creativity in the RF logo, which meshes together the two letters in a stylistic font, to satisfy the modicum of creativity required to be protectable by copyright law (*Feist Publ'ns, Inc v Rural Tel Serv Co*,

499 US 340, 345 (1991)) then the issue will likely come down to:

- who created what;
- whether the work is a work for hire; and
- what the parties' agreement says on the issue.

Because publicity rights, trademark rights and copyright avenues to obtain rights in the RF logo look challenging at best for Federer, his hope may rely on:

- whether the contract provides that the RF logo will one day be assigned to him; or
- whether his lucrative relationship with Nike may one day persuade Nike to voluntarily transfer the rights to him, possibly for an additional fee.

Whichever route the RF logo takes, as Federer mentioned at Wimbledon, he does not have a shoe deal and he could still work one out with Nike – so the Nike-Federer relationship may live on.

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For further information please contact:

Adam S Baldridge
Baker Donelson
www.bakerdonelson.com
Email: abaldridge@bakerdonelson.com
Tel: +1 901 526 2000