

NEW NAME, SAME TEAM: THE INTELLECTUAL PROPERTY REALITIES OF CHANGING A PROFESSIONAL SPORTS TEAM NAME

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INTRODUCTION

In light of recent social justice movements, sports team nicknames have been placed under a larger microscope than possibly any time before now. Discussions surrounding team names have recently prompted at least two professional organizations—the Washington Football Team and Cleveland Guardians—to move away from racially-insensitive names. These franchises were not the first sports entities to change their name and they will certainly not be the last. This Essay seeks to provide a short guide of the legal considerations for changing a team’s name.

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The National Football League (NFL) and NFL Properties LLC, which controls the merchandising and licensing for all thirty-two teams in the American Football Conference and National Football Conference, takes branding and use of teams' rights incredibly seriously. As part of enforcement efforts, NFL Properties LLC and various NFL teams have filed lawsuits against other parties who use the phrase "Super Bowl" without consent and counterfeiters who sell goods that are not officially licensed but bearing the trademarks of various teams. Owning and possessing valid trademark registrations is key to these efforts. All teams must control such trademark registrations to initiate lawsuits in federal court and seek statutory damages in connection with alleged trademark infringement. Failure to possess such registrations may also diminish the impact that demand letters may otherwise have on intended recipients.

Sports franchises should not only take their time and conduct the requisite diligence in coming up with appropriate and cleared branding before they are first announced, but they must also take such care in any rebranding efforts. Failing to appreciate the importance of trademark diligence will often result in frustrations for the franchise that may include a failure to register important brand identifiers as well as result in the worst consequence, being named a defendant in a public, high-profile lawsuit. Part I of this Essay discusses past and ongoing franchise name changes in professional sports. Part II addresses the intellectual property considerations franchises must consider when changing their name, and Part III explains how a franchise can make the appropriate corporate changes to finalize name changes with its Secretary of State (or other applicable body).

I. SPORTS TEAMS CHANGING THEIR NAME

While team names have recently been in the spotlight, there is not a robust history of professional sports franchises changing their names. Part A of this section considers the history surrounding two professional sports franchises that changed their name in the past. Lessons from these teams' name change are still relevant today. Part B of this section considers the current landscape as two professional sports franchises have recent or ongoing name changes with name change legal hurdles.

A. *Changes in the Past*

1. Washington Bullets

“Faster than a speeding bullet”—that was the slogan of the Baltimore Bullets when the team was purchased by Abe Pollin in 1964.¹ After moving to Landover, Maryland, in 1973 and becoming the Washington Bullets a year later,² the name stuck for more than twenty years—enough time to watch Wes Unseld and Elvin Hayes win an NBA championship, which paved the way for consistent success.³ Yet, eventually the name’s social and political implications grew too much to bear for Pollin. The straw that broke the camel’s back was, unfortunately, a literal bullet. In November of 1995, Israeli Prime Minister Yitzhak Rabin was shot twice by a Jewish ultranationalist while attending a Tel Aviv peace rally.⁴ He was a close friend of Pollin’s.⁵ Not even a week later, Pollin announced that he was changing the team’s name.⁶ Although Pollin made the announcement quickly, it was not out of the blue; Pollin mentioned in May of 1995 the team may re-name itself.⁷ In fact, Pollin said he had been thinking about changing the name for thirty-one years.⁸ Pollin said in 1995, “Bullets connote killing, violence, death . . . Our slogan used to be, ‘Faster than a speeding bullet.’ That is no longer appropriate.”⁹ The name had been even more controversial because of rampant crime in the District of Columbia, which had been given the nickname “the murder capital of the country.”¹⁰

1. George Vecsey, *Sports of the Times; Say Goodbye To ‘Bullets’ As Nickname*, N.Y. TIMES (Nov. 12, 1995), <https://www.nytimes.com/1995/11/12/sports/sports-of-the-times-say-goodbye-to-bullets-as-nickname.html> [<https://perma.cc/9AE6-U2CP>].

2. Adam Augustyn, *Washington Wizards*, BRITANNICA (Nov. 5, 2021), <https://www.britannica.com/topic/Washington-Wizards> [<https://perma.cc/44PV-ACL6>].

3. *Bullets and Wizards History*, NBA.COM, <https://www.nba.com/wizards/wizards-history>.

4. Jacob Bogage, *‘My friend was shot’: How an assassin’s bullets in Israel changed an NBA team’s name in D.C.*, WASH. POST. (Apr. 14, 2018), <https://www.washingtonpost.com/news/retropolis/wp/2018/04/14/my-friend-was-shot-how-an-assassins-bullets-in-israel-changed-an-nba-teams-name-in-d-c/> [<https://perma.cc/MT9U-TKSV>].

5. *Id.*

6. *Id.*

7. *Id.*

8. Vecsey, *supra* note 1.

9. *Id.*

10. Debbie M. Price, *‘Murder Capital’ Label Has Long Stalked D.C.*, WASH. POST (Apr. 4, 1989), <https://www.washingtonpost.com/archive/politics/1989/04/04/murder-capital-label-has-long-stalked-dc/06a3c715-5888-4c26-b6c7-64ef290b305d/> [<https://perma.cc/GFR6-LP5N>]; *see also Ever Wonder: Why the name change from Bullets to Wizards?*, NBC SPORTS (May 27, 2020), <https://www.nbcsports.com/washington/wizards/ever-wonder-why-name-change-bullets-wizards> [<https://perma.cc/UJ74-QCHN>] (“On top of the gun violence that took a close friend away from

The team ultimately gave fans the chance to pick the team's new name; three thousand names were submitted, Pollin cut the list to five names, and fans voted on their favorite of those five.¹¹ For each vote received, a one-dollar donation was made to anti-violence efforts.¹² Although *Washington Post* sports writer Tony Kornheiser blasted the team for its team name options,¹³ the franchise ultimately landed on the Wizards. Yet, changing the name brought a new issue—a legal one. The Harlem Wizards, a Harlem Globetrotters-esque basketball team, sued the Washington NBA team for trademark infringement, claiming reverse confusion.¹⁴ The court eventually dismissed the complaint, and the Wizards name moved forward without further legal interruption.¹⁵ Pollin, in light of the social environment and his friend's murder, was thankful to change the name from the Bullets, saying, "If I save one life, make a change in one life . . . it'll be worth it."¹⁶

2. Tennessee Oilers

While the Tennessee franchise's name change was not quite as socially and politically charged as the Bullets', this example offers another motivation for changing a team name: a geographic move. The franchise was the Houston Oilers from 1960–1996 before moving to Tennessee, where it kept the "Oilers" name for two years.¹⁷ Owner Bud Adams, who had owned the team since 1960, considered holding a fan vote contest like Pollin did with the Bullets, but he decided against doing so when franchise legends such as Earl Campbell questioned how changing the name would affect their legacy.¹⁸ However, Tennessee

Pollin, Washington D.C. was in the midst of a terrible reign of drug abuse and gang-affiliated gun violence in the 1990s, marking it as one of the most dangerous, and deadly cities in the country.”).

11. Josh Chaimson, *The Bullet That Changed the Washington Bullets' Name to the Washington Wizards*, THE GAME HAUS (May 2, 2020), <https://thegamehaus.com/nba/the-bullet-that-changed-the-washington-bullets-name-to-the-washington-wizards/2020/05/02/> [https://perma.cc/H676-LUAQ].

12. *Id.*

13. Tony Kornheiser, *Any Other Name – Please!*, WASH. POST (Feb. 20, 1996), <https://www.washingtonpost.com/archive/sports/1996/02/20/any-other-name-please/6cbff02f-5a2c-452d-bb2c-341f1e56e069/> [https://perma.cc/L8YG-SUU5].

14. *Harlem Wizards Ent. Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1086 (D.N.J. 1997); *see also* Thomas Heath, *Bullets in a Battle for Name's Sake*, WASH. POST (Nov. 6, 1996), <https://www.washingtonpost.com/archive/sports/1996/11/06/bullets-in-a-battle-for-names-sake/d6a13874-0662-4cd1-bec0-2653457186b9/> [https://perma.cc/U5VN-U2HM].

15. *Harlem Wizards Ent. Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1099 (D.N.J. 1997).

16. Jacob Bogage, *supra* note 4.

17. *Oilers Change Name To Titans*, CBS NEWS (Nov. 14, 1998), <https://www.cbsnews.com/news/oilers-change-name-to-titans/> [https://perma.cc/BFV7-5TT5].

18. *Id.*

media wanted a name that was more relevant to the new location.¹⁹ The media ultimately received its wish when Adams changed the name to “Titans”. Of the name, Adams said, “Titans come from early Greek mythology and the fact that Nashville is known as the ‘Athens of the South’ makes the Titans name very appropriate.”²⁰ This name change also shed light on the aftereffects of a name change on retailers; one news story showed some local retailers struggling to sell Tennessee Oilers apparel since the new Titans name was announced in November, right before the Christmas holiday season.²¹

B. Recent and Ongoing Changes

1. Washington Football Team

Another NFL franchise, Washington, plans to unveil its new name on February 2, 2022, which will be the second change for the franchise over a two-year span.²² On July 13, 2020, the franchise rid itself of the “Redskins” moniker it had utilized since 1933, when it was originally the Boston Redskins.²³ The name change came approximately one month after public scrutiny and pressure reached what seemed like a boiling point—Nike, FedEx, and PepsiCo investors even called for the companies to end their relationships with the franchise until the name was changed.²⁴ The kettle had been boiling for about fifty years—journalists in the early 1970s called the team’s name a slur and compared it to slurs used against African Americans.²⁵ The following fifty years included:

19. *Id.*

20. *Id.*

21. Keith Russell, *Oilers’ name change to Titans leaves retailers with titanic chore*, NASHVILLE BUS. J. (Nov. 22, 1998), <https://www.bizjournals.com/nashville/stories/1998/11/23/story2.html> [<https://perma.cc/5H9P-KT54>].

22. President’s Brief: Why Wolves Won’t Work, WASHINGTON FOOTBALL TEAM (Jan. 4, 2022), <https://www.washingtonjourney.com/homepage/presidents-brief-why-wolves-wont-work-and-a-date-to-save/> [<https://perma.cc/775H-5SLT>]; Ben Pickman, *New Washington Football Team Name to Be Released in 2022*, SPORTS ILLUSTRATED (Feb. 23, 2021), <https://www.si.com/nfl/2021/02/23/washington-football-team-name-coming-2022> [<https://perma.cc/RN9G-JHY4>].

23. Jeff Kerr, *Washington Redskins change name: Here’s a timeline detailing the origins, controversies, and more*, CBS SPORTS (July 13, 2020), <https://www.cbssports.com/nfl/news/washington-redskins-name-change-heres-a-timeline-detailing-the-origins-controversies-and-more/> [<https://perma.cc/7ZJE-REY2>].

24. *Id.*

25. *Id.* One article from 1971 which is mentioned in a 2014 Washington Post article said, “John Parker, however, a Choctaw from Oklahoma who works for the Bureau of Indian Affairs, was indignant. ‘They should change the name . . . It lacks dignity, a haphazard slang word that refers to Indians in general but on a lower scale. It is the white people’s way of making a mockery, like they used to do to the blacks in the South.’” Dan Steinberg, *The Great Redskins Name Debate*

(1) a petition by six Native Americans of various tribes in 1992 to strip the team of its trademark registrations granted in 1967.²⁶ After the lower court ruled in favor of the plaintiffs, the appellate court in 2009—seventeen years after the petition was filed—reversed, holding that the doctrine of laches did not apply and that the suit was filed too late.²⁷

(2) In the face of another trademark lawsuit brought by a Navajo Indian, owner Daniel Snyder said, ““We’ll never change the name . . . It’s that simple. NEVER—you can use caps.””²⁸ Snyder also stated that the “Redskins” name originated out of respect for Native Americans and that, at the time, the coach and four players were Native American.²⁹

(3) After the Cleveland Indians removed Chief Wahoo from its stadium and uniforms, NFL Commissioner Roger Goodell emphasized that the “Redskins” name would remain, citing origins and tradition as the reason.³⁰ The surrounding social justice events of 2020, along with pressure from corporate partners, may have been the final nail in the coffin for the franchise. Now, the franchise is on the path toward a new, more accepted name and has sought fan input.³¹

2. Cleveland Guardians

Like the Washington Football Team, Major League Baseball’s Cleveland Guardians announced in 2020 it would officially be changing

of ... 1972?, WASH. POST (June 4, 2014), <https://www.washingtonpost.com/news/dc-sports-bog/wp/2014/06/03/the-great-redskins-name-debate-of-1972/?arc404=true> [https://perma.cc/42EN-RWSW] (quoting Tom Quinn, *Redskins/Rednecks*, WASH. DAILY NEWS (Nov. 1971).).

26. Kerr, *supra* note 23.

27. Bill Mears, *Court rejects appeal over Redskins trademark*, CNN (<https://www.cnn.com/2009/CRIME/11/16/scotus.redskins/index.html>) [https://perma.cc/2S8W-C5KF].

28. Erik Brady, *Daniel Snyder says Redskins will never change name*, USA TODAY SPORTS (May 10, 2013), <https://www.usatoday.com/story/sports/nfl/redskins/2013/05/09/washington-redskins-daniel-snyder/2148127/> [https://perma.cc/XED4-4PYZ].

29. Kerr, *supra* note 23. For a more thorough discussion on this history of the name, see J. Gordon Hylton, *Why the Redskins are Called the Redskins*, MARQ. U.L. SCH. FAC. BLOG (May 30, 2014), https://law.marquette.edu/facultyblog/2014/05/why-the-redskins-are-called-the-redskins/?utm_source=homepage&utm_medium=callout&utm_campaign=blogblock [https://perma.cc/5EZH-63TS]. Hylton says six Native American players were on the 1933 team and that co-owner George Preston Marshall was fascinated with the idea of “Indian Football,” thus he wanted to name the team something unique in relation to Native Americans. *Id.*

30. Kerr, *supra* note 23.

31. The team put together a website for fans to submit ideas and follow the process. *See generally* <https://www.washingtonjourney.com> [https://perma.cc/FV2Z-MQW2].

its name.³² On July 3, the same day the Washington Football Team declared it would investigate changing its name, the Guardians released a statement that said, “We have had ongoing discussions organizationally on these issues. The recent unrest in our community and our country has only underscored the need for us to keep improving as an organization on issues of social justice.”³³ A little over five months later, the team announced its name change, but unlike the Washington Football Team, the Guardians did not choose a “placeholder” name and continued using its previous “Indians” logo throughout the 2021 season.³⁴ On July 23, 2021, the franchise announced its new name would be introduced at the beginning of the 2022 season: the Guardians.³⁵ But almost immediately after the announcement, chaos ensued because a Cleveland men’s amateur roller derby team had been using the “Cleveland Guardians” name, logo, domain name, and social media accounts for years.³⁶ The roller derby team filed a lawsuit against the baseball team, but according to reports, a settlement has been reached allowing both teams to use the name.³⁷ Part II addresses how a franchise could have avoided the legal hurdles the Guardians ultimately faced.

The Cleveland franchise was one of the American League’s eight original charter members in 1901 and eventually named itself the Indians in 1915.³⁸ Although there is debate about the true origins of the name,³⁹

32. David Waldstein & Michael S. Schmidt, *Cleveland’s Baseball Team Will Drop Its Indians Team Name*, N.Y. TIMES (Dec. 13, 2020), <https://www.nytimes.com/2020/12/13/sports/baseball/cleveland-indians-baseball-name-change.html> [https://perma.cc/T4DK-4NPC].

33. Mike Axisa, *Cleveland Indians name change: History of franchise nickname, Chief Wahoo logo and calls for a switch*, CBS SPORTS (Dec. 16, 2020), <https://www.cbssports.com/mlb/news/cleveland-indians-name-change-history-of-franchise-nickname-chief-wahoo-logo-and-calls-for-a-switch/> [https://perma.cc/A83E-WEMY].

34. David Waldstein & Michael S. Schmidt, *Cleveland’s Baseball Team Will Drop Its Indians Team Name*, N.Y. TIMES (Dec. 13, 2020), <https://www.nytimes.com/2020/12/13/sports/baseball/cleveland-indians-baseball-name-change.html> [https://perma.cc/5HT5-9PE5].

35. Chelsea Janes, *Cleveland’s MLB team announces its new name, will rebrand as the Guardians*, WASH. POST (July 23, 2021), <https://www.washingtonpost.com/sports/2021/07/23/cleveland-guardians-mlb-name-change/> [https://perma.cc/8TSL-ZPL9].

36. Jeff Eisenberg, *The original Cleveland Guardians? This roller derby team could cash in on Indians’ name change*, YAHOO! SPORTS (July 26, 2021), <https://sports.yahoo.com/the-original-cleveland-guardians-this-roller-derby-team-could-cash-in-on-indians-name-change-030536652.html> [https://perma.cc/Q53F-BFCE].

37. *Cleveland Guardians’ launch starts with store sign crashing to sidewalk*, ESPN (Nov. 19, 2021), https://www.espn.com/mlb/story/_/id/32667138/cleveland-guardians-launch-starts-store-sign-crashing-sidewalk [https://perma.cc/6KX3-HSS9].

38. Axisa, *supra* note 33.

39. See Joe Posnanski, *The Cleveland Indians, Louis Sockalexis, and The Name*, NBC SPORTS (Mar. 18, 2014), <https://mlb.nbcsports.com/2014/03/18/the-cleveland-indians-louis-sockalexis-and-the-name/> [https://perma.cc/ZL2T-CD8W] (offering a skeptical view of the widely-accepted reasoning).

the most widely-accepted story is that “Indians” was chosen as a reference to the first recognized Native American baseball player, Louis Sockalexis.⁴⁰ As was true for the Redskins name, protests surrounding the “Indians” name and the Chief Wahoo logo began in the early 1970s.⁴¹ In 2015, The Real Cleveland Indians, LLC was registered in Ohio as a 501(c)(3) non-profit organization with the purpose of “educating the public about issues concerning Native American Indians, especially those concerning racism, stereotypes and the use of Native American imagery/culture in sports by non-Native American Indian entities.”⁴² One year later, in 2016, Canadian activists filed a lawsuit to ban use of the Chief Wahoo logo and Indians name before an ALCS game against the Toronto Blue Jays in Toronto, but the lawsuit was dismissed.⁴³ Yet, just two years later, the team announced it would no longer use the Chief Wahoo logo on its uniforms.⁴⁴ In 2019, the team had completely gotten rid of the logo.⁴⁵ The following year, 2020, saw the “Indians” name dropped after being used for about one hundred five years.⁴⁶

II. CHOOSING A NEW NAME

Any franchise that is considering changing the word mark and stylized design marks attached to its brand, such as the Washington Football Team and Cleveland Guardians, must take into consideration the ramifications from a trademark law perspective. First, the franchise should be cognizant of existing marks that have been previously registered with the United States Patent and Trademark Office (USPTO) and have a “live” status attached to such registrations. Proper diligence in this regard includes an exhaustive search of the USPTO’s Trademark Electronic Search System (TESS) for any marks that the franchise may be interested in as well as

40. Axisa, *supra* note 33.

41. *Id.*

42. The Real Cleveland Indians, LLC Certificate of Incorporation, OHIO SEC’Y OF STATE, <https://bizimage.ohiosos.gov/api/image/pdf/201511201132> [<https://perma.cc/AX64-PARU>].

43. Steve Keating, *Baseball: Judge rules in favor of Indians in logo lawsuit*, REUTERS (Oct. 17, 2016), <https://www.reuters.com/article/us-baseball-indians-lawsuit-idUSKBN12I035> [<https://perma.cc/UCT8-29SL>].

44. Pete Blackburn, *Cleveland Indians Fully Phase Out Chief Wahoo Logo, Unveil New Uniforms for 2019*, CBS SPORTS (Nov. 19, 2018), <https://www.cbssports.com/mlb/news/cleveland-indians-fully-phase-out-chief-wahoo-logo-unveil-new-uniforms-for-2019/> [<https://perma.cc/BJ2Y-2G64>] (statement of MLB Commissioner Rob Manfred) (“Major League Baseball is committed to building a culture of diversity and inclusion throughout the game . . . Over the past year, we encouraged dialogue with the Indians organization about the Club’s use of the Chief Wahoo logo. During our constructive conversations, Paul Dolan made clear that there are fans who have a longstanding attachment to the logo and its place in the history of the team.”).

45. *Id.*

46. *Id.*

similar variations thereof. Additionally, a deep search should be accomplished that goes beyond scraping TESS to also account for any commercial use of the marks, as well as alternative and similar versions of the marks, outside of those marks that may have been registered with the USPTO and in good standing. Even though there may not be registrations of concern in place, the franchise will want to avoid any third-party from having a claim of infringement based on their common law rights derived from mere use in commerce. Second, the franchise should have an appreciation as to the strength of the marks that it wishes to develop as its brand. A generic or descriptive brand will have a diminished likelihood of success in having its associated marks properly registered by the USPTO, whereas fanciful and arbitrary are marks with strength that can be useful in the prosecution against individuals and companies that choose to infringe upon or dilute the franchise's brand.

Franchises will typically sift through several marks before deciding as to which group of marks is best suited for the future of the organization. An important part of that process is an understanding of any existing rights holders who could serve as a thorn in the side of the teams. It took the NHL expansion team in Seattle roughly four years before settling on the Kraken brand, and the Los Angeles Rams spent approximately two years in finalizing its new logo after the franchise moved geographical locations from St. Louis.⁴⁷ The Washington Football Team considered whether it was in its best interest to remain as the Washington Football Team. Team president Jason Wright understands that part of the process of choosing a new brand for his football team is filing for and receiving trademark registrations.⁴⁸ He has an appreciation for the fact that third parties have proactively filed trademark applications on over thirty potential names that the franchise may be considering.⁴⁹ Wright has also mentioned that, prior to his hiring, the organization determined that it would take eighteen to twenty-four months to establish a new brand, but he understood that the process could take even longer than that.⁵⁰

Strategically, Wright has acknowledged that it would not make sense for the organization to announce new branding before clearing all of the

47. John Keim, *Washington president Jason Wright: On new name, culture, NFL investigation*, ESPN (Nov. 19, 2020), https://www.espn.com/blog/washington/post/_id/40669/washington-president-jason-wright-on-new-name-culture-nfl-investigation [https://perma.cc/3D EC-9HC8].

48. *Id.*

49. *Id.*

50. Jason Wright, *President's Weekly Brief: Let's Talk About The Name*, WASHINGTON FOOTBALL TEAM OFFICIAL WEBSITE (Oct. 27, 2020), <https://www.washingtonfootball.com/news/presidents-weekly-brief-lets-talk-about-the-name> [https://perma.cc/66GQ-YFJV].

legal hurdles to secure the brand, adding that, “not only would that make for a trademarking headache, but it would also be an embarrassing and chaotic launch to what should be a proud and poignant moment for the franchise.”⁵¹ In deciding to depart from the Washington Football Team brand, the team needed to confront the fact that individuals, such as a man named Martin McCaulay who has filed trademark applications to register more than forty names and images, could either present roadblocks to registration of a new brand or stall the process for the franchise. McCaulay has live registrations for Washington Red-Tailed Hawks, Washington Veterans, Washington Monuments, Washington Americans, and Washington Renegades Gridiron Football, amongst others. Those registrations could cause an examining attorney at the USPTO to outright reject applications filed by others, including the Washington Football Team, that contain marks likely to be confused with McCaulay’s. The Washington Football Team could file petitions to cancel McCaulay’s registrations, but that process requires the team to devote substantial time and resources attached to such efforts. McCaulay also possesses live applications for numerous other trademarks, including but not limited to: Washington Redtails, Washington Sentinels, and Washington Liberty. If, for instance, the Washington Football Team was extremely interested in rebranding to the “Washington Redtails” and McCaulay’s application remained pending, then the franchise’s application would likely be suspended until the USPTO fully processed McCaulay’s application. The USPTO could deny Washington’s application outright without McCaulay exhausting his ability to respond to office actions or to appeal any final decision to the Trademark Trial and Appeal Board (TTAB) or allowing McCaulay to proceed to registration. In the case of the latter being true, the franchise’s suspension would likely be lifted, and it would be in a worse situation, with McCaulay’s registration standing in the organization’s way.

However, the complication of choosing a new brand can prove to be much harder than getting around the issues presented by individuals like McCauley, who has joyfully adopted the moniker “Trademark Hog,” granted to him by many who believe he has hogged many of the names that the Washington Football Team may be interested in acquiring. If the Washington Football Team felt most attached to a “Red Wolves” rebrand and decided to use that name (Wright has said the team will not), then it could have faced a legal battle from Arkansas State University, which has demonstrated its desire to strongly enforce its registered marks

51. *Id.*

surrounding the brand.⁵² On December 18, 2019, the university initiated an opposition proceeding in the TTAB against Chattanooga Professional Soccer Management LLC, which had filed a couple of applications to register its Chattanooga Red Wolves SC marks.⁵³ In its opposition filing, Arkansas State University highlighted that it has continuously used and promoted goods attached to its Red Wolves marks since as early as 2008.⁵⁴ The university also highlighted that the Chattanooga pro soccer team had not used any mark having Red Wolves within the mark prior to Arkansas State University's use.⁵⁵ The university's request for relief was that the TTAB should refuse registration of the Chattanooga pro soccer team's applications because Arkansas State University is being and will be damaged by such a registration.⁵⁶ More than two years later, the case is still pending, and the soccer team has failed to receive a registration.⁵⁷ Chattanooga Professional Soccer Management, LLC filed a civil action in the United States District Court for the Eastern District of Tennessee against Arkansas State University during the time that the opposition has been pending, asking for the federal court to declare that the soccer team's use of Red Wolves does not infringe upon Arkansas State University's trademark registrations. The federal court quickly disposed of the case, finding that Arkansas State University was immune from the lawsuit under the Eleventh Amendment and that no exceptions applied.⁵⁸ The type of delay, unreasonable expense, and legal exposure that Chattanooga Professional Soccer Management, LLC has endured over two years and counting is precisely what an organization like the Washington Football Team would want to avoid. By conducting the requisite trademark diligence and entering into any necessary co-existence agreements, teams must ensure that they will be able to reap all of the benefits of receiving and maintaining trademark registrations with the USPTO. These benefits include, but are not limited to, providing the public with notice of the registration, possessing the right to initiate a lawsuit in federal court for trademark infringement, creating a legal presumption of ownership of the trademark, using the registration as a

52. Complaint at 3, Chattanooga Professional Soccer Management, LLC v. Arkansas State University, (E.D. Tenn. 2019) (No. 1:2019cv00339). Wright referenced trademark concerns as a reason for not using "Wolves" as part of the team's new name. See "President's Brief: Why Wolves Won't Work," *supra* note 22.

53. *Id.*

54. *Id.* at 4.

55. *Id.* at 6.

56. *Id.* at 3.

57. *Id.*

58. *Id.*

basis to earn protection outside of the United States, and the capacity to use the registration symbol attached to the marks at issue.

For now, the Washington Football Team is proactively seeking to register marks associated with its current name, whether it be a placeholder or more permanent than originally thought. It has three pending applications with the USPTO that relate to the current brand, all filed under its parent company—Pro-Football, Inc.—and all initially filed on an intent-to-use basis. The organization will ultimately be required to provide statements of use, shifting the applications from intent-to-use bases to actual use bases, to receive registrations for the trademark applications. As of publication, the USPTO has not assigned examining attorneys to any of the pending applications and, thus, no action is necessary on the part of Pro Football, Inc. for the time being.

III. LEGALLY CHANGING THE NAME

Along with choosing a new name and fulfilling the necessary intellectual property registrations to utilize the name and marks in commerce, the franchise may choose to change the name of its business, if necessary. Both the Washington Football Team and the Cleveland Guardians have incorporated entities within their respective states. For example, a search on the Virginia Corporation Search shows “Washington Football, Inc.,” “Pro-Football, Inc.” (Washington Football, Inc.’s parent company), and “The Washington Football Charitable Foundation, Inc.” can transact business in the state.⁵⁹ Washington Football, Inc. (a Maryland corporation), filed its application to transact business in Virginia in 2000, to the tune of \$125. Given the generality of the current corporation’s name, the Washington franchise could choose to keep its current name. However, a look at the history of The Washington Football Charitable Foundation, Inc. shows the franchise just changed that entity’s name. It was previously “The Washington Redskins Charitable Foundation, Inc.” until the name was changed November 20,

59. Clerk’s Information System VA. STATE CORP. COMM’N. CLERK’S INFO. SYS., <https://cis.scc.virginia.gov/EntitySearch/BusinessInformation?businessId=11294&source=FromEntityResult&isSeries=False> [<https://perma.cc/TC5C-4GUB>] (last visited Nov. 11, 2021); Clerk’s Information System, State Corporation Commission, <https://cis.scc.virginia.gov/EntitySearch/BusinessInformation?businessId=15418&source=FromEntityResult&isSeries%20=%20false> [<https://perma.cc/YAY4-J3HJ>] (last visited Nov. 11, 2021); Clerk’s Information System, VA. STATE CORPORATION COMMISSION, <https://cis.scc.virginia.gov/EntitySearch/BusinessInformation?businessId=292750&source=FromEntityResult&isSeries=False> [<https://perma.cc/49LP-NJ4D>] (last visited Nov. 11, 2021).

2020.⁶⁰ To achieve this name change, the Football Team’s foundation had to file an amendment to its certificate of incorporation in Delaware and a shareholder resolution along with an amended certificate of authority to transact business in Virginia.⁶¹ Additionally, Pro-Football, Inc. (a Maryland corporation) filed a trade name registration for “Washington Football Team” in May 2021. Washington’s example highlights the advantage of forming a broad name for the corporation or LLC (like “Washington Football, Inc.”) because the corporation’s name does not need to change; the entity only has to file a trade name registration for the team’s nickname.

Before the Indians name change, a search on the Ohio Corporation Search would have shown the “Cleveland Indians Baseball Company, Inc.,” “Cleveland Indians Baseball Company, LLC,” and “Cleveland Indians Charities, Inc.”⁶² Now, an Ohio search shows the Guardians name for the corporation, LLC, and charitable arm. To change the names of those business entities, the franchise had to file an amendment to the articles of incorporation for each business entity.⁶³ Ohio companies must use the standard certificate of amendment form as prescribed by the Secretary of State⁶⁴ and pay a \$50 certificate filing fee. Unless otherwise stated in the articles of incorporation, directors for the entity can agree to the amendment that changes the name of the entity.⁶⁵ Shareholders can also agree to an amendment.⁶⁶ Once the amendment is adopted, the entities must then file a certificate on the Secretary of State’s prescribed form, which contains: (1) a copy of the resolution; (2) a statement of the manner of its adoption; and (3) a statement of the basis of its adoption, if adopted by resolution of the directors.⁶⁷ The amended articles must include a statement saying they supersede the corporation’s current articles of incorporation,⁶⁸ the certificate must include the corporation’s

60. The Washington Football Charitable Foundation, Inc., Name History, <https://cis.scc.virginia.gov/EntitySearch/BusinessNameHistory> [https://perma.cc/S9C2-FNEA] (last visited Nov. 11, 2021).

61. The Washington Football Charitable Foundation, Inc., Filing History, VA. STATE CORP. COMM’N. CLERK’S INFO. SYS., <https://cis.scc.virginia.gov/EntitySearch/BusinessFilings> [https://perma.cc/W9F3-NVW3] (last visited Nov. 11, 2021).

62. Cleveland Indians Baseball Company, Inc., OHIO SEC’Y OF STATE, <https://businesssearch.ohiosos.gov/?=businessDetails/CP10239> [https://perma.cc/AQ8H-TPBK] (last visited Nov. 11, 2021).

63. OHIO REV. CODE ANN. § 1701.69(B)(1) (West 2002).

64. OHIO REV. CODE ANN. § 111.25 (West 2002).

65. OHIO REV. CODE ANN. § 1701.70(B)(6) (West 2008).

66. OHIO REV. CODE ANN. § 1701.71(A) (West 2004).

67. OHIO REV. CODE ANN. § 1701.73(A)(1) (West 2002).

68. OHIO REV. CODE ANN. § 1701.04(A) (West 2021); OHIO REV. CODE ANN. § 1701.72(C) (West 1955).

currently-registered name and assigned number by the Secretary of State, and an authorized officer must sign the certificate.⁶⁹ For the Guardians' for-profit corporation, the changes included the amendment to the articles along with a shareholder resolution and consent to use a similar name. Interestingly, the charitable arm's name was changed to "Cleveland Guardians Charities, Inc." in July but was then changed to "Cleveland Guardians Foundation, Inc." four months later. One week after that, the name was changed back to "Cleveland Guardians Charities, Inc."—possibly because the charity had filed a trade name registration for "Cleveland Indians Charities" back in July. Additionally, the Guardians' LLC filed four trade name registrations within the three days of amending its articles—"Cleveland Indians", "Cleveland Indians Baseball", "Guardians Baseball", and "Cleveland Guardians Baseball"; each cost \$39.

CONCLUSION

Coming up with new brand identifiers is not as simple as conducting focus groups and polling the relevant audience about what they believe to be a desirable name and logo for future use. Exhaustive diligence in connection with existing trademark registrations as well as any third party who may possess common law trademark rights is an important element of rebranding an organization. Sometimes, the most desirable branding may not be the best option based on the results of that exhaustive diligence. Many organizations have taken multiple years either in developing a brand attached to their franchises for the first time or in the rebranding process. A big reason for that is the legal diligence that is so particularly important which, when ignored, as may have been the case for Chattanooga Professional Soccer Management LLC, results in frustrations such as unintended and undesirable litigation.

69. OHIO REV. CODE ANN. § 1701.73(C) (West 2014).